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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GLENN BRITT and MICHEAL L. LAJOIE

Appeal 2015-005892
Application 13/773,477
Technology Center 2400

Before ALLEN R. MacDONALD, JOSEPH P. LENTIVECH, and
DAVID J. CUTITTA, II, *Administrative Patent Judges*.

MacDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 49, 50, 53, 65, 67–80, and 83–86. Claims 1–48, 51, 52, 54–64, 66, 81, and 82 have been cancelled. App. Br. 14–16. We have jurisdiction under 35 U.S.C. § 6(b).

Exemplary Claims

Exemplary claims 49, 72, and 83 under appeal read as follows (emphasis added):

49. A method of content management within a content delivery network having a plurality of users, said method comprising:

receiving content at a client device from said network, said client device associated with said at least one of said plurality of users of said network, said content comprising third-party generated content; and

causing at least a portion of said received content to be **uploaded** to a storage entity of said network from said client device;

wherein said storage entity is configured to store said content at a storage location specifically associated with said at least one user.

72. A method of managing content via a content delivery network, so as to ensure copyright preservation, the method comprising:

recording a first rendering of a content element on a first recording device at a first location, the first recording device being associated with a first user; and

recording a second rendering of the content element on a second recording device at a second location, the second location being in communication with the first location via the content delivery network, the second rendering being made accessible only to the first user so as to protect the copyright of the content.

83. The method of Claim 49, wherein said storage location comprises equipment **leased by said at least one user** located within a premises **managed by an operator of said network**.

Rejections on Appeal

1. The Examiner rejected claim 49 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.
2. The Examiner rejected claims 65, 69, 70, and 72–80 under 35 U.S.C. § 102(b) as being anticipated by Thomas et al (US 2002/0059621 A1, May 16, 2002) (“Thomas”).¹
3. The Examiner rejected claims 49, 50, 53, 83, and 84 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Thomas and Hunter et al. (US 2002/0056118 A1, May 9, 2002) (“Hunter”).²
4. The Examiner rejected claims 67, 68, 71, 85, and 86 under 35 U.S.C. § 103(a) as being unpatentable over Thomas.³

¹ Arguments are not presented for claims 65, 69, and 70. App. Br. 5. We affirm *pro forma* the rejection of these claims. Although the Examiner also rejected claims 81 and 82 (Final Act. 6 and 9), the Appellants list those claims as cancelled (App. Br. 16).

Claims 72, 77, and 80 are argued separately. Separate patentability is not argued for claims 73–76, 78, and 79. Except for our ultimate decision, the Examiner’s rejection of these claims is not discussed further herein.

² Although claims 83 and 84 are listed as rejected over Thomas alone (Final Act. 12), the rejection analysis is based on the combination of Thomas and Hunter (Final Act. 13–14). Separate patentability is not argued for claims 50, 53, and 84. Except for our ultimate decision, this rejection of these claims are not discussed further herein.

³ Arguments are not presented for claim 67. App. Br. 11. We affirm *pro forma* the rejection of this claim.

Claims 68 and 85 are argued separately. Separate patentability is not argued for claims 71 and 88. Except for our ultimate decision, the Examiner’s rejection of these claims is not discussed further herein.

Appellants' Contentions

1. Appellants contend the Examiner erred in rejecting the claim 49 under 35 U.S.C. § 112, first paragraph, because:

Applicant notes that throughout the specification as filed, downloading of third party content is disclosed.

App. Br. 4.

2. Appellants contend the Examiner erred in rejecting the claim 72 under 35 U.S.C. § 102(b) because the Final Action relies on the rejections of claims 49 and 54 without sufficient further explanation. App. Br. 5.

Additionally, Appellants argue:

At paragraph [0065], Thomas discloses an “LREC” button 338 which “... *may be used to have a local VCR record media content that is currently being displayed by the user equipment*”; and an “RREC” button 339 which enables “... *currently displayed media content [may] to be recorded on a server in a remote server network.*” In other words, the user in Thomas may select one button to have current content recorded locally, and may select a different button to have current content recorded at the network server (see also paragraph [0084]). ***Thomas, however, does not in any way expressly or inherently describe a functionality that would allow these features to be used in concert as would be required to meet the features of Claim 72.*** That is to say, the reference does not, that Applicant can find, provide an option for recording the content which is currently being displayed (i) at the local device and (ii) at the network server. The user is given only an option to select recording at one or the other device; no option is given to request recording at both the local device and the network server.

App. Br. 6, emphasis added.

Thomas simply does not provide first and second devices which record the content; only one device in Thomas records the

content, then it is shared among many devices using e.g., “freezing”.

Reply Br. 5.

3. Appellants contend the Examiner erred in rejecting the claim 77 under 35 U.S.C. § 102(b) because:

[I]n Thomas, users are denied access only when the user has entered an improper account identity or password, or when they have not been given access rights. Thomas is silent with respect to blocking users from accessing content when they have not affirmatively requested to record the content.

App. Br. 8.

In the example given by the Office, a user must first request access to content; then upon the user’s inability to provide a password, the user is denied access to the content. Stated differently, the user in the Office’s example from Thomas affirmatively requests content.

Reply Br. 6.

4. Appellants contend the Examiner erred in rejecting the claim 80 under 35 U.S.C. § 102(b) because:

[I]n Thomas, in the instance a user does not submit a prior affirmative request to have the content stored, the content is simply not distributed thereto; again there is no disclosure of or need for blocking access to the content in this instance.

App. Br. 9.

Appellant reminds the Office, however, that even a request for content which includes an incorrect or invalid password still corresponds to an affirmative request for content.

Reply Br. 7.

5. Appellants contend the Examiner erred in rejecting claim 49 under 35 U.S.C. § 103(a) because:

[T]he remote record option in Thomas enables a user to record programming content to network storage directly and without

first providing the content to the device. This is in direct contrast to the Claim 49 recitation of receiving content at a client device from the network, and causing at least a portion of the received content to be uploaded to a storage entity of the network from the client device. A person of ordinary skill, upon reading Thomas, would understand that the reference explicitly indicates that instead of downloading content to the client from the network, and then uploading content from the device back to the network (as in Claim 49), content is simply sent directly to the remote storage space.

App. Br. 10.

6. Appellants contend the Examiner erred in rejecting claim 68 under 35 U.S.C. § 103(a) because:

[N]owhere does the reference disclose the “unfrozen” content being *simultaneously* delivered to the original device (i.e., the device that was used to freeze the content) as well as to the second (i.e., different) device.

App. Br. 11, emphasis added.

The Office states that the claim language “*based at least in part on said request*” is nonspecific and is not necessarily the same request noted previously in Claim 68. Appellant reminds the Office that the use of the term “said” indicates an antecedent basis to a previously referenced feature. Therefore, “*said request*” refers specifically to a previously referenced request.

Reply Br. 11.

7. Appellants contend the Examiner erred in rejecting claim 83 under 35 U.S.C. § 103(a) because:

Applicant respectfully submits that the Office’s taking of Official Notice with respect to Claim[83] is improper and constitutes clear error, in that the Office’s assertions are unsupported by documentary evidence and are not used regarding matters that are capable of instant and unquestionable demonstration of being well known.

App. Br. 12.

8. Appellants contend the Examiner erred in rejecting claim 85 under 35 U.S.C. § 103(a) because:

Applicant respectfully submits that the Office's taking of Official Notice with respect to Claim [85] is improper and constitutes clear error, in that the Office's assertions are unsupported by documentary evidence and are not used regarding matters that are capable of instant and unquestionable demonstration of being well known.

App. Br. 12.

Applicant submits that such updates and subscriptions (as Noticed by the Office) were not of such notorious character at the time of the invention and as such, such reliance on Official Notice demonstrates clear error.

Furthermore, based on Applicant's understanding of current *YouTube*TM functionality [referenced by Examiner] (which Applicant emphatically stresses is not prior art), a user subscription to a particular channel is not a trigger for receiving selective delivery of content and/or updates.

App. Br. 12.

Regarding the Office's furthered comments to an RSS Feed, Appellant notes that subscription to a feed is simply not sufficient to read on the claimed feature of Claim 85 (based at least in part on said preference, selectively deliver content). That is to say, the subscription service in an RSS feed is no different than that of *YouTube*TM in that a *user subscription* to a particular channel **is not a trigger for** receiving selective delivery of content and/or updates. Instead, the subscribed channel is merely added to a menu to indicate to the user that new content is available (rather than delivering the content itself). Thus, the factual basis for the Official Notice is flawed, and the Office has committed clear and reversible error.

Reply Br. 12, emphasis added.

Issues on Appeal

Did the Examiner erred in rejecting claim 49 under 35 U.S.C. § 112, first paragraph?

Did the Examiner err in rejecting claims 72, 77, and 80 as being anticipated under 35 U.S.C. § 102(e) because Dewar fails to describe the limitation argued by Appellants?

Did the Examiner err in rejecting claims 49, 68, 83, and 85 as being unpatentable under 35 U.S.C. § 103(a) because the prior art does not render obvious the limitation argued by Appellants?

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments that the Examiner has erred.

As to Appellants' above contention 1, we agree with Appellants. An analysis supporting a rejection under 35 U.S.C. § 112, first paragraph, for lack of enablement, must be based on an undue experimentation analysis using the *Wands* factors.

Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.

In re Wands, 858 F.2d 731, 737 (Fed. Circ. 1988).

The *Wands* factors include:

(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Id. We have reviewed the Examiner's rejection, and do not find any analysis based on the *Wands* factors. For these reasons, the Examiner has not shown that claim 49 fails to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.

As to Appellants' above contention 2, we disagree. Although we agree with Appellants that the Examiner's reliance in the Final Action on the rejections of claims 49 and 54 to reject claim 72 was insufficiently explained, an expanded explanation is provided in the Answer at pages 5–12. As to Appellants' particular contention that Thomas discloses an "LREC" button and an "RREC" button, but, does not describe these features to be used in concert as would be required to meet the features of Claim 72, we disagree. Thomas states at paragraph 121:

Files uploaded to the remote server (e.g., VOD server) may also be downloaded to user equipment to be presented to a user. Files may be transferred from one user equipment to a different user equipment system through a media-on-demand remote server. Files may include almost any type of data, program, or content. Examples of files that may be uploaded include, for example, pictures, movies, songs, video games, documents, e-mails, and Internet Web pages. Files such as pictures, movies, songs, video, or other audio-visuals materials may be of particular interest because on-demand media servers are particularly suited for the delivery and presentation of audio-visuals to users.

We conclude that an artisan would recognize the highlighted sentences of Thomas above are inclusive of a sequence of downloading a file to user equipment (recording a first rendering on a first recording device) followed by transferring that file through the media-on-demand remote server (recording a second rendering on a second recording device) to a different user equipment (recording a third rendering on a third recording device).

As to Appellants' above contention 3, we disagree.⁴ Appellants assert that the Examiner has erred and assert that an affirmative request to access content differs from the prior art using a password to access content. We do not find where Appellants have provided support for these assertions, e.g., by explaining their construction of the claimed "affirmatively requested," explaining why they believe the claim to be limited to that construction, and particularly explaining why that construction excludes password based content access. Rather, we find Appellants' assertions to be conclusory. Such unsupported attorney argument, is entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

As to Appellants' above contention 4, we disagree.⁵ We reach this result for the same reasons as contention 3.

As to Appellants' above contention 5, we disagree. We reach this result for the same reasons as contention 2.

As to Appellants' above contention 6, we disagree. Appellants' argument is not commensurate in scope with the claim. The Examiner correctly points out that claim 68 does not require that the data is simultaneously downloaded. Ans. 21. Rather, contrary to Appellants' argument, claim 68 explicitly recites a causal link between downloads, not a requirement that downloads be simultaneous. Further, contrary to Appellants' argument, the Examiner correctly points out that the language

⁴ As with claim 72, an expanded explanation for the rejection of claim 77 is provided in the Answer at pages 12–15.

⁵ As with claim 72, an expanded explanation for the rejection of claim 80 is provided in the Answer at pages 15–16.

“based at least in part” is nonspecific and could include a second request that is based at least in part on said request. Ans. 21. Such as when said already downloaded stored at least portion of said content is requested to be downloaded from the second client to the first client. Unlike the first download in claim 68, the source of the second download is not limited.

As to Appellants’ above contention 7, we disagree. Contrary to Appellants’ argument, the Examiner correctly points out that “the Examiner in a letter dated 8/27/14 provided the applicant with a number of references to support his official notices.” Ans. 23.⁶

As to Appellants’ above contention 8, the Examiner provides the Appellants with a number of RSS related references to support his official notice. Ans. 24. Appellants’ argument directed to the RSS references

⁶ Although not necessary for our decision, we note that the “leased by said at least one user” and “managed by an operator of said network” limitations of claim 83 recite abstract intangible properties of the “equipment” and “premises” respectively.

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977). “[W]hen the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.” *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). However, the *prima facie* case can be rebutted by evidence showing that the prior art product does not necessarily possess the characteristics of the claimed product. *Best*, 562 F.2d at 1255; *see also Titanium Metals Corp. of Am. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985). We do not find where Appellants have presented evidence that the claimed structures are distinguishable from the prior art structure. Without more, mere recitation of these abstract intangible properties does not serve to distinguish over the prior art.

asserts that “a user subscription to a particular channel is not a trigger for receiving selective delivery of content and/or updates.” Reply Br. 12. We disagree. Appellants further assert that based on the user subscription, “the subscribed channel is merely added to a menu to indicate to the user that new content is available (rather than delivering the content itself).” *Id.* Appellants overlook that an artisan would recognize that “added to a menu” makes available subsequent steps to the indication that new content is available which steps include (1) indication by a user that they prefer to receive the new content, and (2) based on that preference selectively delivering the new content.

CONCLUSIONS

(1) Appellants have established that the Examiner erred in rejecting claim 49 as failing to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.

(2) The Examiner has not erred in rejecting claims 49, 50, 53, 65, 67–80, and 83–86 as being unpatentable under 35 U.S.C. § 103(a).

(3) Claims 49, 50, 53, 65, 67–80, and 83–86 are not patentable.

DECISION

The Examiner’s rejection of claim 49, as failing to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph, is reversed.

The Examiner’s rejections of claims 49, 50, 53, 65, 67–80, and 83–86 as being unpatentable under 35 U.S.C. § 103(a) are affirmed.

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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