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ZIMMERMAN, MATTHEW E

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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* JAMES PATTERSON and NATHAN MOODY

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Appeal 2014-007385<sup>1</sup>  
Application 13/089,154<sup>2</sup>  
Technology Center 3600

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Before HUBERT C. LORIN, NINA L. MEDLOCK, and  
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 8–12, 16, 23–27, 31, and 38–42. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> Our decision references Appellants' Appeal Brief ("App. Br.," filed March 13, 2014) and Reply Brief ("Reply Br.," filed June 20, 2014), and the Examiner's Answer ("Ans.," mailed May 6, 2014) and Final Office Action ("Final Act.," mailed October 17, 2013).

<sup>2</sup> Appellants identify Google Inc. as the real party in interest. App. Br. 1.

### CLAIMED INVENTION

Appellants' claimed invention "relates to the field of electronic books and, more particularly, to systems and methods for creating and distributing customized books via electronic devices" (Spec. ¶ 2).

Claims 1, 16, and 31 are the independent claims on appeal. Claim 1, reproduced below, is illustrative:

1. An electronic book system, comprising:
  - a memory storing computer executable instructions for:
    - a publisher processing subsystem configured to permit publisher supply of book components and policies corresponding to the book components, the book components being stored in a book components database, the policies being stored in a policy database;
    - a curator processing subsystem configured to permit curator selection of a plurality of the book components from the book components database, responsive to the policies, for synthesis into an electronic book, the synthesis including determining an umbrella policy, based on a plurality of the policies applicable to the plurality of the components, specifying a manner in which the electronic book may be used, the curator processing subsystem further configured to store the electronic book in association with the umbrella policy in a book database; and
    - a distribution subsystem configured to retrieve the electronic book and the umbrella policy from the book database and supply the electronic book to a reader subject to the umbrella policy; and
  - one or more processors coupled to the memory for executing the computer executable instructions.

## REJECTIONS

Claims 1 and 8–12 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hartman (US 7,007,034 B1, iss. Feb. 28, 2006), Alger (US 2005/0097007 A1, pub. May 5, 2005), and Nakahara (US 2004/0162846 A1, pub. Aug. 19, 2004).

Claims 16, 23–27, 31, and 38–42 are rejected under 35 U.S.C. § 103(a) as unpatentable over Hartman, Campagna (US 2009/0254802 A1, pub. Oct. 8, 2009), and Nakahara.

## ANALYSIS

### *Independent Claim 1 and Dependent Claims 8–12*

We are persuaded by Appellants' argument that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 103(a) because Nakahara, on which the Examiner relies, does not disclose or suggest “determining an umbrella policy, based on a plurality of the policies applicable to the plurality of the [book] components, specifying a manner in which the electronic book may be used,” as recited in claim 1 (App. Br. 6–8).

Nakahara is directed to a content use management system, and discloses that the system comprises a terminal apparatus and a server apparatus connected to the terminal apparatus through a communication channel (Nakahara ¶¶ 10, 11). The terminal apparatus uses content, which is a digital copyrighted work, and the server apparatus manages the use of that content (*id.* ¶ 11). Nakahara discloses that use conditions may specify the number of available times that the content may be used and the time period during which the content may be accessed (*see, e.g., id.* ¶¶ 87, 88, 100).

Citing paragraphs 88 and 100 of Nakahara, the Examiner maintains that Nakahara meets the claim language because Nakahara applies a plurality of use conditions to an entire body of content:

The [Nakahara] license applies a plurality of use conditions to the entire body of content. For example, Nakahara teaches a first use condition on the number of times an item of content can be used and a second use condition on when the item of content may be accessed (see [0088] and [0100]). The combination of these plural use conditions (policies) together forms the license (umbrella policy) for the content.

Ans. 4.<sup>3</sup> Yet, as Appellants correctly observe, the cited portions of Nakahara merely disclose that a license can include multiple conditions, i.e., “the number of available times for the content to be used . . . [and] a validity period of a targeted content” (Reply Br. 2 (quoting Nakahara ¶ 88)). The plural conditions apply to the entirety of the content to which they correspond, and the resulting license also corresponds to the entirety of that content. There is nothing in the cited portions of Nakahara that discloses or suggests that a particular use condition applies only to a particular portion, i.e., a component, of the content and, therefore, nothing that discloses or suggests determining an umbrella policy for an electronic book based on policies that correspond to individual book components, i.e., “determining an umbrella policy, based on a plurality of the policies applicable to the plurality of the [book] components, specifying a manner in which the electronic book may be used,” as recited in claim 1.

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<sup>3</sup> We note, as do Appellants (*see* Reply Br. 2, n.1), that every page of the Examiner’s Answer is labelled “page 1.” Like Appellants, we refer to the title page immediately following Form PTOL-90A as page 1, and treat the pages that follow as though consecutively numbered.

In view of the foregoing, we do not sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the Examiner's rejection of dependent claims 8–12. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

*Independent Claims 16 and 31 and Dependent Claims 23–27 and 38–42*

Independent claims 16 and 31 include language substantially similar to the language of claim 1 and stand rejected based on same erroneous findings with respect to Nakahara applied in rejecting claim 1 (Final Act. 6–7, 9). Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of independent claims 16 and 31, and claims 23–27 and 38–42, which depend therefrom, for the same reasons set forth above with respect to claim 1.

DECISION

The Examiner's rejections of claims 1, 8–12, 16, 23–27, 31, and 38–42 under 35 U.S.C. § 103(a) are reversed.

REVERSED