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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DAVID VALIN

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Appeal 2014-002851  
Application 12/459,353  
Technology Center 3600

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Before BIBHU R. MOHANTY, KENNETH G. SCHOPFER, and  
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 59, 60, 63–66, 69, 71, 72, 74–78, 80–103, 105–110, 112, and 114–121, 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 Appellant's claimed invention is directed to protection, sharing, and tracking content (Abstract, lines 1, 2). Claim 59, reproduced below, is representative of the subject matter on appeal.

59. A method for interacting and collaborating to perform exchanges and sharing, the method comprising:

- connecting to a networked computer system;
- authenticating access to secure access every time a user connects to the system;
- creating one or more electronic files representing a user's property;
- allowing users to protect, share, or exchange property through a computer network;
- protecting, sharing, storing, accessing, authenticating, certifying, the electronic files in the networked computer system;
- attaching the electronic files to one or more other files;
- tracking the electronic files in the networked computer system;
- providing a network collaborative mechanism;
- sharing a first protected or unprotected property between one or more users by a property owner;
- creating a second, altered property based on the first protected or unprotected property by another user;
- changing the second, altered property with permission and protection of the property owner; or
- creating a third subsequent altered properties with permission and protection of the property owner;
- determining the market value of a property;
- determining the value of an intellectual property;
- determining ownership and control of a subsequent properties;
- calculating an ownership percentage that is protected between two or more owners in relation to a shared and protected property;
- calculating advertising rates and valuations of a property;
- arbitrating a deal;
- suggesting and negotiating a deal between a two or more users;
- requesting proposals and prices;

providing an advertising system for buying, selling, targeting, and placing advertisements, individually, in groups, or through the automatic digital semantic agent;  
establishing advertisement rates;  
connecting a mobile or portable network device with the networked system to stream in real-time or upload electronic files;  
providing a group based marketplace for buying and selling;  
providing a rating and voting system;  
providing product development feedback;  
providing an automatic digital semantic agent making a group or cooperative purchase or sale; and  
using the shared payment platform system to perform the buying or selling actions.

#### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Miller	US 5,801,685	Sept. 1, 1998
George	US 7,849,411 B1	Dec. 7, 2010
Cocotis	US 2002/0112162 A1	Aug. 15, 2002
Malackowski	US 2002/0138384 A1	Sept. 26, 2002
Kwei	US 2004/0148228 A1	July 29, 2004
Reisman	US 2004/0186738 A1	Sept. 23, 2004
Barney	US 2004/0220842 A1	Nov. 4, 2004
McCleskey	US 2005/0021398 A1	Jan. 27, 2005
Thomas	US 2005/0108153 A1	May 19, 2005
Koningstein	US 2005/0114198 A1	May 26, 2005
Gizewski	US 2008/0162352 A1	July 3, 2008
Ben-Zvi	US 2008/0228614 A1	Sept. 18, 2008
Hoyt	US 2009/0259594 A1	Oct. 15, 2009
Salwan	US 2010/0030580 A1	Feb. 4, 2010
Aslanian	US 2010/0299192 A1	Nov. 25, 2010

The following rejections are before us for review<sup>1</sup>:

1. Claims 59, 60, 63–66, 69, 71, 72, 74–78, 80–103, 105–110, 112 and 114–121 are rejected under 35 U.S.C. § 112, first paragraph, for failure to show possession of the invention.

2. Claims 59, 60, 63–66, 69, 71, 72, 74–78, 80–103, 105–110, 112 and 114–121 are rejected under 35 U.S.C. § 112, second paragraph.

3. Claims 59, 60, 63–66, 69, 71, 72, 74–78, 80–103, 105–110, 112 and 114–121 are rejected under 35 U.S.C. § 101.

4. Claims 59, 76, 82–87, 106–108, 117, 119, and 120 are rejected under 35 U.S.C. § 103(a) as unpatentable over Reisman, McClesky and Kwei.

5. Claim 60 is rejected under 35 U.S.C. § 103(a) as unpatentable over Reisman, McClesky, Kwei, and Aslanian, Jr.

6. Claims 64, 65, 69, 71, 72, and 75 are rejected under 35 U.S.C. § 103(a) as unpatentable over Reisman, McClesky, Kwei, and Ben-Zvi.

7. Claim 66 is rejected under 35 U.S.C. § 103(a) as unpatentable over Reisman, McClesky, Kwei, Ben-Zvi, and Aslanian, Jr.

8. Claim 74 is rejected under 35 U.S.C. § 103(a) as unpatentable over Reisman, McClesky, Kwei, Ben-Zvi, Gizewski, Salwan, Aslanian, Jr. and Official Notice.

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<sup>1</sup> The Final Rejection and Answer make rejections with regard to claims 59–120, but the claims Appendix lists claims 61, 62, 67, 68, 70, 73, 79, 104, 111, and 113 as being cancelled. The rejections of record under 35 U.S.C. § 112 (first and second paragraphs) and 35 U.S.C. § 101 do not list claim 121 as being included in the rejection, but this omission is considered a typographical error.

9. Claim 77 is rejected under 35 U.S.C. § 103(a) as unpatentable over Reisman, McClesky, Kwei, George, and Official Notice.
10. Claims 78, 90, and 118 are rejected under 35 U.S.C. § 103(a) as unpatentable over Reisman, McClesky, Kwei, and Official Notice.
11. Claims 80, 81 are rejected under 35 U.S.C. § 103(a) as unpatentable over Reisman, McClesky, Kwei, and Aslanian.
12. Claims 88 is rejected under 35 U.S.C. § 103(a) as unpatentable over Reisman, McClesky, Kwei, and Hoyt.
13. Claims 89, 91-103, 109, and 110 are rejected under 35 U.S.C. § 103(a) as unpatentable over Reisman, McClesky, Kwei, and Thomas.
14. Claim 105 is rejected under 35 U.S.C. § 103(a) as unpatentable over Reisman, McClesky, Kwei, Barney, and Official Notice.

#### 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 evidence<sup>2</sup>.

#### ANALYSIS

##### *Rejection under 35 U.S.C. § 112, first paragraph*

The rejection made under 35 U.S.C. § 112, first paragraph, was maintained in the Final Rejection mailed April 17, 2013, and not withdrawn in the Answer (Final Rej. 3–4). The Appellant has not provided any

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

arguments for this rejection. As no arguments have been provided, this rejection of record is summarily sustained.

*Rejection under 35 U.S.C. § 112, second paragraph*

The Examiner has determined that in claim 59 that the claim term “automatic digital semantic agent” is confusing and indefinite, and also that the claim term lacks antecedent basis (Final Rej. 5, Ans. 2–3).

In contrast, the Appellant argues that the cited claim limitation is not indefinite (App. Br. 29–30).

We agree with the Appellant. Here, the claim term “automatic digital semantic agent” is described in the Specification, for example, at pages 1 and 2. Here, the cited claim term is not indefinite in light of the Specification. For these reasons, this rejection is not sustained.

*Rejection under 35 U.S.C. § 101*

The Appellant has argued that the rejection made under 35 U.S.C. § 101 is improper (App. Br. 30–32).

In contrast, the Examiner has determined that the rejection is proper (Ans. 3–4; Final Rej. 5–10).

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: “laws 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 59 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 assess 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, we find that the claim is directed to the concept of creating intellectual property and then creating a marketplace for buying and selling that intellectual property. This is a fundamental economic practice long prevalent in our system of commerce, and is an abstract idea beyond the scope of § 101.

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 using generic computer components. We conclude that it does not.

Considering each of the claim elements in turn, the function performed by the computer system elements at each step of the process is

purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. Thus, the additional recited elements fail to transform the nature of the claim into a patent-eligible application of the abstract idea, and the rejection of record is sustained.

*Rejection under 35 U.S.C. § 103(a)*

The Appellant's has argued that the rejection of claim 59 is improper because the cited prior art fails to disclose the claim limitations for:

protecting, sharing, storing, accessing, authenticating,  
certifying, the electronic files in the networked computer  
system;

(App. Br. 35).

In contrast, the Examiner has determined that the cited claim limitation is shown by Riesman at paras. 82, 83, and 113, (Final Rej. 13, 14).

We agree with the Appellant. Here, Riesman at the above cited portions fail to specifically disclose the cited claim limitation for “protecting, sharing, storing, accessing, authenticating, certifying, the electronic files in the networked computer system” in the manner claimed with the cited claim limitations. For example, paragraph 113 generically discloses “workflow” but discloses nothing specific to the authentication or certifying of the electronic files specifically in the manner claimed. For this reason, the rejection of claim 59 and its dependent claims is not sustained.

### CONCLUSIONS OF LAW

We conclude that Appellant has not shown that the Examiner erred in rejecting the cited claims under 35 U.S.C. § 112, first paragraph, for failure to show possession of the invention; and 35 U.S.C. § 101, as listed in the Rejections section above.

We conclude that Appellant has shown that the Examiner erred in rejecting the cited claims under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103(a), as listed in the Rejections section above.

### DECISION

The Examiner's rejection of claims 59, 60, 63–66, 69, 71, 72, 74–78, 80–103, 105–110, 112 and 114–121 is sustained.

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

AFFIRMED