

EXHIBIT H

PART 1

Electronic Acknowledgement Receipt

EFS ID:	9675947
Application Number:	95001577
International Application Number:	
Confirmation Number:	1540
Title of Invention:	Attention Manager for Occupying the Peripheral Attention of a Person in the Vicinity of a Display Device
First Named Inventor/Applicant Name:	Paul A. FREIBERGER
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Filer:	Michael B. Ray/Kim Perry
Filer Authorized By:	Michael B. Ray
Attorney Docket Number:	2607.335REX1
Receipt Date:	16-MAR-2011
Filing Date:	
Time Stamp:	22:52:44
Application Type:	inter partes reexam

Payment information:

Submitted with Payment	yes
Payment Type	Credit Card
Payment was successfully received in RAM	\$8800
RAM confirmation Number	5796
Deposit Account	
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
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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.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent of:

Paul A. FREIBERGER, *et al*

U.S. Patent No. 6,788,314 (*issued from
Appl. No. 09/528,803*)

Issued: September 7, 2004

For: **Attention Manager for Occupying
the Peripheral Attention of a Person
in the Vicinity of a Display**

Confirmation No.: TBD

Art Unit: TBD

Examiner: TBD

Atty. Docket: 2607.335REX1

Request for *Inter Partes* Reexamination under 37 C.F.R. § 1.913

Sir:

Inter Partes reexamination under 35 U.S.C. § 311 and 37 C.F.R. § 1.913 is requested of United States Patent No. 6,788,314 to Freiburger, *et al*, entitled "Attention Manager for Occupying the Peripheral Attention of a Person in the Vicinity of a Display" (hereinafter "the '314 Patent"). A copy of the '314 patent is attached hereto as Exhibit A.

This request is brought on behalf of Apple Inc. ("Requester").

I. INTRODUCTION

On August 27, 2010, Interval Licensing LLC, filed a lawsuit in the U.S. District Court for the Western District of Washington alleging infringement of the '314 patent by AOL, Inc.; Apple Inc.; Ebay, Inc.; Facebook, Inc.; Google Inc.; Netflix, Inc.; Office Depot, Inc.; Officemax Inc.; Staples, Inc.; Yahoo! Inc.; and Youtube, LLC (see Civ. Case No. 2:10-Cv-01385). The asserted claims appear to be claims 1-15. These are the same claims for which reexamination is being requested.

The subject matter of these claims includes very basic techniques for displaying content on a computer display that were well known and used in the prior art before the '314 patent application was filed. As is explained in detail in this Request for Reexamination, this claimed subject matter was published in the prior art before the '314 patent application was filed – making the claims unpatentable to the persons listed as inventors on the '314 patent.

In the co-pending lawsuit, the apparent owner of the '314 patent is attempting to stop a number of major U.S. companies from using this basic technology – a technology for which the United States Patent and Trademark Office ("the Office") would never have issued a patent if the proper prior art had been provided to the examiner for review during the original examination. Through this Request, the Office is, for the first time, being given the opportunity to review this prior art. It is respectfully submitted that a careful review this prior art will lead the office to the conclusion that these claims are unpatentable and should never have been issued.

II. IDENTIFICATION OF CLAIMS FOR WHICH REEXAMINATION IS REQUESTED

In accordance with 35 U.S.C. § 302 and 37 C.F.R. § 1.510(b)(2), reexamination of claims 1-15 of the '314 patent is respectfully requested. These claims may be referred to herein individually, or collectively as the claims subject to reexamination.

III. CITATION OF PRIOR ART POINTING OUT SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

Reexamination of the '314 patent is requested in view of the following documents, which are also listed on the attached Form PTO/SB/08A. In accordance with 37 C.F.R. § 1.510(b)(3), a copy of each of the following documents is attached.

1. U.S. Patent No. 5,748,190 to Kjorsvik ("Kjorsvik") [US1]
2. Salm, "Buying a Real Computer Monitor," Popular Electronics, October 1984, pp. 102, 103, 132, and 134 [NPL1]
3. U.S. Patent No. 5,913,040 to Rakavy, *et al* ("Rakavy") [US2]

IV. BACKGROUND

A. *General Statement on Patentability*

As will be fully explained and supported below, claims 1-15¹ of the '314 patent are rendered unpatentable under 35 U.S.C. § 102 and/or § 103 in view of the prior art references provided herewith and cited in the accompanying PTO Form PTO/SB/08A. Kjorsvik and Salm were not considered by the Office during original prosecution. Additionally, although Rakavy was applied during prosecution, Requester is presenting Rakavy in a new light that escaped review during original prosecution. Because both

¹ In the present reexamination request, claims presented during original prosecution are referred to as "original prosecution claims" or "prosecution claims." The claims that issued in the '314 patent are referred to as "patent claims" or "issued claims" herein.

Kjorsvik and the newly cited portions of Rakavy disclose the subject matter deemed to be patentable by the Examiner during prosecution, a substantial new question of patentability is raised by both Kjorsvik and Rakavy as described in detail in Section V.

The prior art presented as raising substantial new questions of patentability alone or in combination teaches each and every limitation of the claims subject to reexamination. Therefore, the cited prior art establishes a prima facie case of unpatentability for each and every claim as described in detail in Section VI.

B. Overview of Anticipation

A patent claim may be found to be unpatentable under 35 U.S.C. §102 as being anticipated by a prior art reference. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). A feature may be inherent if "the prior art necessarily functions in accordance with, or includes, the limitations." *Telemac Cellular Corp. v. Top Telecom, Inc.*, 247 F.3d 1316, 1328 (Fed. Cir. 2001). Extrinsic evidence may be used to show that the missing descriptive matter is inherently present in the reference and would be recognized by one skilled in the art. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991).

C. Overview of Obviousness

Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). In

making an obviousness determination, "a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1740 (2007). In *KSR*, the Supreme Court rejected the "rigid approach" of the former "teaching-suggestion-motivation to combine" or "TSM" test. *Id.* at 1739. At the same time, the Court reaffirmed the principles of obviousness set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). *Id.* at 1734.

The obviousness analysis involves the comparison of the broadly construed claim to the prior art. In comparing the claim to the prior art, three factual inquiries must be addressed: (1) the scope and content of the prior art must be ascertained; (2) the differences between the claimed invention and the prior art must be determined; and (3) the level of ordinary skill in the pertinent art at the time the invention was made must be evaluated. *Graham*, 383 U.S. at 17-18. As stated by the Supreme Court in *KSR*, "[w]hile the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls." *KSR*, 127 S.Ct. at 1734.

In view of the Supreme Court's decision in *KSR*, the Office issued "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" See 72 Fed. Reg. 57,526 (Oct. 10, 2007) [hereinafter Examination Guidelines]. According to the Examination Guidelines, "the Supreme Court particularly emphasized 'the need for caution in granting a patent based on the combination of elements found in the prior art.'" 72 Fed. Reg. at 57,526 (citing to *KSR*). After examining the role of the Office, the guidelines state that "the focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on

what such a person would have reasonably expected to have been able to do in view of that knowledge." *Id.* at 57,527. As articulated by the Supreme Court in *KSR*, the "person of ordinary skill" should be viewed as "a person of ordinary creativity, not an automaton." *KSR*, 127 S.Ct at 1742.

When determining obviousness of an invention, the Examination Guidelines instruct Examiners to "first obtain a thorough understanding of the invention disclosed and claimed in the application under examination by reading the specification, including the claims, to understand what the applicant has invented. The scope of the claimed invention must be clearly determined by giving the claims the 'broadest reasonable interpretation consistent with the specification.'" 72 Fed. Reg. at 57,527. Any obviousness rejection then made by the Examiner "should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill [in the art]." *Id.* at 57,528.

For these reasons, Requester has included Sections IV.C.1 and C.2 below, which set forth Requester's view of the "Scope of Alleged Invention Claimed in the '314 Patent" and "Level of Ordinary Skill in the Art."

I. Scope of Alleged Invention Claimed in '314 Patent

a. Background of the '314 Patent

The Background of the Invention section in the '314 patent describes the prevalent use of "screensavers" and "'wallpaper' (i.e., a pattern generated in the background portions on a computer display screen)" by computer systems prior to the earliest possible priority date of the '314 patent. ('314 patent, 1:48-64.) The background further describes that prior to the earliest possible priority date of the '314 patent, information providers

used "public computer networks (e.g., the Internet) and private computer networks (e.g., commercial online services such as America Online, Prodigy and CompuServe) to disseminate their information" to users. ('314 patent, 1:37-40.) However, according to the '314 patent, "screen savers and wallpaper have not heretofore been used as a means to convey [this] information from information providers to computer users." ('314 patent, 1:66-2:1.) In particular, according to the '314 patent, "screen saver and wallpaper application programs have not been constructed to enable retrieval of display content from a remote location via a computer network." ('314 patent, 2:6-9.)

b. Specification of the '314 Patent

To address the need to couple the existing information dissemination by information providers to computer users with existing screensaver and wallpaper functionality, the '314 patent discloses "present[ing] information to a person in the vicinity of a display device in a manner that engages the peripheral attention of the person." ('314 patent, 2:2-14.) As explained in the '314 patent, the peripheral attention of a person in the vicinity of a display device is engaged "by acquiring one or more sets of content data from a content providing system and selectively displaying on the display device, in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus, an image or images generated from the set of content data." ('314 patent, 3:22-27.) For example, "the selective display of the image or images begins automatically after detection of an idle period of predetermined duration (the 'screen saver embodiment'). This aspect can be implemented, for example, using the screen saver API (application program interface) that is part of many operating systems." ('314 patent, 3:28-31.)

FIG. 2 of the '314 patent (reproduced below) is a block diagram of a "system for implementing an attention manager." ('314 patent, 5:63-64.) "The system 200 includes an application manager 201, a multiplicity of content providing systems, shown as Content Providers 1 through n ... and a multiplicity of content display systems, shown as Users 1 through n." ('314 patent, 14:3-9.) According to the '314 patent, these elements can be implemented using conventional digital computers:

The application manager 201, content providing systems 202 and content display systems 203 can be implemented using appropriately programmed digital computers. Generally, the computers can be any conventional digital computers including an input device (such as a keyboard, mouse or touch screen), an output device (such as a conventional computer display monitor and/or one or more audio speakers), a processing device (such as a conventional microprocessor), a memory (such as a hard disk and/or random access memory), additional conventional devices necessary to interconnect and enable communication between the above-listed devices, and communications devices (e.g., a modem) for enabling communication with other computers of the system.

('314 patent, 14:19-32.)

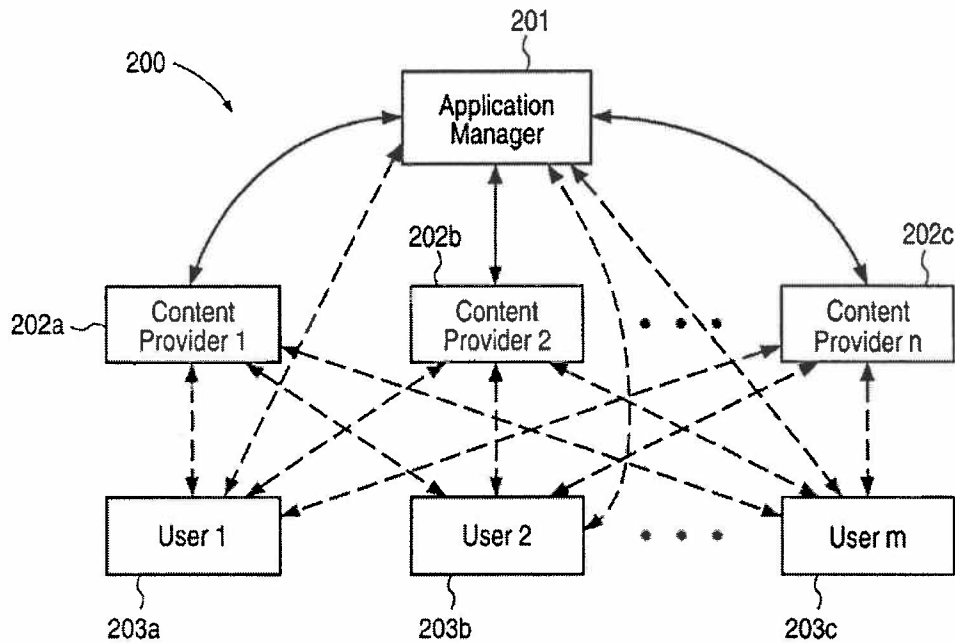


FIG. 2

The "application manager 201 stores application instructions 310, control instructions 320, and content data acquisition instructions 330 that can be disseminated to the content display systems 203 and content providing systems 202 as necessary or appropriate." ('314 patent, 15:8-12.) The "content providing systems 202 store one or more sets of content data 350 that can be disseminated to content display systems 203 as requested." ('314 patent, 16:26-28.)

A content provider may provide scheduling instructions for the content data. As described in the '314 specification, the data scheduling instructions include, for example, duration instructions, sequencing instructions, timing instructions, and saturation instructions:

duration instructions

The content provider can tailor the content data scheduling instructions 322 to indicate the duration of time that a

particular set of content data can be displayed ("duration instructions"). Generally, the duration instructions can be arbitrarily complex and can vary in accordance with a variety of factors, including, for example, the particular time at which the set of content data 350 is displayed after the attention manager begins operating, or the number of previous times that the set of content data 350 has been displayed during a continuous operation of the attention manager.

sequencing instructions

The content provider can also tailor the content data scheduling instructions 322 to indicate an order in which the clips of a set of content data 350 are displayed, as well as the duration of the display for each clip ("sequencing instructions").

timing instructions

The content provider can also tailor the content data scheduling instructions 322 to indicate particular times or ranges of times at which a set of content data 350 can or cannot be displayed ("timing instructions") These times can be absolute (e.g., a particular clock time on a particular day, a particular day or days during a week, after or before a specified date) or relative (e.g., not before or after a specified duration of time since the attention manager began operation, first or not first among the sets of content data 350 to be displayed, not after a particular kind or set of content data 350).

saturation instructions

The content provider can also tailor the content data scheduling instructions 322 to specify a maximum number of times that the set of content data 350 can be displayed after the attention manager begins operating or a maximum number of times that the set of content data 350 can be displayed over any number of operations of the attention manager ("saturation instructions").

(314 patent, 17:7-36.)

Finally, the content display systems are responsible for displaying content:

The content display systems 203 store the application instructions 310, control instructions 320, and content data acquisition instructions 330 described above. The application instructions 310 use the control instructions 320 to display sets of content data 350 that are obtained (and updated, if appropriate) by the content data acquisition instructions 330.

('314 patent, 18:18:29-35.)

d. Claims

(i) Claim Construction

In presenting what it believes are substantial new questions of patentability relating to the claims under reexamination, Requester has adopted – and, indeed is legally obligated to adopt – the broadest reasonable interpretation of the claims. This is so despite the fact that during the concurrent district court litigation, Requester may in the future take a narrower claim construction position than it advanced in the present reexamination request. Requester asserts that this presents no inconsistency, and in no way implicates Requester's obligation to deal with the Office in good faith. As explained more fully below, the Office and the district court are charged with different public functions. Neither is bound by the other's claim interpretations; indeed, they are legally obligated to adopt different claim construction standards.

Specifically, the Office is legally bound to construe the claims in accordance with their "broadest reasonable interpretation." *In re Reuter*, 651 F.2d 751 (CCPA 1981). This is equally true in reexamination proceedings as it is during original prosecution. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). The USPTO broadly interprets claims during examination of a patent application because the applicant may "amend his claims to obtain protection commensurate with his actual contribution to the art." *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. (BNA) 541, 550 (1969). According to the

Federal Circuit, "[t]his approach serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified. Applicants' interests are not impaired since they are not foreclosed from obtaining appropriate coverage for their invention with express claim language." *In re Yamamoto*, 740 F.2d at 1571 (citing *In re Prater*, 415 F.2d at 1405 n.31).

An applicant's ability to amend his claims to avoid cited prior art distinguishes proceedings before the Office from proceedings in federal district courts on issued patents. During district court litigation, claims should be construed, if possible, to sustain their presumptive validity under 35 U.S.C. § 282. *ACS Hosp. Systems, Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). When an application is pending in the USPTO, however, the applicant has the ability to correct errors in claim language and adjust the scope of claim protection as needed. This opportunity is not available in an infringement action in district court. For this reason, "[d]istrict courts may find it necessary to interpret claims to protect only that which constitutes patentable subject matter to do justice between the parties." *In re Yamamoto*, 740 F.2d at 1572 (citing *In re Prater*, 415 F.2d at 1404, 162 U.S.P.Q. at 550).

In sum, the Office acts as an independent tribunal for assessing patent validity. While the positions of the parties taken in the concurrent litigation may to some extent inform the Office's claim interpretation, they are not binding on the Office and should be weighed with a clear eye towards the different nature of the proceedings.

(ii) Limitations

The '314 patent issued with 15 claims, claims 1, 3, 5, 7, 10, and 13 being the independent claims. In the Notice of Allowance mailed on January 12, 2004, the Examiner stated that:

The prior art of record fails to teach or suggest engaging the peripheral attention of a person in the vicinity of a display device by at least *wherein each associated content provider is located in a different physical location than at least one other content provider and each content provider provides its content data to the content display system independently of each other content provider and without the content data being aggregated at a common physical location remote from the content display system prior to being provided to the content display system.*

(Notice of Allowance, p.2.)(emphasis added to highlight claim limitation.) The above highlighted limitation is referred to herein as the "content provider limitation" for ease of discussion. The content provider limitation cited by the Examiner as the allegedly patentable feature of the claims was added to each of independent patent claims 1, 3, 5, 7, 10, and 13 to overcome a prior art rejection based on U.S. Patent No. 5,819,284 to Farber, *et al* ("Farber"). The content provider limitation consists of three parts:

- 1) physical separation of content providers: *each associated content provider is located in a different physical location than at least one other content provider*
- 2) independent provision of content data to display system: *each content provider provides its content data to the content display system independently of each other content data*
- 3) lack of aggregation of content data prior to provision to display system: *without the content data being aggregated at a common physical location remote from the content display system prior to being provided to the content display system*

WITHOUT THE CONTENT DATA BEING AGGREGATED AT A COMMON PHYSICAL LOCATION REMOTE FROM THE CONTENT DISPLAY SYSTEM PRIOR TO BEING PROVIDED TO THE CONTENT DISPLAY SYSTEM

The third part of the "content provider limitation" is presented as a negative limitation. It is important to understand the boundaries of this negative limitation. This negative limitation does not preclude all forms of aggregation of the content data; rather, it only precludes aggregations meeting specific spatial criteria (*common physical location remote from the content display system*) and temporal criteria (*prior to being provided to the content display system*). Thus, and provided the other two parts of the limitation are

satisfied, prior art that does not aggregate content data at a common physical location remote from the content display system prior to providing the content data to a content display system would meet the overall "content provider limitation."

SELECTIVELY DISPLAY ... UNOBTUSIVE MANNER LIMITATION

Each independent patent claim further includes a form of the limitation "*selectively display, in an unobtrusive manner that does not distract a user of the display device or an apparatus associated with the display device from a primary interaction with the display device or apparatus, an image or images generated from a set of content data.*" This limitation is referred to herein as the "*selectively display, unobtrusive manner*" limitation for ease of discussion.

As admitted by the Patent Owner during prosecution of the '652 patent², the construction of the "*selectively display, unobtrusive manner*" limitations encompass screensaver and wallpaper embodiments. Specifically, the Patent Owner stated during prosecution:

... In contrast, in the system recited in Claim 1, a content display system "*selectively display[s], in an unobtrusive manner that does not distract a user of [an] apparatus from a primary interaction with the apparatus, an image or images generated from a set of content data*" (emphasis added). This is neither taught nor suggested by Judson. The display of images in an unobtrusive manner in a system as recited in *Claim 1 can be implemented* by, for example, displaying images during an inactive period (e.g., when the user has not interacted with the apparatus for a predetermined period of time) of a primary interaction with the apparatus (the "*screensaver embodiment*"), as described, for example, at page 3, lines 16-20, page 5, lines 30-33, and page 12, lines 16-20 of Applicants' specification. The display of images in an unobtrusive manner in a system as recited in *Claim 1 can also be implemented* by displaying images during an active period of a

² The '314 patent claims priority to the '652 patent. The priority claims of the '314 patent are discussed in further detail below.

primary interaction with the apparatus, but in a manner that does not distract the user from the primary interaction (the "*wallpaper embodiment*"), as described, for example, at page 3, lines 20-27, page 6, lines 2-8, and page 12, lines 20-28 of Applicants' specification. This aspect of the invention makes use of "unused capacity" of a display device (see, e.g., page 12, lines 28-30 of Applicants' specification) and of the attention of a person in the vicinity of the display device (see, e.g., page 10, lines 11-14 of Applicants' specification). While a similar statement might be made of the method taught by Judson, it is important to note that the instant invention uses different unused capacity than that used by the method taught by Judson.

(Reply to 2/3/98 Office Action in '652 patent, pp. 13-14.)(emphasis in original, bold/italics added)

The excerpts from the specification of the '652 patent, cited by the Patent Owner during prosecution of the '652 patent, also support the interpretation that the "selectively display, unobtrusive manner" limitation encompasses screensavers and wallpaper embodiments.

An attention manager according to the invention presents information to a person in the vicinity of a display device in a manner that engages the peripheral attention of the person. Often, the display device is part of a broader apparatus (e.g., the display device of a computer). Generally, the attention manager makes use of "unused capacity" of the display device. For example, the information can be presented to the person while the apparatus (e.g., computer) is operating, but during inactive periods (i.e., when a user is not engaged in an intensive interaction with the apparatus). Or, the information can be presented to the person during active periods (i.e., when a user is engaged in an intensive interaction with the apparatus), but in an unobtrusive manner that does not distract the user from the primary interaction with the apparatus (e.g., the information is presented in areas of a display screen that are not used by displayed information associated with the primary interaction with the apparatus).

('314 patent, 2:12-28³; *see also* '314 patent 9:2-6.) Accordingly, for purposes of the present reexamination, any prior art presenting screensaver or wallpaper embodiments should be considered as meeting the "*selectively display, unobtrusive manner*" limitation.

(iii) Prosecution History

During prosecution of the '652 patent from which the '314 patent claims priority, the Patent Owner made explicit admissions regarding several limitations of the claims. For example, as illustrated in the following table, the Patent Owner admitted that various aspects of the claims were known prior to the earliest possible priority date of the '314 patent.

³ Requester is providing citation to the equivalent portion in the '314 specification for ease of discussion.

RELEVANT ADMISSIONS BY PATENT OWNER		
'652 Limitation	'314 Limitation	Patent Owner Statement
<p><i>means for displaying one or more control options with the display device while means for selectively displaying is operating</i></p>	<p><i>a system control device that controls aspects of the operation of the system in accordance with a selected control option</i></p> <p><i>controlling aspects of the operation of the system in accordance with a selected control option</i></p> <p><i>instructions for controlling aspects of the operation of the system in accordance with a selected control option</i></p>	<p>"A '<i>means for displaying one or more control options with the display device while the means for selectively displaying is operating,</i>' as recited in Claim 33, was embodied by the content display computer operating in accordance with the computer program shown in Exhibit 2 (see lines 4, 33, and 37 - especially the last - on page 2 of exhibit 2 and the accompanying description in paragraphs 5 and 6 of the second Piernot Declaration) and <i>conventional software for controlling operation of a computer display device (as known to those skilled in the art) to produce a display as shown in Exhibit 3.</i>" (Reply to Final Office Action, p.25)(emphasis added)</p>
<p><i>means for selecting a displayed control options</i></p>	<p><i>user input apparatus that enables selection by a user of one or more control options during the selective display of the image or images generated from [sic] the set of content data</i></p> <p><i>enabling selection by a user of one or more control options during the selective display of the image or images generated from the set of content data</i></p> <p><i>instructions for enabling selection by a user of one or more control options during the selective display</i></p>	<p>"A '<i>means for selecting a displayed control option,</i>' as recited in Claim 33, was embodied by the <i>content display computer and a conventional computer mouse or keyboard operating in accordance with conventional software for controlling operation of such devices (as known to those skilled in the art).</i>" (Reply to Final Office Action, p. 25)(emphasis added)</p>

	<i>of the image or images generated from the set of content data</i>	
<i>content data scheduling instructions for providing temporal constraints on the display of an image or images generated from a particular set of content data</i>	<i>wherein for each set the respective content provider may provide scheduling instructions tailored to the set of content data to control at least one of the duration, sequencing, and timing of the display of said image or images generated from the set of content data</i>	<i>"content data scheduling instructions for providing temporal constraints on the display of an image or images generated from a particular set of content data," as recited in Claim 5, were embodied by the capability of the DeskPicture computer program (which as executed as part of the execution of the computer program shown in Exhibit 1, see line 32 of Exhibit 1 and the accompanying description in paragraph 2 of the second Piernot Declaration) that enabled specification of how long each set of content data was to be used to generate a display of an image (see paragraph 2 of the second Piernot Declaration." (Reply to Final Office Action, pp. 10-11.)(emphasis added)</i>
<i>installation instructions for installing the operating instructions and content display system scheduling instructions on the content display system</i>		<i>" ... '[I]nallation instructions for installing the operating instructions and content display system scheduling instructions on the content display system," as recited in Claim 64, were embodied by conventional software present on the content display computer (see paragraph 3 of the second Piernot Declaration)" (Reply to Final Office Action, p. 32)</i>
<i>display instructions for enabling display of the image or images generated from the set of content data</i>	<i>[instructions for] providing to the content display system a set of instructions for enabling the content display system to selectively display,</i>	<i>"... Lines 31-33 caused the retrieved content data to be used to generate a display of the corresponding image or images: in particular, line 32 caused execution of a computer program called DeskPicture (a</i>

	<p><i>in an unobtrusive manner that does not distract a user of the display device or an apparatus associated with the display device from a primary interaction with the display device or apparatus, an image or images generated from a set of content data</i></p> <p><i>[instructions for] selectively displaying on the display device, [after detection of the idle period and] in an unobtrusive manner that does not distract a user of the display device or an apparatus associated with the display device from a primary interaction with the display device or apparatus, an image or images generated from the set of content data</i></p> <p><i>display apparatus that effects selective display on the display device, in an unobtrusive manner that does not distract a user of the display device or an apparatus associated with the display device from a primary interaction with the display device or apparatus, of an image or images</i></p>	<p>commercially available shareware computer program, produced by Peirce Software, that generated a display of an image as 'wallpaper' on a computer display screen) that accessed a set of content data from the appropriate (previously identified; see line 5, discussed above) location on the non-volatile data storage device and produced the corresponding image display ... (the <i>DeskPicture computer program included capabilities for displaying images generated from multiple sets of content data and specifying how long each set of content data was to be used to generate a display of an image</i>)."</p> <p>(Second Piernot Declaration, ¶2)(emphasis added)</p>
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	<i>generated from the set of content data</i>	
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2. Level of Ordinary Skill in the Art

In its revised examination guidelines for determining obviousness, the Office stated that "any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill [in the art]." 72 Fed. Reg. 57,528. A person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. *Id.* A person of skill in the art has "ordinary creativity" and is "not an automaton." *KSR*, 127 S.Ct. at 1742. The types of problems encountered in the art, prior art solutions to those problems, rapidity with which innovations are made, the sophistication of the technology, and the educational level of active workers in the field are factors that may be considered in determining the level of skill in the art. 72 Fed. Reg. at 57,528 (*citing In re GPAC*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *Customer Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986); *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696 (Fed. Cir. 1983)).

A person of ordinary skill in the art would have therefore been familiar with software programs available prior to the earliest possible priority date of the '314 patent related to generating content and/or displaying content to a user of a computer system. For example, a person of skill in the art would have been familiar with the inherent capabilities of the Powerpoint application developed by Microsoft⁴ as well as the Director

⁴ See Exhibit B describing the inherent capabilities of the Powerpoint application.

product developed by Macromedia. Additionally, a person of ordinary skill in the art would have been familiar with the capabilities of the DeskPicture computer program, which one of the inventors of the '314 and '652 patents admitted in a 37 C.F.R. § 1.131 declaration" included capabilities for displaying images generated from multiple sets of content data and specifying how long each set of content data was to be used to generate a display of an image." ('652 prosecution, Second Piernot Declaration, ¶2.) Furthermore, a person of skill in the art would have been familiar with the screensaver and wallpaper software available prior to the earliest possible priority date of the '314 patent. (See '314 patent background, 1:37-64.)

In addition, a person of ordinary skill would have been familiar with conventional computer hardware and control and operating system functionality available prior to the earliest possible priority date of the '314 patent. For example, a person of ordinary skill in the art would have been familiar with the conventional hardware and software referenced by the Patent Owner during original prosecution including "conventional software for controlling operation of a computer display device (as known to those skilled in the art) to produce a display ...", "conventional computer mouse or keyboard operating in accordance with conventional software for controlling operation of such devices (as known to those skilled in the art)", and the conventional software providing installation instructions for installing the operating instructions and content display system scheduling instructions. (Reply to Final Office Action in '652 patent, pp. 10-11, 25, and 32.)

V. STATEMENT POINTING OUT EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY (37 C.F.R. § 1.915(b)(3))

A. *Priority Date for Claims 1-15 of the '314 Patent*

The '314 patent issued on September 7, 2004, from U.S. Patent Application No. 09/528,803 ("the '803 application"). The '803 application was filed on March 20, 2000, as a continuation of previously filed U.S. Patent Application No. 09/372,399 ("the '399 application"), now abandoned. The '399 application was filed as a continuation of previously filed U.S. Patent Application No. 08/620,641, filed on March 22, 1996, now U.S. Patent No. 6,034,652 ("the '652 patent").

As will be established herein, claims 1-15 of the '314 patent are only entitled to claim benefit of the actual filing date of the '314 patent – March 20, 2000. The subject matter of claims 1-15 was not disclosed in the manner required by 35 U.S.C. § 112, first paragraph in either the '399 application or the '652 patent. Accordingly, the priority claim to the '399 application and the '652 patent must be disregarded.

Under 35 U.S.C. § 120, a claim in a U.S. application is entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. § 112, first paragraph, in the earlier filed application. *See, e.g., Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59 (CCPA 1978). 35 U.S.C. § 112, first paragraph requires that "[t]he specification shall contain a written description of the invention. 35 U.S.C. § 112, first paragraph. To comply with the written description requirement, the specification "must describe the invention sufficiently to convey to a person of skill in the art that the patentee had possession of the claimed invention at the time of the application, i.e., that

the patentee invented what is claimed." *Lizardtech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed Cir. 2005).

The specification of the '399 application and the '652 patent does not provide an adequate written description of the subject matter of claims 1-15. As discussed above, the Examiner indicated that the limitation "*wherein each associated content provider is located in a different physical location than at least one other content provider and each content provider provides its content data to the content display system independently of each other content provider and without the content data being aggregated at a common physical location remote from the content display system prior to being provided to the content display system*" was the patentable feature of claims 1-15.

Thus, patentability of the claims rests on the negative limitation – *without the content data being aggregated at a common physical location remote from the content display system prior to being provided to the content display system*. The law is clear, however, that a negative limitation added to a claim to "carve out" subject matter to overcome a prior art rejection violates the written description requirement if it introduces new concepts. *See In re Xi*, 2008 WL 5232784, at *1-*3 (BPAI 2008) (determining that a negative limitation to remove impurities from a chemical compound that was added to overcome a prior art rejection violated the written description requirement because the specification did not disclose that these impurities could not be present") (citing *Ex parte Grasselli*, 231 U.S.P.Q. 393, 394 (BPAI 1983) (finding the negatively claimed language "said catalyst being free of uranium and the combination of vanadium and phosphorous" in a product claim impermissibly introduced new concepts because "the express exclusion of certain elements implies the permissible inclusion of all other elements not so expressly excluded"), *aff'd*, 738 F.2d 453 (Fed. Cir. 1983) (unpublished)).

The negative limitation added by the Patent Owner to overcome a rejection to Farber introduced new matter in violation of the written description requirement. As *In re Xi* makes clear, to support such a negative limitation, the patent specification needs to disclose that the negative limitation *cannot be present*. Nowhere in the '399 application or the '652 patent does the patentee disclose that the content data cannot be aggregated "*at a common physical location remote from the content display system prior to being provided to the content display system.*" In fact, the specification never even uses the word aggregate (negatively or not). In this regard, failing to disclose a negative limitation is simply not the same as disclosing that it cannot be present. If it were, any time a patent applicant found something that its application did not disclose that was disclosed in the prior art, the applicant could simply insert a negative limitation. This is prohibited by both the written description requirement and common sense because, if an applicant wishes to claim that its invention cannot include something, the applicant is required to disclose that *exclusion* in the specification. There is no such disclosure in the '399 application or the '652 patent that remote aggregation is precluded; thus, the specification of the '399 application and the '652 patent fail to provide adequate written description support. Accordingly, claims 1-15 are not entitled to claim benefit to either the '399 application or the '652 patent.

Therefore, the earliest possible priority date of the '314 patent is March 20, 2000. Printed references with a publication date preceding March 22, 2000, qualify as prior art at least under 35 U.S.C. § 102(a), while printed references with a publication date prior to March 20, 1999, qualify as prior art under 35 U.S.C. § 102(b). Likewise, patents and published patent applications with an effective filing date prior to March 20, 2000, qualify as prior art at least under 35 U.S.C. § 102(e). Accordingly, references published

or having an effective filing date prior to March 20, 2000, may be used to present new information about technology in existence ("pre-existing technology") prior to the filing of the '314 patent.

B. U.S. Patent No. 5,748,190 to Kjorsvik ("Kjorsvik")

Kjorsvik discloses all the limitations of the claims of the '314 patent (as described in more detail below), including the "*content provider* limitation" deemed by the Examiner to provide the allegedly patentable features of the claims – "*wherein each associated content provider is located in a different physical location than at least one other content provider and each content provider provides its content data to the content display system independently of each other content provider and without the content data being aggregated at a common physical location remote from the content display system prior to being provided to the content display system.*" (Notice of Allowance, p. 2.) Kjorsvik was not considered or discussed on the record, alone or in combination with another reference, during the initial examination of the '314 patent. Accordingly, Kjorsvik presents new and non-cumulative information about preexisting technology sufficient to form the basis of a substantial new question of patentability.

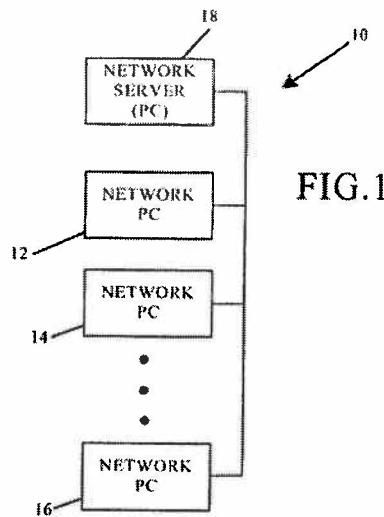
Kjorsvik was filed on September 5, 1995, which is prior to the earliest possible priority date of the '314 patent. Therefore, Kjorsvik qualifies as prior art at least under 35 U.S.C. § 102(e). Furthermore, because the claims of the '314 patent are not entitled to this earliest possible priority date and are instead only entitled to the actual filing date of March 20, 2000, Kjorsvik also qualifies as prior art under 35 U.S.C. § 102(b).

The technical teachings of Kjorsvik relative to the limitations of claims 1-15 are described below. The manner of applying the teachings of Kjorsvik in prior art rejections of claims 1-15 of the '314 patent are described in Sections VI.A, B, and E below.

Kjorsvik is directed to the same problem as the '314 patent - providing content on a display screen utilizing unused capacity of a device (e.g., when the computer is not being used). As described in Kjorsvik, "[w]hen a personal computer is in its 'ON' state but not in use, its computer screen is still lit, which will ultimately lead to damage or degradation of the screen. 'Screen saver' techniques are frequently used in such situations, in which a selected image appears on the screen. Such screen saver images, however, serve no other useful purpose." (Kjorsvik, 1:26-31.) Kjorsvik is therefore directed to a system that provides "useful information or other presentation material ... to the user on his/her computer screen at selected times when the computer is not being used," as an alternative to these conventional screen saver images. (Kjorsvik, 1: 32-36)

FIG. 1 (reproduced below) depicts the basic system architecture of Kjorsvik. The system 10 includes a plurality of individual network personal computers 12, 14, and 16 and a network server PC 18. Each network PC 12, 14, and 16 includes a messenger module responsible for the display of presentations on a screen of the network PC as well as control of the display of images in the presentations. (Kjorsvik, Abstract.) The system of Kjorsvik further includes at least one administration module. The administration module "can be loaded into and executed from any PC in the network." (Kjorsvik, 2:51-52.) That is, a network PC in Kjorsvik may have both a messenger module and an administration module. The network PC of Kjorsvik having both the administration module and a messenger module is a "*content display system*" as recited in claims 1, 3, 5, 7, 10, and 13. The screen associated with the network PC in Kjorsvik is the "*display*

device" recited in the claims. Because the messenger module, the administration module and the screen are part of the same network PC, the network PC having both the messenger module and administration module meets the limitation "*a content display system associated with the display device and located entirely in the same physical location as the display device*" recited in claims 1 and 3.



ACQUIRING/PROVIDING SETS OF CONTENT DATA

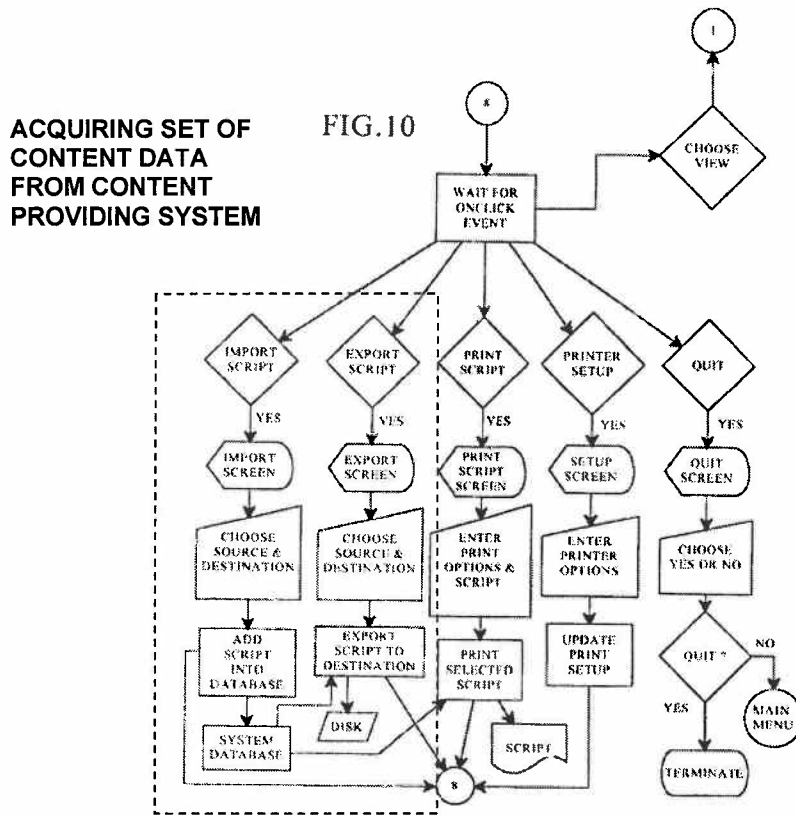
A presentation (script)⁵ in Kjorsvik "consists of one or more individual slides or screens composed around a particular topic." (Kjorsvik, 3:33-35.) Kjorsvik discloses that individual slides and presentations can be created using "Powerpoint in WINDOWS software from Microsoft, Inc."⁶ (Kjorsvik, 3:61-62.) A presentation (script) and/or

⁵ Kjorsvik uses the terms script and presentation interchangeably. (Kjorsvik, 3:30-33.)

⁶ Prior to the earliest possible priority date of the '314 patent, Powerpoint included the inherent capabilities to sequence slides to form a presentation and to specify the duration of time a slide was displayed prior to transition to the next slide. (See Exhibit B.) Kjorsvik refers generally to these capabilities. (See Kjorsvik, 5:14-17.)

individual slides of a presentation of Kjorsvik are therefore "*a set of content data*" as recited in the claims of the '314 patent.

Presentations for use by the messenger module of a network PC in Kjorsvik are created and/or acquired by an administration module. The administration module also "has the capability of communicating with external sources, including other network servers with databases having presentation information, as well as other outside sources of data and images" to acquire presentations and/or other content. (Kjorsvik, 2:58-62.) "[P]resentations may be obtained or provided to external systems and/or other outside sources over external communication lines. This enables the one administration module for the system to obtain or provide presentations directly from or to external sources, so as to eliminate the need for composing them within the system." (Kjorsvik, 4:19-24) This "importing ... of presentations (scripts)" is illustrated in FIG. 10 of Kjorsvik (reproduced below with highlights added). Thus, Kjorsvik discloses "*one or more sets of content data [presentations] are selected from a plurality of sets of content data,*" as recited in claims 1, 3, 5, 7, 10, and 13.



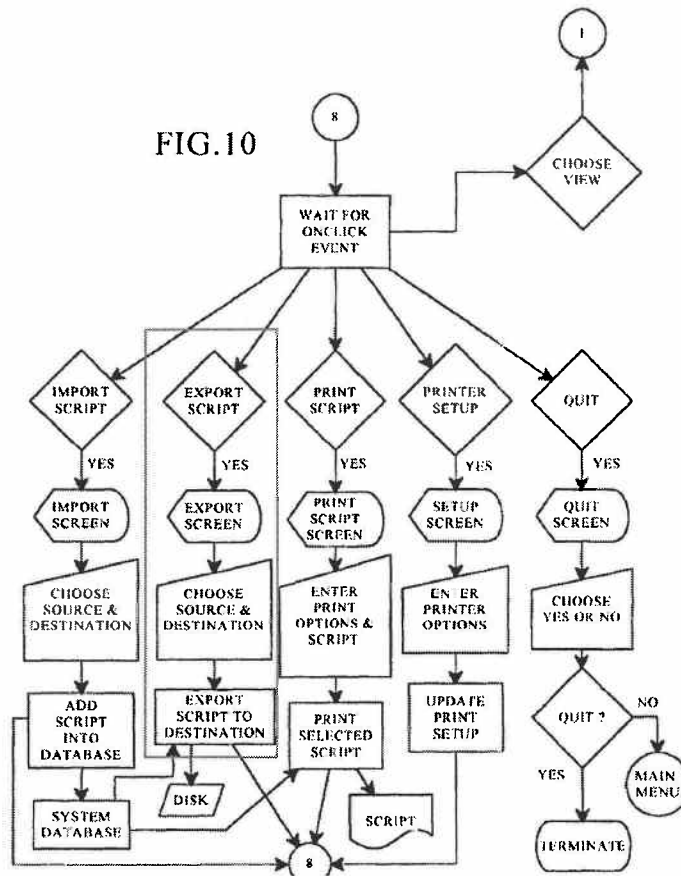
The administration module of the network PC can acquire content data (presentations) from a plurality of content providers (e.g., network servers and external sources). The network servers in turn provide content data (presentations) independently to the administration module of the network PC. These external network servers are separate computers that would be located in different physical locations. The external network servers are therefore "*content providers*" or "*content providing systems*." As shown above in FIG. 10, the administration module directly imports presentations from each external network server without going through an aggregator.

The network PCs including an administration module can also function as content providers to network servers or other external sources. (Kjorsvik, 2:51-52.) As explained above, the administration module "has the capability of communicating with

external sources, including other network servers with databases having presentation information, as well as other outside sources of data and images" to acquire presentations and/or other content. (Kjorsvik, 2:58-62.). Kjorsvik also explains that using the administration module, "presentations may be obtained or provided to external systems and/or other outside sources over external communication lines." (Kjorsvik, 4:19-21.) Therefore, any PC or server with an administration module (external to the content display system) may provide (export) content to the content display system. These external sources with administration modules are "*content providers*" or "*content providing systems*." "Another function of the administration module 26 in the embodiment shown concerns the creation of individual presentations, which may alternatively be referred to as scripts." (Kjorsvik, 3:30-33.) Kjorsvik then explains that these presentations or scripts (which can be created with standard software, such as Powerpoint (Kjorsvik 3:58-62)), may be exported to outside sources (Kjorsvik 4:19-21.) Thus, Kjorsvik also discloses that the presentation/script, "*a set of content data*" recited in the claims of the '314 patent, can be provided to another PC ("*a content display system*"). Kjorsvik further discloses that these other external PCs or network servers with administration modules provide sets of content data to a content display system.

Moreover, as shown in the export functionality of Fig. 10 highlighted below, because the administration module can directly specify the destination for the script (e.g., a content display system), there is no need to aggregate sets of content data, and thus there is no such aggregation, before they are supplied to the destination content display system.

FIG. 10



Further, these network PCs are separate computers that would be located in different physical locations. Thus, the external network servers and the external administration modules acting as content providers meet the limitation of "wherein each associated content provider is located in a different physical location than at least one other content provider" and "each content provider provides its content data to the content display system independently of each other content provider and without the content data being aggregated at a common physical location remote from the content display system prior to being provided to the content display system," recited in claims 1, 3, 5, 7, 10, and 13.

As described above, the import and export functionality of FIG. 10 of Kjorsvik meets the limitations "providing one or more sets of content data to a content display system," as recited in claim 1; "instructions for providing one or more sets of content data

to a content display system," as recited in claim 3; "instructions for acquiring a set of content data from a content providing system," as recited in claims 5 and 13; "data acquisition apparatus that enables acquisition of a set of content data," as recited in claim 7; and "acquiring a set of content data from a content providing system," as recited in claim 10.

SELECTIVELY DISPLAY ... IN AN UNOBTRUSIVE MANNER

In Kjorsvik, a "presentation is displayed on the screens of the individual PCs in the network by the action of a messenger software module present in each PC." (Kjorsvik, Abstract.) Presentations "are initiated for each PC [12, 14, and 16] in the network following a selected amount of time during which each PC has been in an 'on' state but has not been in use. These presentations in effect replace the conventional screen saver, but in addition, provide information in visual form which is intended to be beneficial to the user of the PC." (Kjorsvik, 2:13-18; *see also* 5:4-8.) As discussed in detail above, during prosecution, the Patent Owner identified such "screen saver" embodiments as meeting the "unobtrusive manner" limitation. Accordingly, Kjorsvik discloses "*selectively display [ing] [on the display device][after detection of an idle period and], in an unobtrusive manner that does not distract a user of the display device or an apparatus associated with the display device from a primary interaction with the display device or apparatus, and image or images generated from a set of content data*" as recited in claims 1, 3, 5, 7, 10, and 13.

The messenger module of Kjorsvik controls this "display of [the] presentation sequence on the screen" of the network PC. (Kjorsvik, 1:47-48.) As described above, the messenger module "can be loaded into a network PC from any external source."

(Kjorsvik, 2:48-49.) Kjorsvik therefore discloses "*providing to the content display system a set of instructions for enabling the content display system to selectively display ...*" as recited in claim 1, "*instructions for providing to the content display system a set of instructions ...*" as recited in claim 3; "*instructions for selectively displaying on the display device ...*" as recited in claims 5 and 13; and "*apparatus that effects selective display on the display device,*" as recited in claim 7.

These same limitations are also met in the embodiment where the network PC with the administration module is the "content provider." As Kjorsvik makes clear, any PC, including the external PC that a network PC might provide content to, can have the messenger and administration modules loaded thereon "from any external source" or the PC's own memory." (Kjorsvik, 2:48-54.) Thus, these external PCs would function in the same way as the network PCs.

SCHEDULING INSTRUCTIONS

As discussed above, an administration module of Kjorsvik can import presentations created by other administration modules or external sources. Kjorsvik further explains that an administration module may "be loaded and executed by any PC in the network" (Kjorsvik 2:51-52); thus, as explained above, any PC with an administration module, including PCs Kjorsvik refers to as "external sources" may acts as a content provider to other PC.

An administration module on such a PC of Kjorsvik (either the "network PC" or a network server or other external source) "creates particular presentations by arranging individual slides in a selected sequence." (Kjorsvik, 3:30-43) The arrangement of slides by an administration module in Kjorsvik creates "*scheduling instructions tailored to the*

set of content data to control ... sequencing ... of the display of said image or images generated from the set of content data" as recited in claims 1, 3, 5, 7, 10, and 13. Kjorsvik further discloses that slides and presentations can be created using the Powerpoint software program. Prior to the earliest priority date of the '314 patent, Powerpoint had the capability to set a duration for display of a slide prior to transition to the next slide in a presentation. This capability is referenced in Kjorsvik which states "[e]ach slide is shown for **a preselected period of time**, and then, if the PC is still not being used, the next slide in the presentation sequence is shown, again under the control of the messenger module." (Kjorsvik, 5:14-17)(emphasis added.) This preselected period of time for a slide creates "*scheduling instructions tailored to the set of content data to control ... duration ... of the display of said image or images generated from the set of content data,*" as recited in claims 1, 3, 5, 7, 10, and 13. Because these sequencing and duration instructions are set by the source generating the presentation (i.e., the content provider), for the presentations imported from these external sources to the administration module of the content display system network PC, Kjorsvik discloses "*wherein for each set the respective content provider may provide scheduling instructions tailored to the set of content data to control at least one of the duration, sequencing, and timing of the display of said image or images generated form the set of content data*" as recited in claims 1, 3, 5, 7, 10, and 13. Likewise, when the network PC is the "content provider" and exports such presentations/scripts to external computers, these same presentation/script capabilities in any of the network PCs containing an administration module also allow the "content provider" (the network PC) to "*provide scheduling instructions tailored to the set of content data to control at least one of the duration, sequencing, and timing of the display of said image or images generated form the set of*

content data" as recited in claims 1, 3, 5, 7, 10, and 13." Therefore, in either case, where the network PC is the destination for a presentation or is the source for the presentation, Kjorsvik discloses the above limitation.

During prosecution of the '652 patent (to which the '314 patent claims priority), one of the listed inventors, Philippe Piernot admitted in his second declaration under 35 U.S.C. § 1.131 that a prior art software product, DeskPicture, had capabilities to sequence images and schedule the duration and timing of the display of images generated from a set of content data:

Lines 31-33 caused the retrieved content data to be used to generate a display of the corresponding image or images: in particular, line 32 caused execution of a computer program called DeskPicture (a commercially available shareware computer program, produced by Peirce Software, that generated a display of an image as 'wallpaper' on a computer display screen) that accessed a set of content data from the appropriate (previously identified; see line 5, discussed above) location on the non-volatile data storage device and produced the corresponding image display ... (the DeskPicture computer program included capabilities for displaying images generated from multiple sets of content data and specifying how long each set of content data was to be used to generate a display of an image)

(Second Piernot Declaration, ¶2.) Thus, the Patent Owner admitted that the scheduling limitation recited in each of the independent claims of the '314 patent was known prior to the earliest possible priority date for the '314 patent.

DETECTING AN IDLE PERIOD

As discussed above, in Kjorsvik, presentations "are initiated for each PC [12, 14, and 16] in the network following a selected amount of time during which each PC has been in an 'on' state but has not been in use. These presentations in effect replace the conventional screen saver, but in addition, provide information in visual form which is intended to be beneficial to the user of the PC." (Kjorsvik, 2:13-18) Thus, Kjorsvik

discloses "*instructions for detecting an idle period of predetermined duration*," as recited in claim 5.

CONTROL OPTIONS

As explained in Kjorsvik, a "PC user has the capability of returning the PC to its conventional use, but also has the capability of controlling the presentation to an extent, or even changing to an entirely different presentation among the several which may be available to that specific user." (Kjorsvik, Abstract.) "For instance, by pressing a designated key on the PC keyboard (or the correct mouse button), when a presentation is in progress, a control menu will appear on the user's screen over the current slide. This menu gives the user various possibilities by which to control the presentation." (Kjorsvik, 5:25-29.) FIG. 15 of Kjorsvik (reproduced below) illustrates exemplary control options provided in the system of Kjorsvik.

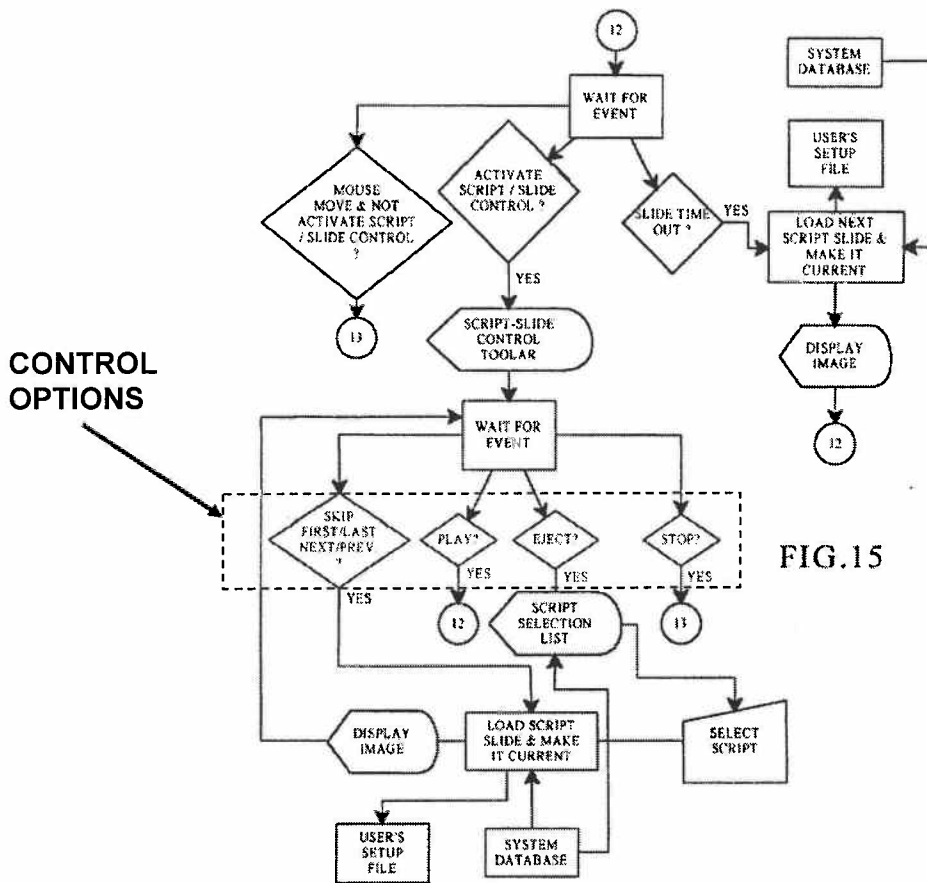


FIG. 15

As shown in FIG. 15, the control options provided in Kjorsvik include SKIP, FIRST/LAST, NEXT/PREVIOUS, PLAY, EJECT, and STOP.

In Kjorsvik, a control option is initiated by an "event" such as pushing a button or other designated key on a keyboard. (See, e.g., Kjorsvik, 5:25-29; 3:6-10; FIGs. 9, 10, and 15.) For example, "[b]y pushing an eject button or other designated key, the user will also be able to go to another selected presentation among the several available to it through the administration module." (Kjorsvik, 5:33-36.) The network PC (or any external PC) with the messenger module and the disclosed conventional mouse or keyboard of Kjorsvik therefore disclose the "user input apparatus that enables selection

by a user of one or more control options during the selective display of the image or images generated from the set of content data" limitation recited in claim 7, "enabling selection by a user of one or more control options during the selective display of the image or images generated from the set of content data; and controlling aspects of the operation of the system in accordance with a selected control option" as recited in claim 10, and "instructions for enabling selection by a user of one or more control options during the selective display of the image or images generated from the set of content data," as recited in claim 13.

Kjorsvik provides flow charts illustrating operations of various control options. See Kjorsvik, FIGs. 14-16. As explained in Kjorsvik, "[i]t is possible, for example, to reverse the presentation slide by slide, or the presentation may be fast-forwarded, slide by slide." (Kjorsvik, 5:29-31.) When a user selects the "STOP" option, the "quit" sequence for the messenger module is initiated, terminating operation of the presentation and returning the PC to its primary interaction with the user. (See, e.g., 5:48-51; FIG. 16.) "By pushing an eject button or other designated key, the use will also be able to go to another selected presentation among the several available to it through the administration module." (Kjorsvik, 5:33-36.) The software carrying out these and other exemplary control options discloses the "*a system control device that controls aspects of the operation of the system in accordance with a selected control options*" limitation of claim 7, the "*controlling aspects of the operation of the system in accordance with a selected control option*" limitation of claim 10, the "*instructions for controlling aspects of the operation of the system in accordance with a selected control option*" limitation of claim 13.

As depicted in FIG. 15 (reproduced above), when a user selects one of the "SKIP, FIRST/LAST, NEXT/PREV" the messenger module will load another script slide and link to the user's setup file. Similarly, when a user selects the "EJECT" options, the messenger module must obtain a script selection list and select a new script (presentation) to display. In either case, the messenger module is linking to some other source of information which is "*an information location*" as recited in claim 9, 12, and 15.

Furthermore, in Kjorsvik, "presentations may be obtained or provided to external systems and/or other outside sources over external communication lines." (Kjorsvik, 4:19-24.) To obtain a presentation from an external source, a user in Kjorsvik can select an import script "control option" from the file menu and identify a destination. (See Kjorsvik, FIG. 10.) The external systems are also "*information location[s]*" as recited in claim 9, 12, and 15.

Thus, in the system of Kjorsvik when a user selects one of the control options such as the import control option or the control options of FIG. 15, the system must establish link with "an information location," such as an internal or external source. Accordingly, Kjorsvik discloses "*the control option enables the user to establish a link with an information location; and the means for controlling establishes the link with the information location,*" as recited in claim 9; "*wherein a link control option enables the user to establish a link with a information location, the step of controlling aspects of the operation of the system further comprising the step of establishing the link with the information location in response to selection of the link control option,*" as recited in claim 12; and "*wherein a link control option enables the user to establish a link with an information location, the instructions for controlling aspects of the operation of the*

system further comprising instructions for establishing the link with the information location in response to selection of the link control," as recited in claim 15.

AUDITING THE DISPLAY OF SETS OF CONTENT DATA

As depicted in FIGs. 14 and 15, the system of Kjorsvik routinely updates a user's setup file during operation of the system. For example, the "messenger module maintains control of the presentation on the screen to the extent that it has stored in its user's own setup file (a file on the PC's hard disk) the last slide which has been shown in the particular presentation then being used, even if the presentation has been interrupted by use of the PC." (Kjorsvik, 5:8-13.) The presentation can then begin "at the same point at which it was interrupted by use of the PC." (Kjorsvik, 5:13-14.) The functionality of recording the last slide presented to a user is an example of "*auditing the display of sets of content data by the content display system,*" as recited in claim 1 and "*for auditing the display of sets of content data by the content display system,*" as recited in claim 3.

C. Salm, "Buying a Real Computer Monitor" ("Salm")

Each of claims 2, 4, 6, 8, 11, and 14 recite that the display device comprises a television. During prosecution, the Examiner took Official Notice that:

Televisions were well know [sic] when the invention was made, the examiner takes official notice of this fact, to be one of the many types of display devices that may be used as a computer monitor.

(Final Office Action dated 2/14/03, p. 9).

The Patent Owner did not traverse the Examiner's assertion of Official Notice. Therefore, the Official Notice statement by the Examiner should be taken as admitted prior art.