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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KEITH MARSHALL CHATFIELD and MARK ALAN PASTOR

Appeal 2014-000527
Application 12/244,052
Technology Center 3600

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–3, 7, 9, 10, 12, and 21–33 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to a system and method for providing a media content exchange service. (Spec. 1:5–7). Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method comprising:

receiving a request from a user for a replacement copy of a specific media content at a content server, the request including an indication from the user that the user has an original copy of the specific media content;

providing the replacement copy of the specific media content to the user via the content server based on the request before verifying media validation information for the specific media content;

receiving media validation information from the user at the content server to validate the original copy of the specific media content; and

initiating or not initiating a payment action from the user based on the media validation information.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

van Zoest	US 6,496,802 B1	Dec. 17, 2002
Cronce	US 7,483,860 B2	Jan. 27, 2009
Peters	US 2009/0204855 A1	Aug. 13, 2009

The following rejections are before us for review:

1. Claims 1–3, 7, 9, 10, 12, and 21–33 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

2. Claims 1–3, 7, 9, 10, and 21–33¹ stand rejected under 35 U.S.C. § 103(a) as being unpatentable over van Zoest and Cronce.
3. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over van Zoest, Cronce², and Peters.

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence³.

ANALYSIS

Rejections under 35 U.S.C. § 101

The Examiner has rejected the claims under 35 U.S.C. § 101 as being drawn to ineligible subject matter (Ans. 3–6). The Examiner has determined that the claims are directed to an abstract idea of validation of media validation information received from a user and initiating or not initiating a payment action from a user based on the media validation information (*id.*).

In contrast, the Appellants have argued that this rejection is improper (Reply Br. 1–5).

¹ The listing of claim 12 in this rejection at page 9 of the Final Rejection is considered a typographical error as it is not listed in the body of the rejection and instead included in the separate rejection at page 20. Also, the listing of claim 11 at page 13 of the Final Rejection is considered an error as the claim is canceled (Appeal Br. 15).

² The omission of Cronce from this rejection is considered an error as claim 12 depends from claim 1.

³ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

We agree with the Examiner. Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2354 (2014).

In judging whether claim 1 falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296-97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. If so, we then consider the elements of the 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 of the abstract idea. *Id.* This is a search for an “inventive concept,” an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* at 2358.

Here, the claim is directed to the abstract idea of conditional payment based on media validation information and also to a fundamental economic practice of paying for media. We next consider whether additional elements transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea over the Internet, using generic

computer components. We conclude that it does not. The recited method steps of claim 1 fail to transform the nature of the claim as they are directed to generic computer structures for storing and transferring information. For this reason, this rejection of claim 1 is sustained. The Appellants have provided the same arguments for the remaining claims, and the rejection of these claims is sustained as well.

Rejections under 35 U.S.C. § 103(a)

Independent claim 1 requires “providing the replacement copy of the specific media content . . . based on the request before verifying media validation information for the specific media content.”

The Appellants argue that the rejection of claim 1 is improper because, *inter alia*, “van Zoest never teaches providing media content before verifying validation information.”

The Examiner has however determined that the rejection is proper and finds this limitation in van Zoest at column 20, lines 22–67 (Ans. 9).

We agree with the Appellants. Here the cited claim limitation requires that a replacement copy is provided before the verification of the corresponding request. The above citations to van Zoest fail to disclose this. At column 20, lines 22–39, van Zoest describes an embodiment wherein validation is performed based on a counter. Each time a request for content is received, the system compares the current value of the counter to a threshold. If the counter exceeds the threshold, then the user’s request is not validated. If the counter does not exceed the threshold, the work is provided and the counter is incremented. After the providing is complete, the counter is decremented. At column 20, lines 40–49, van Zoest discloses another

embodiment wherein the validation of each request is performed based on a session identifier included in each request. In both of these embodiments, each request for content results in a new validation (i.e., based on the counter or session identifier) that is performed before the content is provided in response to that particular request. At column 20, lines 50–67, van Zoest discloses that “[o]nce the Content Delivery System **152** validates a user,” the system searches for the content and, if the content can be located, it is provided to the user. Thus, it is clear that Content Delivery System 152 does not provide the content until the corresponding request has been validated. In other words, subsequent requests for the same or different content result in distinct validation operations being performed before the corresponding content is provided. For these reasons the rejection of claim 1 and its dependent claims 2, 3, 7, 9, 10, 12, and 21–26 is not sustained.

Independent claims 27 and 32 contain similar limitations, and the rejection of claims 27 and 32 suffers from the same deficiency as the rejection of claim 1. Therefore, the rejection of claims 27 and 32 and their dependent claims 28–31 and 33 is not sustained for the same reasons.

CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 101.

We conclude that the Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a).

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DECISION

The Examiner's decision to reject claims 1–3, 7, 9, 10, 12, and 21–33 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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED