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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/315,760	12/19/2005	David Haslam	050202	2118
90893	7590	02/17/2015	EXAMINER	
AT&T Legal Dept. GGGV Attention: Patent Docketing Room 2A-212 One AT&T Way Bedminster, NJ 07921			KEEHN, RICHARD G	
			ART UNIT	PAPER NUMBER
			2456	
			MAIL DATE	DELIVERY MODE
			02/17/2015	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DAVID HASLAM

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Appeal 2012-011902  
Application 11/315,760  
Technology Center 2400

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Before ST. JOHN COURTENAY III, THU A. DANG, and  
LARRY J. HUME, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–7 and 9–21, which are all the claims pending in the application. Claim 8 is cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

*Invention*

The claimed invention on appeal pertains to providing podcast content, “wherein the podcast content is categorized into various topics, and the podcast file includes podcast content of a particular topic”. (Spec. ¶ 2; claim 1).

*Representative Claim*

Independent claim 1 is representative of the rejected claims on appeal:

1. A remote server for providing podcast content and other content distinct from the podcast content, comprising:

an interface for providing a network connection;  
storage including a podcast file including the podcast content, wherein the podcast content includes podcast content received from at least one subscriber computing device, [a] *wherein the podcast content is categorized into various topics, and the podcast file includes podcast content of a particular topic;*

a processor for receiving the podcast file, wherein the processor, in response to receiving requests to download the podcast file, retrieves the podcast file from storage and [b] *provides the podcast file with the other content distinct from the podcast content for the particular topic of the podcast content included in the podcast file via the network connection, wherein the other content distinct from the podcast content is inserted in the podcast file once a request to download the podcast file is received.*

(Contested limitations [a], [b] lettered and emphasized.)

*Rejection*

Claims 1–7 and 9–21 stand rejected under 35 U.S.C. § 103(a) as being obvious over the combined teachings and suggestions of Jones (US 2006/0265503 A1; published Nov. 23, 2006), Plotnick (US 2005/0097599

A1; published May 5, 2005), and Marriott (US 2006/0265637 A1; published Nov. 23, 2006).<sup>1, 2</sup>

### *Grouping of Claims*

Based on Appellant's arguments, we decide the appeal of all rejected claims, except claim 20, on the basis of representative claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv)(2012). We address claim 20 separately, *infra*.

### *Contentions*

Appellant advances two principal contentions:

1. **No combination of Jones, Plotnick and Marriot[t] teaches that podcast content is categorized into various topics. and the podcast file includes podcast content of a particular topic.** (App. Br. 7 regarding contested limitation [a]).
2. **No combination of Jones. Plotnick and Marriot[t] teaches providing the podcast file with the other content distinct from the podcast content for the particular topic of the podcast content included in the podcast file.** (App. Br. 9 regarding contested limitation [b]).

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<sup>1</sup> Appellant filed a Notice of Appeal on January 25, 2012. The date of filing the Notice of Appeal determines which set of rules applies to an ex parte appeal. If a Notice of Appeal is filed on or after January 23, 2012, then the 2012 version of the Board Rules (Title 37 of the Code of Federal Regulations (37 C.F.R. § 41.1 et seq.)) published on November 22, 2011 in the Federal Register notice applies to the appeal.

<sup>2</sup> We note both the Appellant and the Examiner have consistently misspelled the first-named inventor of the Marriott et al. Patent Application Publication (US 2006/0265637 A1) as "Marriot" (with a single "t").

Regarding contested limitation [A], the Examiner finds:

*if the podcast content as claimed is categorized into various topics, it contains at least two particular topics.* Now if the same podcast content is included in the podcast file as claimed, then the podcast file *must necessarily* also contain the at least two particular topics, one of which would be “a particular topic.” As discussed above, Marriot[t] discloses the same in ¶ [0071].

(Ans. 3–4, emphasis added).

In the Reply Brief, Appellant further responds:

While *Appellant agrees that Marriot[t] discloses a podcast category as one of various selectable categories of audio information and that a podcast can be segmented into different chapters as transitions between topics*, this is not the same as categorizing podcast content into various topics ... the podcast file including content of a particular topic as set forth in claim 1. As argued in the Appeal Brief (page 8), the only categorization that Marriot[t] refers to is categorization of audio information (with podcasts being one among various categories). As to the Examiner's allegation that that "transitions between topics" as taught by Marriot[t] indicates at least two different topics, each having content nature different than the other, the Examiner makes this allegation *without offering an explanation as to why segmenting podcasts into different chapters would necessarily mean that the podcast content is categorized into various topics as claimed*. Moreover, contrary to the Examiner's reasoning, it does not necessarily follow that having a podcast segmented into *different chapters as transitions between topics, as described in Marriot[t]*, means that podcast content is categorized into various topics, nor is it necessary that different chapters relate to different topics. There is nothing in Marriot[t] that demonstrates that a podcast needs to be segmented into different chapters having different topics, nor is there any indication in Marriot[t] that podcasts are categorized into various topics. Rather, Marriot[t] simply indicates that a podcast may be segmented into different chapters, with no

indication that those different chapters must relate to different topics.

(Reply Br. 2–3, emphasis added).

## ANALYSIS

### *Rejection A of Representative Claim 1*

**Issues:** Under § 103, did the Examiner err by finding the cited prior art would have collectively taught or suggested the following contested limitations (lettering added):

[a] wherein the podcast content is categorized into various topics, and the podcast file includes podcast content of a particular topic;

[b] provides the podcast file with the other content distinct from the podcast content for the particular topic of the podcast content included in the podcast file,  
within the meaning of representative claim 1?

### *Claim Construction*

As an initial matter of claim construction, a question arises as to how much patentable weight, if any, should be given to the contested *functional* limitations recited in apparatus claim 1, e.g., “wherein the podcast content is *categorized* into various topics” and “wherein the processor . . . *provides* the podcast file . . . .”<sup>3</sup> Further, a question arises as to how much patentable

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<sup>3</sup> Although the preamble of claim 1 is directed to a remote server (which we broadly but reasonably construe as an apparatus), we note the claim is silent regarding what specific element of the apparatus performs the function of categorizing the podcast content into “various topics.” Presumably the

weight, if any, should be given to the contested *data limitations* recited in apparatus claim 1, e.g., “the podcast *content is categorized into various topics*, and the podcast file includes *podcast content of a particular topic*” and “wherein the processor . . . provides the podcast file with *the other content distinct from the podcast content for the particular topic of the podcast content included in the podcast file.*” (emphasis added).

Appellant urges us to distinguish the *apparatus* (structure) of representative claim 1 over the cited prior art structure(s) merely in terms of recited intended *functions* and the particular arrangement or organization (e.g., “various topics”) of the podcast content (*data*).<sup>4</sup> (App. Br. 6–10). We particularly note the contested limitations are recited within “wherein clauses” that do not further limit the *structure* of the claimed apparatus.<sup>5</sup>

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podcast content has already been “categorized into various topics” by some unknown apparatus or method external to (and outside the scope of) the “remote server” of claim 1. Regarding this issue, and in the event of further prosecution, we leave it to the Examiner to consider whether a rejection under 35 U.S.C. § 112, second paragraph, would be applicable to at least claim 1 and associated dependent claims.

<sup>4</sup> “An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates.” *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed.Cir. 2003). Although “[s]uch statements often . . . appear in the claim's preamble,” *In re Stencel*, 828 F.2d 751, 754 (Fed. Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

<sup>5</sup> See MPEP § 2111.04 regarding “wherein” clauses: Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, *or by claim language that does not limit a claim to a particular structure*. However, examples of claim language,

Our reviewing court guides the patentability of an apparatus claim “depends on the claimed structure, not on the use or purpose of that structure.” *Catalina Marketing Int’l., Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002). “It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citations omitted). *See also Superior Indus., Inc. v. Masaba, Inc.*, 553 Fed. Appx. 986, 991 (Fed. Cir. 2014) (Rader, J., concurring) (stating: “[A] system claim generally covers what the system is, not what the system does.”<sup>6</sup> *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990); *see also Roberts v. Ryer*, 91 U.S. 150, 157 (1875) (“The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not.”). Thus, it is usually improper to construe non-functional claim terms in system claims in a way that makes infringement or validity turn on their function. *Paragon Solutions, LLC v. Timex Corp.*, 566 F.3d 1075, 1091 (Fed. Cir. 2009). *See also* MPEP 2114.

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although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are: (A) "adapted to" or "adapted for" clauses; (B) "wherein" clauses; and (C) "whereby" clauses. (MPEP §2111.04 Eighth Edition, Rev. 9, Aug. 2012, emphasis added).

<sup>6</sup> *Superior Indus., Inc. v. Masaba, Inc.*, 553 Fed. Appx. 986 (Fed. Cir. 2014) is a non-precedential opinion of the Court of Appeals for the Federal Circuit. However, we consider the concurring opinion by former Chief Judge Rader as guiding because it cites precedential authority in support.

Moreover, because Appellant has not contested any *specific structural differences* between the apparatus of claim 1 and the corresponding structure(s) found in the cited references, the only purported differences between representative claim 1 and the corresponding apparatus structure found in the cited prior art turns on the *content* or *organization* of *data* (i.e., “podcast content [which is] categorized into various topics” as recited in claim 1). See contested limitations [a] and [b], each directed to a type or arrangement of “podcast content” (*data* consisting of music and/or speech content – claim 1).

The PTAB has provided guidance in decisions regarding claims that differ from the prior art only based on “non-functional descriptive material.” See *Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential) (“[T]he nature of the information being manipulated does not lend patentability to an otherwise unpatentable computer-implemented product or process.”); *Ex parte Mathias*, 84 USPQ2d 1276, 1279 (BPAI 2005) (informative) (“[N]onfunctional descriptive material cannot lend patentability to an invention that would have otherwise been anticipated by the prior art.”), *aff’d*, 191 Fed.Appx. 959 (Fed. Cir. 2006) (Rule 36); *Ex parte Curry*, 84 USPQ2d 1272, 1274 (BPAI 2005) (informative) (“Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious.”), *aff’d*, No. 06-1003 (Fed. Cir. June 12, 2006) (Rule 36).

Here, we find the claimed “podcast content” (music and/or speech data) which is “categorized into various topics” is intended for human

listening, and is not positively recited as *data* that is actually used to change or affect any machine function.<sup>7</sup> Thus, we conclude representative claim 1, when considered as a whole, is directed to conveying a message or meaning to a human reader independent of the intended computer system (“remote server”, claim 1).

Assuming *arguendo* our reviewing court may give full patentable weight to the contested *data* limitations and functional statements of intended use, as recited in representative claim 1, we find the preponderance of the evidence supports the Examiner’s underlying factual findings and ultimate legal conclusion of obviousness for the reasons discussed below:

*Contested limitation [a]*

As pointed out by the Examiner (Ans. 2). Appellant acknowledges “Marriott describes how podcasts can be segmented into different chapters as transitions between topics . . . ,” as follows:

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<sup>7</sup> See MPEP 2111.05, 8th ed., Rev. 9, Aug. 2012 (“[W]here the claim as a whole is directed conveying a message or meaning to a human reader independent of the intended computer system, and/or the computer-readable medium merely serves as a support for information or data, no functional relationship exists.”). As an underlying subsidiary question of fact pertaining to our claim construction, the MPEP (extrinsic to the record) guides that *music* is an example of non-functional descriptive material. (*id.*) Under a broad but reasonable interpretation, we conclude the “podcast content” of Appellants’ claim 1 covers speech and/or music content which are each examples of non-functional descriptive material per se. See MPEP 2111.05 (III.) (“For example . . . tracks of recorded music, utilize[] the intended computer system merely as a support for the information. Such claims are directed toward conveying meaning to the human reader rather than towards establishing a functional relationship between recorded data and the computer.”).

while paragraphs 0015,0042 and 0043 of Marriott describe podcasts as a category of audio information and paragraph 0071 of *Marriott describes how podcasts can be segmented into different chapters as transitions between topics*, there is no disclosure or suggestion in these portions or any other portion of Marriot[t] of categorizing podcast content into various topics. The only categorization that Marriot[t] refers to is categorization of audio information (with podcasts being one among various categories).

(App. Br. 8, emphasis added; *see also* Reply Br. 2).

Regarding Appellant’s contentions challenging that segmenting podcasts into different *chapters* would not necessarily mean the podcast content is categorized into various *topics*, as claimed (App. Br. 8), we note “[a] prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

Marriott describes, in pertinent part:

[0071] According to another aspect, chapter information can be presented at a portable media device. *A podcast can be segmented into different chapters as transitions between topics or discussions*. Each chapter can have *different chapter information* that is presented while the corresponding chapter is being presented. The chapter information is also considered metadata. The chapter information being presented can be either requested by a user or automatically requested by the portable media device. (emphasis and underline added).

Given this evidence, we agree with the Examiner that Marriott’s description of “a podcast [that] can be segmented into different chapters as transitions between topics” at least *suggests* each chapter would be directed

to a different topic. Otherwise, why would an artisan (author) subdivide, for example, a podcast, a book, or any work involving authorship into separate chapters? Even if a podcast or other work is directed as a whole to a single main topic, we find the chapters within would be divided into *subtopics* pertaining to the single main topic, which we find is taught or suggested by Marriott (§71). We find Marriott teaches or at least suggests this notoriously well-known concept, which can be confirmed by opening any book having a table of contents listing more than one chapter.<sup>8</sup> For these reasons, we find Marriott’s specific teaching (§71) of different chapter information (or metadata) at least suggests different chapters pertaining to different topics, thus teaching or suggesting contested limitation [a]: “wherein the podcast content is categorized into various topics, and the podcast file includes podcast content of a particular topic,” as claimed. (Claim 1).

*Contested limitation [b]*

Claim 1 recites in pertinent part: “*wherein the processor . . . [b] provides the podcast file with the other content distinct from the podcast content for the particular topic of the podcast content included in the podcast file . . .*” Appellant contends the Examiner (Final Office Action 6) admits that this feature is not shown by Jones and Plotnick, and further contend this feature is not taught by Marriott. (App. Br. 9–10).

In the response to arguments (Ans. 4), the Examiner contends Appellant has misstated what the Examiner pointed out as deficiencies in the

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<sup>8</sup> The Supreme Court guides that courts should “take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

combination of Jones and Plotnick. The Examiner clarifies the basis for the rejection:

Plotnick was used to disclose the other content distinct from the content is inserted in the content, referring to Plotnick's disclosure of advertising content inserted between subscribed content at 1111 [0090 and 0127]. Marriot was relied upon to disclose "podcast content of a particular topic"; and "for the particular topic of the podcast content", which Marriot does as discussed in Argument 1. It is the combination of references cited that discloses the argued limitation, not Marriot alone. The *combination of references*, as used by the Examiner, has not been argued by Appellant.

(Ans. 4–5, emphasis added).

Appellant responds in the Reply Brief (4):

[T]he Examiner indicates (on pages 4 and 5 of the Examiner's Answer) that Plotnick discloses "the other content distinct from the content is inserted in the content" and that Marriot discloses "podcast content of a particular topic" and "for the particular topic". However, as explained above in Part A of this Reply Brief, Marriot does not disclose categorizing podcast content into various topics.

Thus, Appellant grounds their argument regarding limitation [b] on a premise we have found unpersuasive, as detailed above in our discussion regarding limitation A. Therefore, on this record, we are not persuaded of error regarding the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding both contested limitations [a] and [b]. Accordingly, we sustain the rejection of representative independent claim 1, and the rejection of all grouped claims which fall therewith. *See* Claim Grouping, *supra*.

*Dependent Claim 20*

Claim 20 recites: The remote server of claim 1, *wherein the podcast content is further categorized into various categories, each podcast file includes podcast content of a particular category and topic*, and the other content distinct from the podcast content includes different content that is inserted at respectively different places within the podcast file *for the particular category and topic of the podcast content included in the podcast file*. (Contested limitations emphasized; *see* also Reply Br. 5).

Appellant advances a nominal argument regarding dependent claim 20 by reciting the language of the claim and asserting it is not taught (App. Br. 10–11; Reply Br. 5). However, we find Appellant has not traversed the Examiner’s specific findings regarding paragraphs 1111, 0015, 0042, 0043 and 0071 of Marriott, as relied on in the rejection of claim 20. (Ans. 12–13). Additionally, claim 20 presents similar problematic claim construction issues to those discussed above regarding claim 1.

To the extent the Appellant is attempting to claim a purportedly novel type or arrangement of podcast content per se (i.e., an original and fixed compilation, arrangement and/or selection of music and/or speech on *various topics* including *a particular topic*), we note that such subject matter (when considered alone) properly falls under existing copyright law.<sup>9</sup>

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<sup>9</sup> *See e.g.*, 17 U.S.C. §102, *et seq.* To the extent that an original and fixed compilation, arrangement, and/or selection of “*podcast content*” (claim 1) may be protectable under existing copyright law (“wherein the podcast content is categorized into various topics, and the podcast file includes podcast content of a particular topic” – claim 1), *see* 17 U.S.C. §102(b): “In

In any event, on this record, Appellant has not persuaded us of error regarding the Examiner's rejection of dependent claim 20, which we construe as an apparatus claim in a utility patent application under existing applicable patent laws.<sup>10</sup>

#### DECISION

We affirm the Examiner's decision rejecting claims 1–7 and 9–21 under § 103. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

#### AFFIRMED

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no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” *See also* 17 U.S.C. § 101: “A ‘compilation’ is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term ‘compilation’ includes collective works.”

<sup>10</sup> Although claim 1 nominally recites generic computer hardware (a remote server, storage, and a processor), Appellant's arguments urging patentability focus solely on the informational content of the claimed “podcast content,” which we conclude broadly covers speech and/or music. *See* note 7. In the event of further prosecution of this application, we leave it to the Examiner to review all the claims for compliance under 35 U.S.C. § 101 in light of the recently issued preliminary examination instructions on patent eligible subject matter. *See* “Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*,” Memorandum to the Examining Corps, June 25, 2014. Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See Manual of Patent Examining Procedure* (MPEP) 1213.02.

Appeal 2012-011902  
Application 11/315,760

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