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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID R. CHILUK, LOGAN S. GABRIEL,
ERIC R. KERN, MICHAEL S. ROLLINS,
PAUL K. SCRUTTON, JANA E. V. SIMONS,
TOREZ SMITH, DAVID R. WOODHAM, and
TONG YU

Appeal 2010-011248
Application 11/733,461
Technology Center 2400

Before JOSEPH L. DIXON, ST. JOHN COURTENAY III, and
CARLA M. KRIVAK, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1-21. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

The invention is directed to “merging a codec with a digital media file and playing a digital media file on a playback device” (Spec. 1:13-14).

Claim 1, reproduced below, is representative of the claimed subject matter:

1. A method of merging a codec with a digital media file, the method comprising:

receiving, by a digital media provider from a playback device through a data communications network, a request for the digital media file, the digital media file comprising digital media content encoded by a codec;

identifying, by the digital media provider, the codec by which the digital media content was encoded;

inserting, by the digital media provider, the codec into the digital media file;

distributing the digital media file with the inserted codec to the playback device through the data communications network.

REFERENCE

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Agrawal

US 6,570,926 B1

May 27, 2003

REJECTIONS

Claims 19-21 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1, 3-6, and 8-21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Agrawal.

Claims 2 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Agrawal.

ANALYSIS

The Non-Statutory Subject Matter Rejection

Appellants contend that claim 19 is statutory because “[t]he digital media file of claim 19 imparts to a playback device the codec required to decode the encoded digital media file and therefore imparts to a playback device the functionality of playing back the digital media content” (Br. 5).

We agree with the Examiner that claim 19 is directed to non-statutory subject matter for the reasons discussed in the Answer, namely, that the claimed digital media file has no functional relationship to a computer or computing device (Ans. 3, 16). In other words, even considering that the digital media file contains a codec, which is software (*see* Spec. 5:10-13), the digital media file is software *per se*, which is non-statutory subject matter. *See* MPEP § 2106(I) (“examples of claims that are not directed to one of the statutory categories: . . . a computer program *per se*”) (citing *Gottschalk v. Benson*, 409 U.S. 63, 72 (1972)).

We are, therefore, not persuaded that the Examiner erred in rejecting claim 19 and claims 20-21 not separately argued.

The Anticipation Rejection

Appellants contend:

Agrawal simply sends contemporaneously in packets a video stream and decoding software for the video stream. Packetizing a video stream and packetizing decoding software and sending those packets contemporaneously is not in any way inserting a codec into a digital media file itself as claimed in the present application. Agrawal never discloses or even contemplates inserting the codec into the digital media file itself. Furthermore, Agrawal does not ensure that the digital media content encoded by the codec are always together on the playback device.

(Br. 7).

Agrawal describes the following:

Segmentation device 1620 partitions the stored video data file into data sub-files for transmission as data packets in active packets 731. When the active packets (e.g., packets 731) are assembled by active packetizer 735, the deduced program code used to decode the video data is injected into the program packet portion of the active packets along with the discerned parameters.

(Agrawal, col. 14, ll. 53-59). We agree with the Examiner (*see* Ans. 16-17) and find that, after Agrawal's video data file is packetized for transmission, the sequence of packets represents the video data file such that injecting the decoder program into the packets meets the claim 1 limitation "inserting, by the digital media provider, the codec into the digital media file." Further, we agree with the Examiner (*see* Ans. 17) that Appellants' argument that "Agrawal does not ensure that the digital media content encoded by the codec are always together on the playback device" (Br. 7) is unavailing because no such limitation is recited in claim 1.

We are, therefore, not persuaded that the Examiner erred in rejecting claim 1 and claims 3-6 and 8-21 not separately argued.

The Obviousness Rejection

Appellants rely on the arguments presented for claims 1 and 6, from which claims 2 and 7 depend, and present no new arguments for claims 2 and 7 (*see* Br. 8). We are, therefore, not persuaded that the Examiner erred in rejecting claims 2 and 7 for the reasons discussed above.

CONCLUSIONS

The Examiner did not err in rejecting claims 19-21 under 35 U.S.C. § 101.

The Examiner did not err in rejecting claims 1, 3-6, and 8-21 under 35 U.S.C. § 102(b).

The Examiner did not err in rejecting claims 2 and 7 under 35 U.S.C. § 103(a).

DECISION

For the above reasons, we affirm the rejections of claims 1-21.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

peb