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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALI AYDAR, JORDAN MENDELSON,
and SHAWN FANNING

Appeal 2012-004196
Application 11/314,752¹
Technology Center 3600

Before, JOSEPH A. FISCHETTI, MICHAEL C. ASTORINO, and
NINA L. MEDLOCK, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 26–30 and 47–63. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ Appellants identify MySpace Music LLC as the real party in interest. Appeal Br. 2.

THE INVENTION

Appellants' claims are directed to a method of regulating downloading and other machine reproductions of digitally stored memory contents based on the rights of the owners of the content. Spec. ¶ 2.

Claim 26 reproduced below, is representative of the subject matter on appeal.

26. A method of managing online digital rights and files, comprising:

providing a database of file information including ownership rights with respect to sound recording and rules associated with a specific file of rights holder, the file information further including a title, a performer, a category of the specific file, and restrictions for digital rights management purposes;

accessing the file information for the specific file;
receiving an update to the file information including the ownership rights and rules associated with the specific file; and
storing the updated file information.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Ginter US 5,892,900 Apr. 6, 1999

The following rejections are before us for review.

Claims 26–30 and 47–63 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 26–30 and 47–63 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 26–30 and 47–63 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginter.

FINDINGS OF FACT

1. We adopt the Examiner’s findings as set forth on pages 7–12 of the Answer.

2. Ginter discloses:

Each event record 872 may be a set of instructions to be executed by the end user’s electronic appliance 600 to make an addition or modification to the end user’s secure database 610, for example. Events can perform many basic management functions, for example: add an object to the object registry, including providing the associated user/group record(s), rights records, permission record and/or method records; delete audit records (by “rolling up” the audit trail information into, for example, a more condensed, e.g. summary form, or by actual deletion); add or update permissions records 808 for previously registered objects; add or update budget records; add or update user rights records; and add or update load modules.

Col. 142, ll. 13–26.

3. Ginter discloses that a

. . . catalog is used to record information related to the VDE content in content storage, and/or content available through the repository reflected in content references. The content catalog 3322 may consist of titles of content, abstracts, and other identifying information. In addition, the catalog may also indicate the forms of electronic agreement and/or agreement VDE template applications (offering optional, selectable control

structures and/or one or more opportunities to provide related parameter data) that are available to end users 3310 through the repository for given pieces of content in deciding, for example, options and/or requirements for: what type(s) of information is recorded during such content's use, the charge for certain content usage activities, differences in charges based on whether or not certain usage information is recorded and/or made available to the repository and/or content provider, the redistribution rights associated with such content, the reporting frequency for audit transmissions, the forms of credit and/or currency that may be used to pay certain fees associated with use of such content, discounts related to certain volumes of usage, discounts available due to the presence of rights associated with other content from the same and/or different content providers, sales, etc.

Col. 314, ll. 29–52.

4. Ginter discloses a content system having:

. . . general search characteristics should be associated with content submissions (e.g. whether abstracts should be automatically indexed for searches by users of the repository, the manner in which content titles, abstracts, promotional materials, relevant dates, names of performers and/or authors, or other information related to content submissions may or should be used in lists of types of content and/or in response to searches, etc.), and/or

how content that is stored at and/or passed through the repository should be shipped (including any container criteria, encryption requirements, transaction requirements related to content transmissions, other control criteria, etc.)

Col. 310, ll. 23–37.

5. Ginter discloses “that Author 3306A provide[s] information concerning the types and/or categories of content proposed for storage and access using the repository. . . .” Col. 310, ll. 7–9.

6. Ginter discloses:

Author 3306A transmits a message to the repository 3302 indicating her desire to register with the repository to distribute her content. In response to this message, the user/author registration system 3320 of the content system 3302A, and the user/author registration system 3338 of the clearinghouse system 3302B transmit requests for registration information to author 3306A using the network 3304.

Col. 309, ll. 59–65.

7. Ginter discloses: “[w]hen an end user makes use of container content, their content usage information may, for example, be segregated in accordance with control structures that organize usage information based at least in part on the author who created that segment.” Col. 319, ll. 36–40.

8. The Examiner found with respect to the 35 U.S.C. § 101 rejection:

In the instant application, Appellant’s [sic] method step fails the first prong of the new test because there is no tie to any kind of machine for any of the claimed step[s]. Specifically, the steps of “providing”, “accessing”, “receiving”, and “storing” does [sic] not require the use of a machine. Rather, the method step could be performed by a person with human mind. Therefore, the claims do not pass the first test of Bilski with respect to providing a tie to a particular machine.

(Answer 13).

9. The Examiner found with respect to the 35 U.S.C. § 101 rejection:

. . . Appellant's [sic] method step fails the second prong of the test because the claimed step does not result in an article being transformed from one state to another. Contrary to the Appellant's [sic] assertion, there is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances. The Appellant [sic] does not present argument as to why the steps of providing, accessing, receiving, and storing represent a transformation of a physical object or substance. Contrary to the Appellant's [sic] assertion, Examiner finds that there is no transformation occurring in the claim for a physical object or substance, or an article representative of a physical object or substance, to a different state or thing.

(Answer 14).

10. The Examiner found with respect to the 35 U.S.C. § 101 rejection:

Additionally, other factors and considerations in addition to the machine/transformation test also point to a finding that the claims are directed to a mere abstract idea. The claims seem to be a mere statement of a general concept of storing information to a file. The claims if allowed would appear to effectively grant a monopoly on this broad concept claimed in the method. Moreover, steps of the method, as claimed, could be performed by any currently known or future manner of storing update information to a file, or even done by human beings because no machine is recited in the claims (i.e., if the machine is not inherently required, a human user could perform the steps manually "on" a computer or similar device). When viewing these factors and the

claims as whole, it is concluded that the claims are directed to a mere abstract idea and are not patent eligible under 35 USC 101.

(Answer 14).

ANALYSIS

35 U.S.C. § 101 REJECTION

We will affirm the rejection of claims 26–30 and 47–63 under 35 U.S.C. § 101.

The Examiner found “. . . there is no tie to any kind of machine for any of the claimed step[s]. Specifically, the steps of ‘providing’, ‘accessing’, ‘receiving’, and ‘storing’ does [sic] not require the use of a machine.” (FF. 8). The Examiner also found “. . . that there is no transformation occurring in the claim for a physical object or substance, or an article representative of a physical object or substance, to a different state or thing.” (FF. 9).

Accordingly, the Examiner found, “[w]hen viewing these factors and the claims as whole, it is concluded that the claims are directed to a mere abstract idea and are not patent eligible under 35 USC 101.” (FF. 10).

We agree with the Examiner’s ultimate findings that claim 26 is drawn to an abstract idea. (FF. 10).

Independent claim 26, the only independent claim before us, recites, in pertinent part, the steps of,

providing a database of file information including ownership rights with respect to sound recording and rules associated with a specific file of rights holder, the file information further including a title, a performer, a category of the specific file,

*and restrictions for digital rights management purposes;
accessing the file information for the specific file;
receiving an update to the file information
including the ownership rights and rules
associated with the specific file; and
storing the updated file information.*

The Supreme Court has

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, we then ask, “[w]hat else is there in the claims To answer that question, [] consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. [The Court] described step two of this analysis as a search for an “inventive concept”—*i.e.*, an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”

Alice Corp. Pty. Ltd. v CLS Bank Int’l., 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012) (citations omitted).

We must first determine whether the claims at issue are directed to a patent-ineligible concept. We conclude that they are. As found *supra* (FF. 8–10), the Examiner, in applying the *Bilski* factors², found that the

² The test under the Federal Circuit’s formulation to determine whether a

substantive portions of claim 26 do not cover a machine or apparatus, nor do they transform the underlying subject matter to a different state or thing. (FF. 8, 9). Although *Bilski* is no longer controlling in light of *Alice*, the Examiner’s findings above are nevertheless useful factors in our analysis under *Alice*. The Court found in *Alice* that it need not labor to delimit the precise contours of the “abstract ideas” category in that case. *See Alice Corp.* 134 S. Ct. at 2357.

We, thus, agree with the Examiner’s findings (FF. 8–10) that claim 26 is drawn to the abstract idea of using a database to access, update data and store updated data in the database file, a thought process we, as humans, have practiced since early in time, namely, refreshing our memories with the latest information. It follows from the Supreme Court’s prior cases, and *Bilski* in particular, that the claims at issue here are directed to an abstract idea. On their face, the claims before us are devoid of substantial ties to a machine or apparatus³ (FF. 8). Rather, the claims cover the simple concept of updating a memory. Like the risk hedging in *Bilski*, the concept of updating a memory is a fundamental practice to our understanding of how

claimed process recites patentable subject matter under § 101 is if: “(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Bilski v Kappos*, 561 U.S. 593, at 600 (2010) (citing *In re Bilski*, 545 F.3d 943, 959–60 (Fed. Cir. 2008)).

³ Claim 26 recites a “database.” Although a database can be arranged data in a computer memory, such computer components are not required by its definition: “a usually large collection of data organized especially for rapid search and retrieval (as by a computer).”

<http://www.merriam-webster.com/dictionary/database> (last visited, Mar. 23, 2015). Thus, in our view, even data arranged in a file cabinet is a database.

information is kept and maintained. Thus, the idea of updating a memory, like hedging, is an “abstract idea” beyond the scope of § 101.

We further find that the introduction of the word “digital” recited in claim 26 does not alter the analysis at *Mayo* step two, and does not transform the abstract idea of monitoring and compensating for the sale of content, into a patent-eligible invention. The mere recitation of the content in digital form does not add any meaningful limitation beyond generally linking the abstract method to a general purpose computer. *See Alice Corp.*, 134 S. Ct. at 2350. Adding a nominal recitation of content in computer readable form is insufficient to make a claim patent-eligible. *See Bancorp Servs. v. Sun Life Assurance Co.*, 687 F.3d 1266, 1278 (Fed. Circ. 2012). *See also Mayo*, 132 S. Ct. at 1293 (a claim cannot simply state the abstract idea and add the words ““apply it.””)

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea [] on a generic computer.” *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2359. They do not. In fact, the digital form of the content does not control the core steps of the claims, but rather speaks only to the type of medium in which the content is fixed; be it on paper, or encoded in an electronic medium, for purposes of this analysis, the difference is not distinguishable.

We, therefore, agree with the Examiner’s ultimate finding that claims 26–30 and 47–63 are drawn to an abstract idea.

35 U.S.C. § 112 REJECTION

We will not sustain the rejection of claims 26–30 and 47–63 under 35 U.S.C. § 112 for the reasons given by the Appellants on page 5 of the

Appeal Brief. Specifically, we find that the antecedent basis for “updated file information” is properly based on the phrase, “receiving an update to the file information.”

We do not agree with the Examiner’s finding that the claims fail to “positively recite updating the file information with the received update information,” because the concern is a matter of claim breadth, not indefiniteness. “Breadth is not indefiniteness.” *In re Gardner*, 427 F.2d 786, 788 (1970).

35 U.S.C. § 103 REJECTION

The Appellants argued claims 26–30 and 47–63 as a group. (Appeal Br. 5). We select claim 26 as the representative claim for this group, and the remaining independent claims stand or fall with claim 26. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

Claim 26 recites in pertinent part, “*providing a database of file information including ownership rights with respect to sound recording and rules associated with a specific file of rights holder, the file information further including a title, a performer, a category of the specific file, and restrictions for digital rights management purposes.*”

The Examiner found that Ginter discloses this limitation at:

(see col. 18, lines 56–64, a distribution model including content delivery from an Internet repository; col. 141, lines 5–35; col. 293, lines 50–66, maintaining of online catalog of collection of requirement records and descriptive information of objects for distribution; col. 1 line 307/15–308/61, repository where contents are kept for distribution; col. 1 lines 309/25–321/4, repository used for storing and distributing content, registration

information including types/categories of the content, content title, content abstracts, content promotional materials, relevant dates, names of performers and/or authors, and how the content should be distributed, e.g. container criteria, encryption requirements, transaction requirements, other control requirements)

(Answer 7–8).

Appellants argue,

Applicant [sic] respectfully asserts that Ginter merely illustrates in Fig. 7 that “ROS 602 may also manage secure database 610 and a storage device (e.g., ‘secondary storage’ 652) used to store secure database 610” (Col. 63, lines 36–39 — emphasis added). However, the mere disclosure of a secure database 610, as in Ginter, simply fails to specifically suggest applicant’s claimed “providing a database of file information including ownership rights with respect to a sound recording and rules associated with a specific file of a rights holder, the file information further including a title, a performer, a category of the specific file, and restrictions for digital rights management purposes” (emphasis added), as claimed.

(Appeal Br. 6).

We disagree with Appellants. We find that although the Appellants’ arguments do cover in rebuttal some of the sections of Ginter which were cited to by the Examiner concerning database 610, the Examiner also cited to additional sections of Ginter, particularly, column 309, line 25 to column 321, line 4, disclosing a content repository (Answer 7), to which the Appellants do not respond. That is, Appellants’ “mere disclosure of a secure database 610” argument fails because it ignores the disclosure in Ginter at

column 309, line 25 to column 321, line 4, which discloses a content repository which meets the claim requirements.

Based on Ginter's disclosed content repository alone (FF. 2–7), we find that the Examiner established a prima facie case of obviousness for the rejection for the following reasons. We find that Ginter explicitly discloses that the content repository and related information “consist of titles of content, abstracts, and other identifying information.” (FF. 3). We find that items such as, title, and performer, are identifying information. We further find that the claim requirement of “category of the specific file” is met by Ginter disclosing, “Author 3306A provide[s] information concerning the types and/or categories of content proposed for storage.” (FF. 5). Moreover, Ginter discloses recording the named author (FF. 4) and specifying redistribution rights, both of which qualify as evidence of the required *ownership rights*. Ginter further discloses determining “what type(s) of information is recorded during such content's use” (FF. 3), which we find meets the claim requirement of *rules associated a specific file of a right holder*. Against these findings, Appellants offer no arguments.

Appellants do argue that Ginter fails to disclose “receiving an update to the file information including the ownership rights and rules associated with the specific file.” (Appeal Br. 6).

We disagree with Appellants. We find Appellants' Specification does not specifically define the term “update”, nor does it utilize the term contrary to its customary meaning. The ordinary and customary definition of the term “update” is: “to give (someone) the most recent information about

something.”⁴ We thus find the registration information which is transmitted to the repository 3320 by the author via the registration transmission (FF. 5, 6) is an update because it gives the repository the most recent information on ownership rights and rules associated with a specific file. (FF. 4).

Appellants also argue that Ginter fails to disclose, “wherein the rules associated with the specific file relate to a format of a track included in the specific file.” (Appeal Br. 7).

We disagree with Appellants because Ginter explicitly discloses relating content usage information in accordance with control structures that organize usage information based at least in part on the author who created that segment or track. (FF. 7). In other words, Ginter discloses author specified rules including how the involved segment of the work is to be formatted. (FF. 2–4).

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 26–30 and 47–63 under 35 U.S.C. § 101.

We conclude the Examiner erred in rejecting claims 26–30 and 47–63 under 35 U.S.C. § 112, second paragraph.

We conclude the Examiner did not err in rejecting claims 26–30 and 47–63 under 35 U.S.C. § 103(a).

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).

⁴ <http://www.merriam-webster.com/dictionary/update> (last visited Mar. 10, 2015).

Appeal 2012-004196
Application 11/314,752

DECISION

For the above reasons, the Examiner's rejection of claims 26–30 and 47–63 is AFFIRMED.

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

AFFIRMED

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