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7  
8 UNITED STATES DISTRICT COURT  
9 CENTRAL DISTRICT OF CALIFORNIA  
10 SOUTHERN DIVISION

11 **ACACIA MEDIA TECHNOLOGIES**  
12 **CORPORATION,**

13 Plaintiff,

14 v.

15 **INTERNATIONAL WEB INNOVATIONS,**  
16 **INC.; and OFFENDABLE COMMERCIAL**  
17 **LIMITED, BV, et al.**

18 Defendants.

Consolidated Case No. SA CV 02-  
1040 JW (MLGx)

**DEFENDANTS' CLAIM**  
**CONSTRUCTION BRIEF**

Date: February 6, 2003  
Time: 10:00 a.m.  
Ctm: Of the Honorable James  
Ware

19 **AND ALL RELATED CASE ACTIONS**  
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1 **I. INTRODUCTION**

2 This case has been consolidated with defendants VS Media, Inc, IAAVC, and  
3 others. Co-defendants VS Media et al. have filed a separate claim construction brief,  
4 wherein six additional claim terms have been defined, and the underlying factual  
5 background and legal basis for the analysis has been set forth. Defendants  
6 International Web Innovations, Inc. (“IWI”) and Offendale join in that brief, and  
7 present herewith, an additional two claim terms to be construed. In the interest of  
8 minimizing repetition, this brief does not set forth the underlying factual background  
9 of the asserted patents, or the legal basis for analysis, but rather, refers the court to the  
10 joined brief of the co-defendants, and incorporates it by reference.

11 As discussed in the sections below, the additional two terms that IWI proposes  
12 to be construed herein are set forth in the claims as “means plus function” and “step  
13 plus function” terms that must be construed under 35 U.S.C. §112, ¶ 6. However,  
14 contrary to the requirements of that statute, the patent specification fails to provide  
15 un-ambiguous disclosure of the structure, material or acts necessary to provide the  
16 “function” of the “means plus function” and “step plus function” terms. The failure  
17 to provide such un-ambiguous disclosure is a violation of 35 U.S.C. §112 and renders  
18 the subject claim terms incapable of being defined. As described below, the Court  
19 should find that the ‘992 patent fails to provide a suitable disclosure of any structure,  
20 material or acts for the “compressed data storing means ...” of claim 1 or for the step  
21 “storing, as a file, compressed, formatted and sequenced data blocks with the  
22 assigned unique identification code” of claim 41.

23 While the ‘992 patent fails to disclose proper structure, material or acts for the  
24 noted terms, other aspects of the “function” portion of the terms can be construed. As  
25 described below, the claim terms require that compressed, formatted and sequenced  
26 data blocks be stored “with the unique identification code assigned by the  
27 identification encoding means” (claim 1) or “with the assigned unique identification  
28

1 code.”<sup>1</sup> The references to “**the** unique identification code” or “**the** assigned unique  
2 identification code” is a clear reference to **the** particular unique identification code  
3 previously assigned to “information” **before** that “information was compressed,  
4 formatted or sequenced.

5 More specifically, claims 1 and 41 require an order of operations specified by  
6 the claim language. For example, with respect to claim 1, “information” must be  
7 stored in a library means. Thereafter, the “information” can be retrieved from the  
8 library means by the identification encoding means. Then a unique identification  
9 code is assigned to the “retrieved information.” Thereafter, the “retrieved  
10 information” is formatted by the conversion means to make “formatted data.” The  
11 “formatted data” is then sequenced by the ordering means to form “a sequence of  
12 addressable data blocks.” Then, the sequence of addressable data blocks is  
13 compressed to form “compressed, sequenced data blocks.” The “compressed,  
14 sequenced data blocks are then stored by the compressed data storing means.

15 Thus, the claim language requires a specific, sequential order of operation. As  
16 part of that sequential order, a unique identification code is assigned to “information”  
17 retrieved from the library means. Much later in the serial order of operations, after  
18 the information had been formatted into formatted data and after the formatted data is  
19 sequenced and compressed to form compressed, sequenced data blocks, the claim  
20 requires the “compressed, sequenced data blocks” to be stored with the same unique  
21 identification code that was previously assigned to the retrieved “information” before  
22 that information was compressed, sequenced and formatted. Thus, the Court should  
23 find that the “compressed data storing means ...” and the step “storing, as a file, ...,”  
24 each require storing the same unique identifier that was previously assigned to  
25 “information” before the “information” was compressed, sequenced or formatted.  
26  
27

28 <sup>1</sup> The “unique identification code” is construed in co-defendants’ (VS Media et al.’s)  
claim construction brief, which is incorporated herein by reference.

1 **II. DEFENDANTS' PROPOSED CLAIM CONSTRUCTIONS**

2 **A. Identification Of The Claims To Be Construed**

3 Pursuant to the Court's request, the parties have selected claim limitations from  
4 independent claims 1 and 41 of the '992 patent for construction. In addition to the  
5 terms offered by co-defendants VS Media et al., defendants IWI and Offendale  
6 propose the following terms for construction in Claims 1 and 41, wherein the  
7 proposed terms are bolded and underlined:

8 1. A transmission system for providing information to be transmitted to  
9 remote locations, the transmission system comprising:

10 library means for storing items containing information; identification  
11 encoding means for retrieving the information in the items from the  
12 library means and for assigning a unique identification code to the  
13 retrieved information;

14 conversion means, coupled to the identification encoding means, for  
15 placing the retrieved information into a predetermined format as  
16 formatted data;

17 ordering means, coupled to the conversion means, for placing the  
18 formatted data into a sequence of addressable data blocks;

19 compression means, coupled to the ordering means, for compressing the  
20 formatted and sequenced data blocks;

21 **compressed data storing means, coupled to the data compression**  
22 **means, for storing as files the compressed, sequenced data blocks**  
23 **received from the data compression means with the unique**  
24 **identification code assigned by the identification encoding means;**

25 and

26 transmitter means, coupled to the compressed data storing means, for  
27 sending at least a portion of one of the files to one of the remote  
28 locations.

1 '992 patent at 20:14-34.

2  
3 41. A method of transmitting information to remote locations, the  
4 transmission method comprising the steps, performed by a transmission  
5 system, of:

6 storing items having information in a source material library;

7 retrieving the information in the items from the source material library;

8 assigning a unique identification code to the retrieved information;

9 placing the retrieved information into a predetermined format as

10 formatted data;

11 placing the formatted data into a sequence of addressable data blocks;

12 compressing the formatted and sequenced data blocks;

13 **storing, as a file, the compressed, formatted, and sequenced data**

14 **blocks with the assigned unique identification code;** and

15 sending at least a portion of the file to one of the remote locations.

16 (*Id.* at 24:54-25:5.)

17  
18 **B. Defendant's Proposed Construction Of The Term In Claim 1**

19 **1. The Construction Of Means Plus Function Limitations**

20 Construction of a means-plus-function limitation involves two steps. First, the  
21 Court must identify the claimed function. *Telemac Cellular Corp. v. Topp Telecom,*  
22 *Inc.*, 247 F.3d 1316, 1324 (Fed. Cir. 2001); *Micro Chem., Inc. v. Great Plains Chem.*  
23 *Co., Inc.*, 194 F.3d 1250, 1258 (Fed. Cir. 1999). The court must construe the function  
24 of a means-plus-function limitation to include the limitations contained in the claim  
25 language, and only those limitations. *Lockheed Martin Corp. v. Space Sys./Loral,*  
26 *Inc.*, 249 F.3d 1314, 1324 (Fed. Cir. 2001). It is improper to narrow the scope of the  
27 function beyond the claim language. *Id.* It is equally improper to broaden the scope  
28 of the claimed function by ignoring clear limitations in the claim language. *Id.*

1 Ordinary principles of claim construction govern interpretation of the claim language  
2 used to describe the function. *Id.*

3 After identifying the claimed function, the court must then determine what  
4 structure, if any, disclosed in the specification corresponds to the claimed function.  
5 *Id.* In order to qualify as corresponding, the structure must not only perform the  
6 claimed function, but the specification must clearly associate the structure with  
7 performance of the function. *Medtronic, Inc. v. Advanced Cardiovascular Systems,*  
8 *Inc.*, 248 F.3d 1303, 1311 (Fed. Cir. 2001). If this inquiry reveals that no  
9 embodiment discloses corresponding structure, the claim term cannot be defined. *See*  
10 *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 296 F.3d 1016, 1115, 1119 (Fed.  
11 Cir. 2002). Although Courts will attempt to construe claims to give them meaning,  
12 where the specification fails to disclose structure corresponding to the claimed  
13 function, it is impossible to do so. *See Id.* at 1115.

14 **2. The '992 Patent Fails to Clearly Identify Structure**  
15 **Corresponding to the "Compressed Data Storing Means"**

16 Claim 1 of the '992 Patent recites the limitation "compressed data storing  
17 means, coupled to the data compression means, for storing as files the compressed,  
18 sequenced data blocks received from the data compression means with the unique  
19 identification code assigned by the identification encoding means." The parties agree  
20 that this limitation is subject to interpretation under Section 112, ¶ 6.

21 The claimed function "storing as files the compressed, sequenced data blocks  
22 received from the data compression means with the unique identification code  
23 assigned by the identification encoding means" is properly construed to require (1)  
24 that the compressed data storing means received from the data compression means, to  
25 which it is coupled, blocks of data that are in a sequence; (2) that the sequence of data  
26 blocks is stored by the compressed data storing means as multiple files; and (3) that  
27 each of the files stored in the compressed data storing means include the "unique  
28

1 identification code” (“UIDC”) previously assigned by the identification encoding  
2 means to the information in the corresponding item in the library means.<sup>2</sup>

3 A patent specification must disclose a structure that performs the claimed  
4 function and must clearly associate that structure with the performance of the  
5 function. *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 296 F.3d 1106, 1113  
6 (Fed. Cir. 2002). Here, this means that the ‘992 patent specification must disclose a  
7 structure which is coupled to the data compression means and which performs the  
8 functions of (1) receiving compressed sequence data blocks from the data  
9 compression means; (2) storing those compressed, sequenced data blocks as files; and  
10 (3) storing those files with the unique identification code assigned by the  
11 identification encoding means.

12 In violation of Section 112, ¶¶ 2 and 6, the named inventors failed to disclose  
13 in the ‘992 Patent specification a structure which performs the claimed functions and  
14 which is clearly associated with the performance of those functions. The claimed  
15 “compressed data storing means” is mentioned only twice in the entirety of the ‘992  
16 patent specification. [‘992 patent at Col. 2:41-45 (“compressed data storing means,  
17 coupled to the compression means, for storing as a file the compressed sequenced  
18 data received from the compression means with the unique identification code  
19 assigned by the identification encoding means”); 10:17-22 (“In accordance with a  
20 preferred embodiment of the present invention, the transmission system 100 may  
21 further comprise compressed data storing means, coupled to the compression means,  
22 for storing as a file the compressed sequenced data with the unique identification  
23 code received from the data compression means”).] These statements merely repeat  
24 the functional language of claim 1, and fail to disclose any information about the

25  
26 <sup>2</sup> Not previously discussed, and not subject to construction at this time, is the  
27 process by which the information and its assigned UIDC is converted to a sequence  
28 of data blocks. This process includes three separate and ordered steps—(1) the  
information (and its assigned UIDC) is placed into a predetermined format as  
formatted data by the conversion means; (2) the formatted data (and its assigned  
UIDC) is placed into a sequence of addressable data blocks by the ordering means;

1 structure of the compressed data storing means. Leaving one of skill in the art further  
2 in the dark as to its structure, the specification also fails in both instances to correlate  
3 any schematically depicted element in the patent's figures with the compressed data  
4 storing means.

5 Other disclosed elements that might perform at least some of the claimed  
6 functions of the limitation also fail to be clearly associated with the claimed function  
7 and/or fail to provide any disclosure of their respective structure. For instance, the  
8 '992 patent specification discloses a "compressed data *storage* means" (as opposed to  
9 *storing* means) which is identified as element 117. ['992 patent at Col. 10:25-26,  
10 10:34-38.] Especially given its proximity in the specification to the disclosure of the  
11 compressed data storing means [compare '992 Patent at Col. 10:19 with Col. 10:25-  
12 26], any argument that the compressed data *storage* means is synonymous with the  
13 compressed data *storing* means should be rejected. See *Ethicon Endo-Surgery, Inc. v.*  
14 *United States Surgical Corp.*, 93 F.3d 1572, 1579 (Fed. Cir. 1996) (explaining that if  
15 the terms "pusher bar" and "pusher assembly" described the same item, one would  
16 expect the claim to refer consistently to this element as either, but not both).

17 Moreover, the compressed data *storage* means 117, does not perform the functions  
18 attributed to the claimed compressed data *storing* means. Instead, the compressed  
19 data storage means formats and places into a single file the compressed audio and  
20 video data it receives from compressor 116. ['992 Patent at Col. 8:2-6; 10:36-38.] In  
21 fact, the specification also identifies element 117 as the "compressed data formatting  
22 section" ['992 patent at Col. 7:48-50, 7:55-58; 8:2-6] and as the "compressed data  
23 formatter" ['992 patent at Col. 12:65-68]. The compressed data formatting section  
24 117 is described as performing the function of realigning the audio and video data  
25 received from precompression processor 115 and compressor 116 to form a  
26 compressed data file. ['992 Patent as Col. 8:2-6; 12:65-68.] Similarly, compressed  
27 data formatting section 117 may also reformat program note data such that it is

28 and (3) the formatted and sequenced data blocks (and its assigned UIDC) are

1 compatible with the material stored in the compressed data library 118. [7:50-55.]  
2 Regardless of what it is called by the specification, the critical storage function is not  
3 ascribed to element 117.<sup>3</sup>

4 The specification discloses that compressed data must be stored with its UIDC  
5 in the compressed data library 118. [‘992 patent at 6:35-39 (“Prior to being made  
6 accessible to a user of the transmission system of the present invention, the item must  
7 be stored in at least one compressed data library 118, and given a unique  
8 identification code by identification encoder 112.”] Acacia proposes that the  
9 structure described in the specification of the ‘992 patent for performing the recited  
10 function of the “compressed data storing means” is the “compressed data library  
11 (118).”<sup>4</sup> (Acacia’s Preliminary Claim Construction, pg. 5.) Similarly, in the  
12 prosecution of the ‘992 patent, the compressed data library 118 was identified by the  
13 applicant as the “compressed data storing means.” (“992 Patent, Petition to Make  
14 Special (“PTMS”), pg. 4, ll. 2-4, Exh. 2.) Compressed data library 118, however,  
15 also cannot be the structure clearly associated with the claimed function of the  
16 compressed data storing means. Rather than explicitly linking element 118 to the  
17 claimed function, the specification merely describes it as an optional sub-component  
18 of the compressed data storage means 117. [‘992 patent at Col. 10:34-39.]  
19 Moreover, compressed data library 118 does not perform the requisite function of  
20 receiving compressed sequence data blocks from the data compression means.  
21 Instead, it receives a data file that was created from constituent sequences of  
22 compressed audio and video data blocks that were realigned by compressed data

23 compressed by the compression means.

24 <sup>3</sup> The ‘992 patent does disclose a “short term storage 117’ in the compressed  
25 data formatting section 117.” [‘992 patent at Col. 7:55-58.] This element is  
26 described as directly receiving material that has been previously compressed. *Id.*  
Accordingly, it is not connected to the compressed data storing means as required by  
the compressed data storing means limitation.

27 <sup>4</sup> The ‘992 patent specification defines the compressed data library 118 as follows:  
28 “The compressed data library 118 is composed of a network of storage devices  
connected through a High Performance Parallel Interface (HPPI) Super Controller  
(available from Maximum Strategy Inc., San Jose, Calif.)” (‘992 Patent 13:9-13.)

1 formatter 117. In addition, compressed data library 118 is not “coupled to” the data  
2 compression means as required by the claim limitation, but is instead separated from  
3 the data compression means by compressed data formatting section 117. [See Figs.  
4 2a, 2b.] Indeed, the “compressed data storing means” must be electrically connected  
5 to a data compression means to have received compressed sequenced data blocks  
6 from the data compression means. Thus, within the context of the patent, “coupled  
7 to” means “to join; connect; to bring (two electric circuits) close enough to permit an  
8 exchange of electromagnetic energy.” [Webster's Ninth New Collegiate Dictionary  
9 (1988) at 298, Exh. 1] To be electrically connected to “receive ... from the  
10 compression means,” requires that the “compressed data storing means” is  
11 electrically connected to the output of the compression means. In this regard, the  
12 “compressed data storing means” is connected in the system, after the compression  
13 means, ordering means and conversion means.

14 Finally, the compressed data storing means cannot be the same as the  
15 “compressed data library means,” which is described by the specification as  
16 “separately storing composite formatted data blocks for each of the files.” [‘992  
17 patent at Col. 10:31-34.] To begin, if they were the same element they would be  
18 referred to by the same name. *See Ethicon*, 93 F.3d at 1579. Moreover, the issued  
19 claims of the ‘992 patent make clear that the compressed data library is a  
20 subcomponent of the compressed data storing means. Claim 6 of the ‘992 patent,  
21 which is dependent upon claim 1, recites in relevant part: “the compressed data  
22 storing means further comprises: compressed data library means for separately  
23 storing a plurality of files, each including at least one compressed, sequenced data  
24 block.”

25 Indeed, if the compressed data storing means of claim 1 is the compressed data  
26 library 118, as asserted by Acacia, then what “further” structure would be the  
27 compressed data library means of claim 6? There is no such “further” structure  
28

1 described in the '992 patent. The only logical conclusion is that the "compressed  
2 data library means" of claim 6 is the "compressed data library" 118. As each claim  
3 must be distinct, if claim 6 recites and claims the structure allegedly supporting the  
4 means plus function limitation in claim 1, then it is violates the rules of claim  
5 differentiation. Thus, to provide an interpretation of the claims which are consistent  
6 with the rules of claim construction, the structure for the "compressed data storing  
7 means" of claim 1 must be different than that of claim 6. As no other structure is  
8 identified in the '992 Patent, the structure of claim 1 is un-defined and, thus,  
9 indefinite.

10 As discussed above, there is no structure disclosed in the specification which  
11 unambiguously corresponds to the claimed function as required by §112, ¶ 6. The  
12 quid pro quo for allowing the patentee to express the claim in terms of function under  
13 §112, ¶ 6 is a "duty of a patentee to *clearly* link or associate structure with the  
14 claimed function...." *Medical Instrumentation and Diagnostics Corporation v.*  
15 *Elekta AB et al.*, 344 F.3d 1205, 1211 (Fed. Cir. 2003), *citing Budde v. Harley-*  
16 *Davidson, Inc.*, 250 F.3d 1369, 1377 (Fed. Cir. 2001) (emphasis added). Section 112,  
17 ¶ 6 requires that a "price" be paid for the convenience of not being required to recite  
18 all possible structures in the claims. *Id.* Thus, "[i]f the specification is not clear as to  
19 the structure that the patentee intends to correspond to the claimed function, then the  
20 patentee has not paid that price but rather is attempting to claim in functional terms  
21 unbounded by any reference to structure..." (*id.*), thereby rendering the claim  
22 indefinite. Here, the repeated use of inconsistent terms fails to "clearly link or  
23 associate structure with the claimed function", and thus, the patent has not comported  
24 with the requirements of §112, ¶ 6, but rather, is attempting to claim in unbounded  
25 functional terms, which is impermissible by statute. *Id.* Indeed, given the extreme  
26 ambiguity of the '992 patent specification, its failure to clearly associate any structure  
27 with the claimed function, and its failure to adequately describe the structure that  
28 performs the claimed function, this claim limitation must be found to violate the

1 mandate of Section 112, ¶¶ 2 and 6. Accordingly, this claim limitation cannot be  
2 properly construed.

3 **3. The “Compressed Data Storing Means” Stores The Same**  
4 **Unique Identifier That Was Previously Assigned By The**  
5 **Identification Encoder To “Information” Before That**  
6 **“Information” Was Formatted, Sequenced Or Compressed**

7 As noted above, the compressed data storing means has several cited functions.  
8 The cited functions lend some clarity to the limitations of the claim. In particular, it  
9 is clear from claim 1 that the “compressed data storing means” is for storing “the  
10 unique identification code assigned by the identification encoding means” (emphasis  
11 added) with the compressed, sequenced data blocks received from the data  
12 compression means. The only unique identification code assigned by the  
13 identification encoding means was assigned, per the claim language, “to the retrieved  
14 information.” Thus, the phrase “the unique identification code assigned by the  
15 identification encoding means” (emphasis added) is a clear reference to the function  
16 of the identification encoding means recited earlier in the claim as “assigning a  
17 unique identification code to the retrieved information” (emphasis added).

18 As discussed above, the two functions of the identification encoding means are  
19 “retrieving the information in the items from the library means” and “assigning a  
20 unique identification code to the retrieved information.” The claim specifically  
21 requires the “unique identification code” to have been assigned to “retrieved  
22 information” obtained from the library means, and not to the later formed “formatted  
23 data,” “formatted and sequenced data blocks,” or “compressed, sequenced data  
24 blocks.”

25 Thus, in the “compressed data storing means” limitation, the reference to “the  
26 unique identification code assigned by the identification encoding means” is a direct  
27 reference to the same unique identification code that the identification encoding  
28 means previously assigned to “information” retrieved from the library means, before  
that “information” was formatted, sequenced and compressed.

1           **C. Defendants' Proposed Construction of The Term In Claim 41**

2           **1. The Court Should Construe The "Storing As A File" Step**  
3           **Pursuant To 35 U.S.C. §112, ¶ 6**

4           The step of "storing, as a file, the compressed, formatted and sequenced data  
5 blocks with the assigned unique identification code" is a step-plus-function element  
6 that must be construed in accordance with 35 U.S.C. §112, ¶ 6. Section 112, sixth  
7 paragraph permits the patentee to define an act for performing a function through the  
8 use of a "step" expression, provided the patentee discloses the specific act  
9 corresponding to the functional step in the patent specification. See *Seal-Flex, Inc. v.*  
10 *Athletic Track and Court Const.*, 172 F.3d 836, 849-850 (Fed. Cir. 1999) (Rader  
11 concurring)

12           As with "means" limitations, the use of the word "steps" in a method claim  
13 limitation alerts the reader that section 112, sixth paragraph, may have been invoked  
14 by the patentee. 35 U.S.C. 112, sixth paragraph; *O.I. Corp. v. Tekmar, Co., Inc.*,  
15 115 F.3d 1576, 1582-1583 (Fed. Cir. 1997) ("We interpret the term 'steps' [in § 112, ¶  
16 6] to refer to the generic description of elements of a process, and the term 'acts' to  
17 refer to the implementation of such steps.")<sup>5</sup>

18           The claim itself expressly refers to "storing" as one of the "steps" of the  
19 claimed method. The preamble of claim 41 recites a "transmission method  
20 comprising the steps ... of ...," (emphasis added) where one of the listed "steps" is  
21 "storing ...." The use of the term "steps" in the claim alerts the public that section  
22 112, sixth paragraph, may apply.

23           Next, the claim step is evaluated to determine whether it recites a function or  
24 acts, wherein similar to a "means" limitation, §112, ¶ 6 is invoked if the acts that  
25 support the claimed functional steps of the process are not recited in the claim. See  
26 *id.* at 1583. Functional steps describe what the claim element accomplishes, whereas

27 <sup>5</sup> The present claim is distinguished from the claim analyzed in *O.I. Corporation v.*  
28 *Tekmar Company Incorporated*, 115 F.3d. 1576 (Fed. Cir. 1997), where the court  
found no function specified in the claim under consideration. As noted above, the

1 acts describe how the function is accomplished. *Seal-Flex, Inc. v. Athletic Track and*  
2 *Court Const.*, 172 F.3d 836, 849-850 (Fed. Cir. 1999) (Rader concurring) (emphasis  
3 added). The claim limitation is in step-plus-function format if the claim limitation  
4 recites only a function, the "what", without recitation of any acts, the "how", that  
5 explains the manner in which the function is accomplished.

6 **2. The '992 Patent Fails to Clearly Identify Acts Corresponding**  
7 **to the Step of "Storing As A File"**

8 In the present case, the claim fails to recite any acts for performing the step of  
9 "storing" The claim specifies what is stored. In particular, a file of "the compressed,  
10 formatted and sequenced data blocks with the assigned unique identification code,"  
11 but fails to recite the acts of how to store the file.

12 The claim, however, does specify a function. The claim expressly states what  
13 is accomplished by the step. The "storing" step results in a file of the compressed,  
14 formatted and sequenced data with the assigned unique identification code, that is, the  
15 "storing" step describes *what* is accomplished. Thus, the claim identifies "storing ..."  
16 as one of the "steps" of the claimed method, the step recites a function of "storing as  
17 a file", but no acts. The claim meets the criteria for a step plus function element  
18 under 35 U.S.C., §112, ¶ 6.

19 In contrast to cases finding an act, the limitation at issue is purely functional.  
20 For example, in *Masco Corp. v. U.S.*, 303 F.3d 1316, 1327-28 (Fed. Cir. 2002), the  
21 court found that the limitation "transmitting a force" described an act. More  
22 specifically, in *Masco*, the claimed function of "transmitting a force" was supported  
23 by an elaborate recitation of how that function is accomplished; namely, "transmitting  
24 a force applied to the knob to the lever through the rigid connection after the lever  
25 and the knob have been operably connected to drive the lever to a position where the  
26 protrusion can contact the surface of the cam wheel in such a manner that the lever  
27 will be pulled by the cam wheel during rotation of the cam wheel." *Id.* at 1321

28 storing step of claim 41 involves a function of providing a file of the compressed,  
formatted and sequenced data with the assigned unique identification code.

1 (emphasis added). Similarly, in the Seal-Flex case, the functional limitation  
2 "adhering the mat to the foundation" was held to recite an act, but, as the Court  
3 explained, only because the claim language immediately preceding and following the  
4 functional phrase, i.e., "spreading an adhesive tack coating for adhering the mat to the  
5 foundation over the foundation surface," described precisely how the claimed  
6 function was achieved. *Seal-Flex*, 172 F.3d at 850-51.

7 No such elaboration of the manner in which the function of "storing" is  
8 accomplished is found in the claim. Although this claim is subject to §112, ¶ 6, the  
9 claim fails to meet the obligations imposed by §112, ¶ 2, as described above.

10 **3. The Court Should Construe Claim 41 As The Same Invention**  
11 **As Claim 1**

12 The method steps of claim 41 corresponds to the system elements of claim 1,  
13 but written in method step format. The correspondence of the claims is important  
14 when considered in connection with special requirements accepted and expressed by  
15 the Applicant during the prosecution of the patent. More specifically, during the  
16 prosecution of the patent application, the patentee requested a special, accelerated  
17 prosecution of the application, in a "Petition To Make Special Under M.P.E.P  
18 708.02(VIII) (5<sup>th</sup> Ed, revised Oct. 1989)."

19 Under the cited rule, the patentee was required to direct all claims under  
20 examination to a single invention. In fact, in the Petition document itself, the  
21 patentee stated "[a]ll claims presented for examination are believed to be directed to a  
22 single invention" (Petition, page 1, second paragraph). While claim 41 was added to  
23 the application after the Petition was filed, in return for reaping the benefit of an  
24 accelerated examination the patentee was required to direct all claims under  
25 examination to a single invention.

26 Moreover, when claim 41 was added to the application, the applicant informed  
27 the U.S Patent and Trademark Office that the claim "tracks" claim 1 and is allowable  
28 over prior art for the same reasons as set forth with respect to claim 1. ('992 Patent,  
Response to Office Action of September 30, 1991, pg. 25, ll. 25 and 26 and pg. 26, ll.

1 6-9), Exhibit 3. By simply relying on its arguments for claim 1 to show patentability  
2 of the similarly-worded claim 41, the prosecution history of the '992 patent makes it  
3 clear that the applicant intended the steps of claim 41 be construed similar to the  
4 construction of the means-plus-function elements of claim 1.

5 Therefore, several factors in the present case show that the steps of claim 41  
6 are to be construed under 35 U.S.C. §112, ¶ 6, in a manner similar to the construction  
7 of the means-plus-function elements of claim 1, including: (1) that the Petition To  
8 Make Special (for expedited examination) filed by the applicant required the  
9 applicant to direct claims 1 and 41 to a single invention, (2) that claim 41 was  
10 expressly introduced by the applicant as tracking claim 1, (3) that the applicant  
11 merely referenced its arguments for claim 1 to also distinguish claim 41 over prior  
12 art, (4) that there is a direct correspondence between the means elements of claims 1  
13 and the steps in claim 41, and (5) that the patentee has accepted that the elements of  
14 claim 1 are to be construed as “means plus function” elements. At least from those  
15 facts, it follows that the corresponding steps of claim 41 are to be construed  
16 correspondingly as “step plus function,” similar to the “means plus function”  
17 elements of claim 1.

18 **4. The “Storing, As A File” Step Is Indefinite And Fails To Meet**  
19 **The Requirements Of 35 U.S.C. §112, ¶ 2**

20 Because the “storing as a file ...” step of claim 41 should be construed  
21 similarly to the compressed “data storing means” of claim 1, the above-noted failure  
22 of claim 1 to meet the requirements of 35 U.S.C. §112, ¶ 2, also applies to claim 41.  
23 In particular, the '992 patent specification fails to describe, in unambiguous terms,  
24 any structure, material or acts necessary for performing the recited step, just as the  
25 patent failed to provide an unambiguous description of structure that performs the  
26 function of the compressed data storing means of claim 1.  
27  
28

1                   **5. The “Storing, As A File” Step Involves Receiving An Output**  
2                   **Of A Data Compression Means**

3                   What is clear about the “storing, as a file” step is that it involves storing “the  
4 compressed, formatted and sequenced data blocks ...” (emphasis added). The word  
5 “the” in that claim language is a clear reference to the antecedent basis provided by  
6 the previous step in the claim. In particular, the previous step in the claim recites  
7 “compressing the formatted and sequenced data blocks.” It follows that the output or  
8 result of that step of compressing formatted and sequenced data blocks must be  
9 “compressed, formatted and sequenced data blocks.” Accordingly, whatever means  
10 that perform the compressing step must produce an output, which is received and  
11 stored as part of the proceeding storing step.

12                   **6. The “Storing, As A File” Step Involves Storing The Same Unique**  
13                   **Identifier That Was Previously Assigned To “Information” Before That**  
14                   **“Information” Was Formatted, Sequenced Or Compressed**

15                   What is also clear about the “storing, as a file” step in claim 1 is that it is for  
16 storing the compressed, formatted and sequenced data blocks with “the assigned  
17 unique identification code” (emphasis added). The only unique identification code  
18 assigned in the claim was the one assigned, per the claim language, “to the retrieved  
19 information.” Thus, the phrase “the unique identification code” (emphasis added) is a  
20 clear reference to the step recited earlier in the claim of “assigning a unique  
21 identification code to the retrieved information” (emphasis added).

22                   The claim specifically requires the “unique identification code” to have been  
23 assigned to “retrieved information” obtained from the library, and not to the later  
24 formed “formatted data,” “formatted and sequenced data blocks,” or “compressed,  
25 formatted and sequenced data blocks.”

26                   Thus, similar to claim 1, in the “storing, as a file” step of claim 41, the  
27 reference to “the unique identification code” is a direct reference to the same unique  
28 identification code that the identification encoding means previously assigned to  
“information” retrieved from the library means, before that “information” was  
formatted, sequenced and compressed.

1 **III. CONCLUSION**

2 For the foregoing reasons, the identified terms in claims 1 and 41 are not  
3 capable of definition.

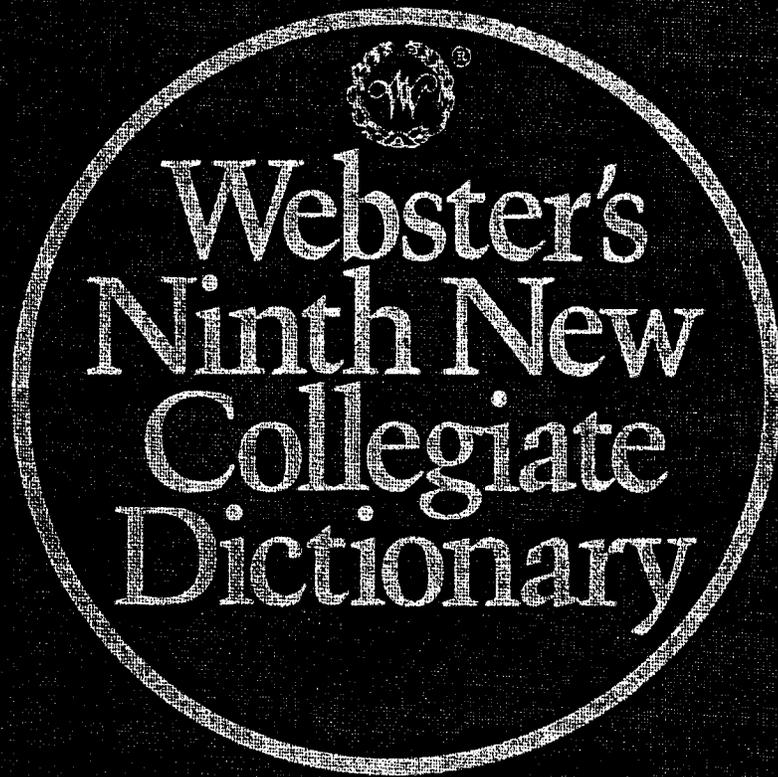
4  
5 Dated: January 8, 2004



6 William J. Robinson  
7 Victor de Gyarfas  
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9 Attorneys for  
10 **INTERNATIONAL WEB INNOVATIONS,**  
11 **INC. and OFFENDALE COMMERCIAL**  
12 **BV, LTD.**

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# **EXHIBIT 1**



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## **EXHIBIT 2**



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PATENT JUN 21 1991  
Attorney Docket No. 02473.0001-00000

GROUP 260

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

|                                   |   |                     |
|-----------------------------------|---|---------------------|
| In re the application of          | ) |                     |
| Paul Yurt, et al.                 | ) |                     |
| Serial No. 07/637,562             | ) | Group Art Unit: 262 |
| Filed: January 7, 1991            | ) | Examiner:           |
| For: AUDIO AND VIDEO TRANSMISSION | ) |                     |
| AND RECEIVING SYSTEM              | ) |                     |

Hon. Commissioner of Patents  
and Trademarks  
Washington, DC 20231

Sir:

PETITION TO MAKE SPECIAL UNDER  
M.P.E.P. § 708.02(VIII)

Applicants hereby petition the Commissioner of Patents and Trademarks under M.P.E.P. § 708.02 (VIII) to make this application special and receive accelerated examination. In accordance with that section, Applicants have enclosed a check for \$80.00 to cover the fee for this petition as set forth in 37 C.F.R. § 1.17(i). If any additional fees are required in connection with the filing of this Petition, please charge those fees to Deposit Account No. 06-916.

All claims presented for examination are believed to be directed to a single invention. If, however, the Examiner requires a restriction, Applicants provisionally elect for prosecution whichever group of claims contains method claims 18-21.

Also in accordance with M.P.E.P. §708.02 (VIII), Applicants affirm that a preexamination search has been made

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1-202-408-4000

by an attorney who conducted searches in class 358, subclass 86 and class 455, subclasses 4, 5, 86, 102, 135, and 136.

The following references were developed during the searches and during subsequent investigations, and a copy of each of these references is enclosed along with a copy of PTO Form FB-A820 listing these references.

#### DESCRIPTION OF THE CLAIMED INVENTION

The present invention is directed to an audio and video transmission and receiving system in which the user controls the access and the playback operations of selected material. The present invention affords the user greater access to and control over audio and video information than is possible in conventional systems. With the present invention, a user can request audio and video information to be sent to a selected destination. Further, the user is not constrained to having programs played at a particular time because the system has a buffering capability. By employing such buffering, the user has individualized control over the replay of requested programs. Moreover, requested programs are sent to the user in a compressed format. This enables the system to send requested programs to users in a relatively short time period, and allows users to store large quantities of requested material for playback at a desired time.

The entire system includes a transmission system and a reception system. The transmission system includes a source material library from which a user makes a selection. The selected program is processed and compressed for storage in a

compressed data library. The system control computer controls access to programs stored in the compressed data library and controls transmission of selected programs to a user.

Once a selected program is transmitted, the reception system of the present invention receives the program and buffers it in a storage section. Because the program is buffered, the user can choose to replay the stored program whenever desired. When replay is requested, the program is decompressed and played back in real time at the receiving device requested by the user.

Figs. 2A and 2B of the application are detailed block diagrams of a preferred implementation of the transmission system of the present invention. Fig. 2B shows an implementation of the compressed data storing means recited in claim 1 as the compressed data library 118. Fig. 6 is a block diagram of a preferred implementation of the receiving system of the present invention. Fig. 6 shows an implementation of the storing means required in claim 22 as element 203. Fig. 7 is a flowchart of a preferred method of distribution which shows the buffering step at step 418.

Claims 1-17 are directed to a transmission system for providing information to remote locations. The system recited in those claims includes library means, for example source material library 111, for storing items. A requested program is encoded in the identification encoding means, for example identification encoder 112, which assigns the requested program with a unique identification code. The requested program is also converted by the converting means, for example converter 123, and ordered into a sequence of addressable data block by the ordering means, for

example time encoder 114 and precompression processor 115. Subsequently, the program is compressed by compression means, such as compressor 116, and stored in the compressed data storing means, which may be compressed data library 118. The identification means, the conversion means, the ordering means, and the compressed data stores storing means will be collectively referred to as preprocessing elements. Transmitter means, for example transmitter format means 119 and transmitter 122, transmit the requested program to the user.

Claim 7 calls for a system control interface means for generating a visually-perceptible list of the items available in the compressed data library, and library access interface means, which may be library access interface 121, which receives transmission requests and retrieves formatted data blocks stored in the compressed data library means.

Claims 18-21 cover a distribution method responsive to user requests identifying information to be sent from a transmission system to remote locations. This is shown in Figure 7. The distribution method of independent claim 18 includes the steps of processing audio and information for storage in a compressed data form (steps 413a-413e), storing audio and video information in a compressed data form (step 414) and user request of the stored information for transmission to a selected remote location (step 415). The method also includes the steps of sending the compressed information to a remote location (step 416) and receiving it there (step 417). After reception, the distribution method includes buffering the received information (step 418) and

playing it back in real time at a time requested by the user (step 419). The distribution method recited in claim 21 further includes, the step of storing a list of items available to the user from at least one compressed data library, and providing the user with the list so that the user may remotely select a particular item for transmission.

Claims 22-32 are directed to a receiving system responsive to a user input identifying an item stored in a source material library to be played back to the subscriber at a location remote from the source material library, the item containing information to be sent from a transmitter to the receiving system. The reception system 200 comprises transceiver means, such as transceiver 201, which receives requested information from the transmitter as compressed formatted data. The received information is converted into a format suitable for storage and playback in real time in the receiver format conversion means, which may be receiver format converter 202, and then stored as compressed data in the storage means, for example storage 203. When playback is requested, the decompressing means, for example audio decompressor 209 and video decompressor 208, decompresses the information and the output conversion means, such as output converter 206, plays back the decompressed information in real time at a time specified by the user.

As recited in claim 27, the output data conversion means further comprises digital video output means, for example video output converter 211, and analog video output means, for example analog video output converter 213. According to claim 30, the

output data conversion means also includes digital audio output means, for example digital audio output converter 212, and analog audio output means, for example analog audio output converter 214. Claim 32 recites that the transceiver means, such as transceiver 201, receives information via any one of telephone, ISDN, broadband ISDN, satellite, common carrier, computer channels, cable television systems, MAN, and microwave.

#### DETAILED DESCRIPTION OF THE REFERENCES

##### A. REFERENCES CITED IN THE SPECIFICATION

##### 1. Lang, U.S. Patent No. 4,963,995

Lang, which is discussed in the Background of Invention portion of the specification, discloses an audio/video transceiver apparatus (VCR-ET) that includes a compression capability. The VCR-ET of Lang is an improved audio/video recorder which has "added features and functions which significantly enhance its usefulness and functionality." See col. 1, lines 65-68. Specifically, Lang discloses an audio/video transceiver with the capability of editing or copying from one video tape to another using only a single tape deck. Lang further discloses a VCR-ET which can re-transmit a program to a second VCR-ET. See Col. 7, lines 60-64.

Lang does not disclose a transmission system as recited in independent claim 1 because Lang does not teach or suggest a transmission system for providing information to remote locations which includes library means for storing items. Lang also does not teach or suggest an identification encoding means for

retrieving the information for the items from the library means and for assigning a unique identification code to the retrieved information

Lang also is not concerned with providing a distribution method responsive to user requests identifying information to be sent from a transmission system to remote locations. Accordingly, Lang fails to teach or suggest the steps of the distribution method claimed in independent claim 18.

Because Lang is directed to an improved VCR, Lang does not disclose a receiving system which is responsive to user requests for items from a source material library. While Lang mentions that video libraries are "envisioned," there is no disclosure of how material would be requested or retrieved from such libraries. See col. 7, line 67 of Lang. Particularly, Lang does not teach that user requests will cause items stored in a source material library to be sent from a transmitter to a receiving system, as called for in independent claim 22.

2. Monslow et al., U.S. Patent No. 4,890,320

Monslow et al., which is also described in the Background of Invention section of the specification, discloses a system which broadcasts viewer-selected material to a viewer at a prescribed time. However, the Monslow et al. system requires multiple users in multiple locations to view the requested material at the time it is broadcast, rather than allowing each viewer to choose his or her own viewing time. Once the choice is made, the user cannot change it because Monslow et al. does not provide for buffering a

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selected program so that the user can play it back at a desired time. See col. 6, line 60 through col. 7, line 28.

Further, in Monslow et al., the viewer-chosen program is transmitted to the television receiver of the requesting viewer. The requestor therefore does not have a choice of where the information that they request is sent. See the Abstract, Fig. 1, and col. 5, lines 27-39.

With regard to the claims, Monslow et al. does not teach or suggest the preprocessing elements called for in independent claim 1, the buffering step required in independent claim 18, or the storage means recited in independent claim 22.

3. Abraham, U.S. Patent No. 4,590,516

Abraham '516, which is another reference described in the Background of Invention portion of the specification, discloses a combined telephone and modulated carrier communication system. In Abraham '516, a user at a subscriber station 10 uses a standard telephone set 16 to contact program service station 12. The user selects a program from the library 36. A telephone communication link is established with the station 12 through the switching gear 20, and when the program selection operation from the library 36 is completed, a return signal is heard by the subscriber through the telephone. The user then hangs up the telephone which initiates program readout and sets the billing computer 28. A timed message period precedes transmission of the program. After the message period ends, the selected program is transmitted and the billing operation is performed. During the message period,

the subscriber can call up and cancel transmission of the program. See col. 4, line 38 through col. 5, line 3 and Fig. 1.

The system in Abraham '516 uses a dedicated signal path, rather than multiple common carriers, to transmit audio/video programming. Also, the receiver has no storage capability. Furthermore, the system provides for only display functions, which limits viewing to the time at which the material is ordered, and, like Monslow et al., the Abraham '516 system does not allow for the stop, pause, and multiple viewing functions of existing VCR technology.

Because Abraham '516, like Monslow et al., discloses relative simultaneous transmission of the requested material, this reference does not teach or suggest the compressed data storage means recited in independent claim 1, the buffering step required in claim 18, or the storage means called for in claim 22.

4. Walter, U.S. Patent No. 4,506,387

Walter, also discussed in the Background of Invention section of the specification, discloses a fully dedicated, multi-conductor, optical cable system that is wired to the viewer's premises. Although the system affords the viewer some control over accessing the material, it requires that a location designated by the viewer be wired with a dedicated cable. The Walter system further requires that the viewer be at that location for both ordering and viewing the audio/video material.

In Walter, information is retrieved from the memory modules 24-35. A host computer 20 controls output of desired material over optical fibers 129, 94, 96, 98, and 100 to data receiving

system 146. After selection from memory modules, there is no provision in Walter for storing the requested material in a compressed form. Therefore, Walter does not teach or suggest the preprocessing elements required in independent claim 1. Additionally, there is no teaching or suggestion in Walter that only a portion of an item stored in the library modules 24-34 can be sent to a subscriber, as further recited in independent claim 1.

Walter shows memory module 102 in the data receiving system 14, but there is no indication in Walter that compressed data is stored in memory module 102. Because non-compressed data is stored in the memory module, the user is limited as to the quantity of data which may be stored therein. Accordingly Walter does not teach or suggest buffering the received information, which is compressed, at the remote location, as recited in independent claim 18, or a receiver including storage means, coupled to receiver format conversion means, for storing compressed formatted data, as set forth in independent claim 22.

B. REFERENCES CITED IN THE SEARCH REPORT OF 09/07/90

1. Lumelsky, et al., U.S. Patent No. 4,949,169

Lumelsky et al. discloses an audio-video data interface for a high speed communication link in a video-graphics display window environment. A "primary objective" of Lumelsky et al. is to "provide a simple interface to a high speed digital communication network such that full motion video window images and its audio sampled by one node can be transmitted over the network to other nodes." See col. 5, lines 25-30 and Figs. 1A and 1B.

Because Lumelsky et al. is directed to interface architecture for connecting video display devices, it is not directed to a transmission system or a receiving system, as respectively recited in independent claims 1 and 22. Further, because Lumelsky et al. is concerned only with interconnecting display devices, it is not concerned with the distribution of information from a transmitter to a receiver, and therefore it does not teach or suggest buffering received information at a remote location, as recited in the distribution method of independent claim 18.

2. Fenwick et al., U.S. Patent No. 4,947,244

Fenwick et al. discloses a video program distribution system. The system includes controller 116 which receives and responds to user requests from monitors 102. The controller 116 also controls the switch 114 which is connected to the video sources 112. See col. 3, lines 29-36. The video sources 112 are video cassette players. The number of video cassette players used in a system will vary between thirty-two and ninety depending on the range of programming desired. See col. 5, lines 15-20.

In Fenwick et al., the video sources 112 must be manually controlled. Because the system is manually controlled, Fenwick et al. does not disclose a transmission system including identification encoding means for retrieving the information for the items from a library and for assigning a unique identification code to the retrieved information, as required in independent claim 1. Moreover, in Fenwick et al., information is sent directly from video sources 112 to the monitors 102 and is not stored prior to replay. Therefore, Fenwick et al. also does not

disclose buffering received information at a remote location, as required in independent claim 18 or a storage device at the receiver, as required in independent claim 22.

3. Boulton, U.S. Patent No. 4,937,821

The Boulton patent discloses an information delivery system for delivering reference information to a plurality of users. In Boulton, information from data sources 12 is encoded in encoders 14 and mixed in mixers 16 and 18 for delivery over a cable 24 to a user. The information is neither transmitted nor received by the user in a compressed form. Boulton also does not show the requested information being stored prior to transmission to a user. Boulton therefore does not teach or suggest a transmission system including the preprocessing steps or compressed data storing means, as recited in independent claim 1, or the step of storing audio and video information in a compressed data form, as recited in independent claim 18. Because Boulton also does not show the requested information being stored at the receiving device of a user, Boulton does not teach or suggest storage means for storing compressed formatted data, as recited in independent claim 22.

4. Eggers et al., U.S. Patent No. 4,920,432

The Eggers et al. patent discloses a system for random access to an audio video library with independent selection and display at each of a plurality of remote locations. The system in Eggers et al. includes a video filer 2, which is a microprocessor-controlled mechanical storage and retriever device, that transports discrete data record items, i.e., video cartridges,

between a rectangular array of storage sites 12 open on one side, and an adjacent array of playback devices 11. See col. 3, lines 36-40. Video signal combiner 4 directs the outputs of all of the signal sources, including players 11, to the user terminals 8 by way of a video cable 17.

Eggers et al. does not teach or suggest the identification encoding means for retrieving the information from the library and for assigning a unique identification code to the retrieved material, as called for in independent claim 1. Eggers et al. also does not teach storage of the requested material at the receiving device prior to replay. Therefore, Eggers et al. does not teach or suggest the buffering step set forth in independent claim 18. Moreover, because the material is sent directly from the filer 2 to the user terminals 8, Eggers et al. does not teach or suggest the storage means called for in independent claim 22.

5. Bestler et al., U.S. Patent Nos. 4,807,023 and 4,755,872

The Bestler et al. patents relate to an "impulse pay per view" system. In the Bestler et al. system, a user can receive a specific cable program by requesting that it be unscrambled at his receiver. The user enters a password which causes the authorization code in his converter to change thereby allowing him to view the desired cable event. See col. 14, lines 58-64 of Bestler et al. '023 and col. 14, lines 49-55 of Bestler et al. '872.

In the Bestler et al. patents, programming is sent directly to the viewer's cable television receiver. Because the requested programming is directly transmitted, neither of the Bestler et al.

patents teaches buffering requested programming. Therefore, neither of the Bestler et al. patents teaches or suggests the preprocessing elements recited in independent claim 1, the buffering step required in independent claim 18, or the storage means called for in independent claim 22.

6. Gordon et al., U.S. Patent No. 4,763,191

The Gordon et al. patent discloses a system providing an "800" dial-a-view program for ordering a selection through a telephone networking arrangement. The Gordon et al. system includes routing database 101 for directing a dial-a-view call received by a toll network switching office 102 to centralized network equipment 103. Vendor equipment 104 supplies the requested subscription television programming to the calling customer television 105 at customer premises 122 via decoder 106 and coaxial cable 160. See Fig. 1 and col. 5, lines 3-23.

Fig. 2 of Gordon et al. shows another embodiment of vendor equipment 104. In this configuration, vendor equipment 104 includes local vendor equipment 201 to serve customer premises 122 via cable 160. Satellite facilities 202 and 203 provide individual programming whereby information is transmitted to the local vendor equipment 201. Equipment 201 includes program distribution equipment 207 and a billing system 208.

In Gordon et al., there is no provision for storage of requested programming before transmission to the user or for storage before the programming is played. Because there is no storage, Gordon et al. does not teach or suggest the preprocessing elements recited in independent claim 1, the buffering step

required in independent claim 18, or the storage means called for in independent claim 22.

7. Southworth et al., U.S. Patent No. 4,400,717

The Southworth patent relates to a color slow-scan TV system and method. The system includes video compressor 25 which receives a color signal from a video input 27. The output of the memory in video compressor 25 is displayed on a TV monitor 29 which indicates the image to be transmitted. The memory is read out slowly and transmitted over a transmission channel 31 to a video expander 33 and displayed at TV monitor 35. See Fig. 1 and col. 2, lines 33-49.

Because Southworth, et al. is concerned with the slow scan, it is not directed to reception and distribution of audio and video information from libraries to remote user locations, as in the present invention.

8. Lambert, U.S. Patent No. 4,381,522

The Lambert patent relates to a cable television system which includes a minicomputer 11 that responds to signals from viewers at remote receiving locations 18. Desired programs are sent only at specified times and only over specified cable channels. See col. 2, line 49 through col. 3, line 18. In Lambert, the subscriber has limited control over when a program will be played because computer 11 assigns a channel, start and stop time for the selected program. Moreover, there is no provision for storage of requested data prior to transmission, or for storage at the receiving device of the user. Accordingly, Lambert does not teach or suggest the preprocessing elements called for in independent

claim 1, the buffering step required in claim 18, or the storage means recited in claim 22.

9. Cannon, U.S. Patent No. 4,122,299

The Cannon patent discloses a data output modifying system. The system places data from a television display into a format for acceptance by a general purpose communications printer. Cannon is not concerned with a transmission, reception or distribution system responsive to user requests for information, as is the present invention.

10. Stetten et al., U.S. Patent No. 3,746,780

The Stetten et al. patent relates to a video display system including a transmission system whereby a subscriber 4 uses telephone 6 to select video display information stored in storage section 30. The information is sent directly to TV receiver 34. There is no provision in Stetten et al. for storing requested information after selection and prior to transmission. Further, Stetten et al. does not show the data sent to TV receiver 34 in a compressed format.

Therefore, Stetten et al. does not teach or suggest a transmission system including the preprocessing elements recited in independent claim 1, or the step of storing audio and video information in a compressed data form, as recited in independent claim 18. Also, there is no provision for storing the requested information at the receiver of Stetten et al. Accordingly, Stetten et al. also does not teach or suggest storage means for storing compressed formatted data, as recited in the receiver system of independent claim 22.

C. REFERENCES CITED IN THE SEARCH REPORT OF 6/19/90

1. Music et al., U.S. Patent No. 4,914,508

The Music et al. '508 patent relates to a method and system for compressing and statistically encoding color video data. Fig. 1 shows a diagram of the system and method for compressing color video data and Fig. 7 shows the system and method for decompressing color video data. Because Music et al. '508 relates only to compression and decompression of color video data, Music et al. '508 is not concerned with a transmission, reception or distribution system responsive to user requests for information, as is the present invention.

2. Okamura et al., U.S. Patent No. 4,907,081

The Okamura et al. patent relates to a compression and coding device for video signals. The object of Okamura et al. is to provide a coding device capable of suppressing signal deterioration (error propagation, etc.) accompanying the coding and of reducing the necessary average number of bits per sampled data. See col. 2, lines 12-16. Okamura et al. is not concerned with a transmission, reception or distribution system responsive to user requests for information, as is the present invention.

3. Golin et al., U.S. Patent No. 4,868,653

The Golin et al. patent relates to an adaptive digital video compression system. Particularly, Golin et al. is directed to meeting the need for a compression system for providing a compressed digital video signal representative of a full motion color video signal which is suitable for recording or transmission using relatively narrow band media and which may be decompressed

at speeds at least equal to conventional video frame rates. See Col. 1, lines 44-50. Because Golin et al. is concerned only with signal compression, Golin et al. is not concerned with a transmission, reception or distribution system responsive to user requests for information, as is the present invention.

4. Music et al., U.S. Patent No. 4,847,677

The Music et al. '677 patent relates to a video telecommunication system and method for compressing and decompressing digital color video data. Fig. 1 shows a diagram of the system and method for compressing color video data and Fig. 7 shows the system and method for decompressing color video data. Because Music et al. '677 relates only to compression and decompression of color video data, Music et al. '677 is not concerned with a transmission, reception or distribution system responsive to user requests for information, as is the present invention.

5. Hirashima, U.S. Patent No. 4,833,710

The Hirashima patent is directed to a pay television system capable of effectively preventing illegal access to certain programming by being charge codes to indicate how much money a subscriber owes, and denying of access to the system unless the bill is paid. In Hirashima, requested programming is sent directly to the television receiver 17. See Fig. 2.

Because Hirashima directly transmits programming, it does not disclose buffering and therefore does not teach or suggest the preprocessing elements recited in independent claim 1, the

buffering step recited in independent claim 18, or the storage means recited in independent claim 22.

6. Keith et al., U.S. Patent No. 4,785,349

The Keith et al. patent relates to a digital video decompression system. Particularly, Keith et al. shows a system for compressing and formatting a full motion color digital video signal. Because Keith et al. relates only to a decompression system, Keith et al. is not concerned with a transmission, reception or distribution system responsive to user requests for information, as is the present invention.

7. Okada et al., U.S. Patent No. 4,734,765

The Okada et al. patent discloses an audio/video information transmission system which includes subscriber terminal 5 from which information is requested and then delivered to and received a TV receiver 52. The subscriber terminal 5 is coupled to sub-center 6 which communicates with center 3 having audio and video files 1. See Figs. 1 and 2

In Okada et al., the subscriber request is processed and the information is sent directly to the subscriber terminal. There is no provision for storage of the requested information prior to transmission or for storage by the user at the receiver so that he for replay at a desired time. Therefore, Okada et al. does not teach or suggest the preprocessing elements recited in independent claim 1, the buffering step required in claim 18, or the storage means called for in independent claim 22.

8. Eilers et al., U.S. Patent No. 4,688,246

The Eilers et al. patent relates to a CATV transmission system for a CATV scrambled signal with compressed digital audio in the horizontal intervals. Because Eilers et al. is only concerned with a transmission system, it does not teach or suggest the steps of the distribution method set forth in independent claim 18 or the receiving system set forth in independent claim 22.

Regarding the transmission system, Eilers et al. sends items directly to users and does not provide for storage of compressed data prior to transmission. Therefore, Eilers et al. does not teach or suggest a transmission system including the preprocessing elements required in the transmission system recited in independent claim 1.

9. Catros et al., U.S. Patent No. 4,679,079

The Catros et al. patent is concerned only with a method and system for bit-rate compression of digital data between a television transmitter and receiver. Catros et al. is not concerned with a transmission, reception or distribution system responsive to user requests for information as in the present invention.

10. Nakajima et al., U.S. Patent No. 4,538,176

The Nakajima et al. patent discloses a video/audio transmission system for sending video and audio information from video and audio files of a center 4 to a subscriber terminal 7. The arrangement includes a sub-center 8 which has a buffer memory 2. See Fig. 2. The information requested from center 4 is

sent to the sub-center 8. In sub-center 8, the video is separated from audio and sent to buffer 25. Audio is decompressed in changeover/output unit 24 and combined with video in combining and output unit 26. The decompressed information is then sent to subscriber terminal 7b over line 5. See Figs. 3 and 6A and col. 4, line 50 through col. 5, line 6.

In Nakajima et al., the subscriber request is processed and the information is sent directly to the subscriber terminal. There is no provision for storage of the requested information prior to transmission to the user or storage by the user so that to replay at a desired time. Therefore, Nakajima et al. does not teach or suggest the preprocessing elements recited in independent claim 1, the buffering step required in claim 18, or the storage means called for in claim 22.

11. Tiemann et al., U.S. Patent No. 4,533,936

The Tiemann et al. patent relates to a system for encoding and decoding video signals to reduce the bandwidth required for transmission thereof over a transmission channel, a broadcast channel or a storage medium. See col. 1, lines 5-9. Because Tiemann et al. is concerned solely with encoding and decoding video signals, that reference is not related to the transmission, reception or distribution system responsive to user requests for information of the present invention.

12. Lovett, U.S. Patent No. 4,450,477

The Lovett patent discloses a television information system wherein a control station 140 sends a unique modulated carrier frequency signal to the subscriber terminal 129 of a user.

Privacy is guaranteed by dedicating a different carrier frequency to each subscriber. There is no provision for storage of the requested information prior to transmission or by the user so that he or she can replay it at a desired time. Therefore, Lovett does not teach or suggest the preprocessing elements recited in independent claim 1, the buffering step required in independent claim 18, or the storage means called for in independent claim 22.

13. Parker et al., U.S. Patent No. 4,009,346

The Parker et al. patent relates to distributional activity compression. Particularly, Parker et al. concerns a modular hierarchical approach to time division multiplex (TDM) switching relative to time division multiplex access (TDMA) facilities, particularly earth satellite TDMA facilities. Parker et al., however does not relate to the transmission, reception or distribution system responsive to user requests for information of the present invention.

14. Flemming, U.S. Patent No. 4,009,344

The Flemming patent relates to interrelated switching, activity compression and demand assignment. Specifically, Flemming concerns an access method and modular station apparatus for switching voice and data signals relative to a TDMA link, especially a satellite. See col. 3, lines 3-5. Flemming is not related to the transmission, reception or distribution system responsive to user requests for information of the present invention.

15. Jackson et al., U.S. Patent No. 3,599,178

The Jackson et al. patent relates to a method of storing information on and retrieving information from a magnetic drum. Jackson et al. employs selective mapping of information on a magnetic drum to permit rapid access and retrieval. Because Jackson et al. is concerned only with the storage of information, Jackson et al. does not relate to the transmission, reception or distribution system responsive to user requests for information of the present invention.

D. OTHER REFERENCES

1. Cohen, U.S. Patent No. 4,949,187

The Cohen patent relates to a video communication system having a remotely controlled central source of video and audio data. Cohen shows a block diagram of the remotely-controlled central source of video and audio data. Disks 12, 14, 16, 18, 20, 22, 24, and 26 store frequently accessed movies. The disks are read by drives controlled by a disk controller 28, 30. Movies that are only accessed infrequently are archived on a tape archival system 32 which is controlled by tape driver 34. The distribution system CPU 36 controls the bidirectional flow of data from disks 12-26 and tape archival system 32. See col. 1, lines 1-18.

In order to output a plurality of movies simultaneously, several controllers 42, 44, 46, and 48 are used which output signals to multiplexor 58 for transmission over telephone line 60. See Fig. 4 and col. 4, lines 30-46. Cohen does not teach that the information transmitted over telephone line 60 is compressed, and

therefore does not teach or suggest compression means for compressing formatted and sequenced data or the compressed data storage means for storing as a file the compressed, sequenced data, as recited in the transmission system of independent claim 1. Cohen also does not teach or suggest the step of storing audio and video information in a compressed data form, as recited in the distribution method of independent claim 18.

Figs. 1-3 of Cohen show the receiving device. Incoming serial data on phone line 112 is processed by modem 110 and is forwarded by central processing unit 104 to the disk storage system 114 via disk controller 116. Cohen does not indicate that the incoming signals are received in a compressed format. Because Cohen does not receive the signals in a compressed format, Cohen also does not teach or suggest the decompressing means for decompressing the compressed formatted data, as recited in the receiving system of independent claim 22.

2. Yabiki et al., U.S. Patent No. 4,518,989

The Yabiki et al. patent is commonly assigned to the assignee of the Okada et al. and Nakajima et al. patents. Yabiki et al. shows a plurality of repeaters 6 between center 4 and sub-center 8 and between sub-center 8 and subscriber terminal 7. In Yabiki et al., a subscriber request is processed and the information is sent directly to the subscriber terminal. There is no provision for storage of the requested information prior to transmission or by the user so that he or she can replay it at a desired time. Therefore, Yabiki et al. does not teach or suggest the preprocessing elements recited in independent claim 1, the

buffering step required in independent claim 18, or the storage means called for in independent claim 22.

3. Abraham, U.S. Patent No. 4,567,512

The Abraham '512 patent discloses a recorded program communication system. In this system, subscribers communicate with a library computer 28 via a telephone connection. The telephone system 12 is coupled to a command unit 24 from which the subscriber enters his or her choices. With command terminal unit 24, the subscriber has access to information in the library station 18 and provides billing information to the billing station 27. See col. 4, lines 45-49.

By using command unit 24, the subscriber enters selection data obtained from a printed program guide which identifies each program in the library and its associated program number. Based on the same program guide, the subscriber selects one of the available time segments for the selected program. See col. 7, lines 24-32 and Fig. 3. With the system in Abraham '512, the subscriber may not change the time a program can be viewed. This is because there is no provision for storage of the requested program prior to transmission or for storage at the receiving device of the user. Therefore, Abraham does not teach or suggest the preprocessing elements recited in independent claim 1, the buffering step required in independent claim 18, or the storage means called for in independent claim 22.

4. Abraham, U.S. Patent No. 4,521,806

Abraham '806 relates to a method of generating and processing audio/video broadcast signals in a subscription communication

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system. In Abraham '806, as with Abraham '512 and '516, the requested information is not stored prior to transmission and the subscriber cannot store the requested information at his or her station. Therefore, the subscriber can only receive information substantially simultaneously to the request for it. Because requested information is not stored prior to transmission or at the user's receiving device, Abraham '806 does not teach or suggest the preprocessing elements recited in independent claim 1, the buffering step required in independent claim 18, or the storage means called for in independent claim 22.

5. Bushnell et al., U.S. Patent No. 4,071,697

The Bushnell et al. patent relates to an interactive video/telephone transmission system wherein a user can view merchandise information at home. The system includes a capability of calling particular stores offering the viewed merchandise to registering a request to purchase selected merchandise. The user does not receive anything at his receiver 12 in response to his request to purchase selected merchandise. Rather, in Bushnell et al., the user simply views merchandise and then calls a store to order that merchandise.

6. Zeidler et al., U.S. Patent No. 4,062,043

The Zeidler et al. patent relates to a light wave transmission and distribution system in which at least one optical transmitter is used to distribute television programming to a plurality of receivers through light conducting fibers.

7. Ohrenstein

The Ohrenstein article describes a data storage system with a high performance parallel interface (HPPI).

8. Morreale et al.

The Morreale et al. article discusses metropolitan-area networks (MAN).

CONCLUSION

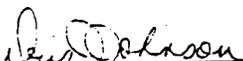
None of the references renders the pending claims invalid under 35 U.S.C. § 103. Furthermore, there is no reasonable combination of references which can be combined under 35 U.S.C. § 103 to render the pending claims obvious to a person of ordinary skill.

The requirements of M.P.E.P. §708.02 (VIII) having been met, and the pending claims being allowable over the references, Applicants request that this Petition to Make Special be granted and that claims 1-32 of this application be passed to issue as quickly as possible.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER

By:

  
Doris J. Johnson  
Reg. No. 34,629

Dated: June 17, 1991

# **EXHIBIT 3**

PATENT  
Attorney Docket No. 02473.0001-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of  
Paul Yurt, et al.  
Serial No. 07/637,562  
Filed: January 7, 1991  
For: AUDIO AND VIDEO TRANSMISSION  
AND RECEIVING SYSTEM  
Hon. Commissioner of Patents  
and Trademarks  
Washington, DC 20231

Group Art Unit: 262

Examiner: R. Smith

RECEIVED  
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GROUP 260

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*10-28-91*  
*J. A. [unclear]*  
*[unclear]*  
*[unclear]*

Sir:

AMENDMENT

In response to the Office Action dated August 29, 1991, the period of response to which extends through November 29, 1991, please amend the above captioned application as follows.

IN THE SPECIFICATION:

Page 9, line 9, change "systema" to --systems--.

Page 11, line 3, change "is" to --as--;

line 7, change "send a movie" and insert --have a movie sent--; and

line 14, after "items" insert --for--.

Page 13, line 25, change "communicated" to

--communicate--.

Page 14, line 15, change "the any of" to --any of the--.

Page 16, line 14, after "such" insert --as in--; and

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In view of the arguments presented above, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 7 and 18-21 under 35 U.S.C. § 103 over Lang in view of Fenwick et al.

By this Amendment, Applicants have added new claims 33-58. Claim 33 depends from independent claim 1 and further defines the conversion means. Claims 34 and 35 each depend from claim 18 and recite respectively aspects of Figs. 1d and 1f. Specifically, claim 34 sets forth that information may be buffered at the head end of a cable television reception system 200 and claim 35 recites that information is buffered at an intermediate storage device 200'.

Claim 36 depends from claim 22 and further defines the source material library of the reception system defined in claim 22. Specifically, claim 36 includes a recitation that a request may be made by a user from a compressed data library, as set forth at page 29, lines 8-11 of Applicants' specification.

Claims 37 and 38 also depend from claim 22 and separately recite the limitations of claim 27. Similarly, claims 39 and 40 depend from claim 22 and separately recite the limitations of claim 30.

New independent claim 41 claims a transmission method, claim 47 a distribution system, and claim 54 a receiving method. Claims 41, 47, and 54, respectively track independent claims 1, 18, and 22. Dependent claims 42, 43, 45, 46, 48, and 55-57, respectively, correspond generally to

claims 3, 4, 6, 7, 19, 26, 29, and 31. Dependent claims 44, 49, 53, and 58, respectively, correspond generally to new dependent claims 33, 34, 35, and 36. New claims 50-52, which depend from new independent claim 47, further define the head end of the cable television system shown in Fig. 1f.

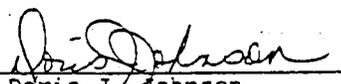
For the reasons set forth above with respect to claims 1, 18, and 22, independent claims 41, 47, and 54, and the claims which depend variously therefrom are allowable over Lang and over Lang in view of Fenwick et al.

In light of the remarks made above, Applicants respectfully request reconsideration and withdrawal of the objection under 37 C.F.R. § 1.75(c) and the rejections under 35 U.S.C. §§ 102(e) and 103, allowance of pending claims 1-58, and issuance of a Notice of Allowance in this case.

If any fees are due in connection with the filing of this Amendment, the Commissioner is hereby authorized to charge any such fees to our Deposit Account No. 06-916. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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GARRETT & DUNNER

By:   
Doris J. Johnson  
Reg. No. 34,629

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Dated: September 30, 1991



1 **PROOF OF SERVICE**

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3 18 and not a party to this action; my current business address is **2029 Century Park  
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27 \_\_\_\_\_  
28 **Janet E. Weems**