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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAYMOND ANTHONY JOAO

Appeal 2016-004470¹
Application 13/200,446²
Technology Center 3600

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant appeals from the
Examiner's decision to reject claim 1. We have jurisdiction under § 6(b).

We AFFIRM.

¹ Our Decision references Appellant's Specification ("Spec.," filed Sept. 23, 2011) and Appeal Brief ("Br.," filed Aug. 28, 2015), as well as the Examiner's Final Office Action ("Final Act.," mailed Feb. 26, 2015) and Answer ("Ans.," mailed Feb. 10, 2016).

² Appellant identifies GTJ Ventures, LLC as the real party in interest. Br. 1.

SUBJECT MATTER ON APPEAL

The invention “pertains to a digital television broadcasting apparatus and method for providing information in a digital television and/or Internet convergent environment.” Spec. 1.³ Claim 1 is the sole claim on appeal and is reproduced below, with paragraphing added:

Claim 1. A digital television broadcast apparatus, comprising:

a database, wherein the database stores a plurality of news stories, wherein each news story of the plurality of news stories can be received or obtained from any one of any number of content providers, wherein each news story of the plurality of news stories contains video information and audio information, and further wherein each news story of the plurality of news stories is capable of being transmitted on, over, or via, a digital television broadcast network, on, over, or via, the Internet or the World Wide Web, and on, over, or via, a cellular communication network or a wireless communication network, and further wherein the database stores ratings information regarding a news story or news stories of the plurality of news stories;

a memory device, wherein the memory device stores information regarding a request by an individual to receive an alert message regarding a posting of a news story in the database, wherein the request to receive an alert message contains information regarding a search criteria;

a processor specially adapted for processing information regarding digital television broadcasting content, wherein the processor detects a posting of a news story in the database, wherein the processor determines if the news story satisfies the search criteria and, if the search criteria is satisfied, the processor generates an alert message containing information regarding the posting or the storing of the news story and ratings information regarding the news story; and

³ Appellant’s Specification does not include line or paragraph numbering, so we refer to the Specification by page number.

a transmitter, wherein the transmitter transmits the alert message to a communication device associated with the individual, wherein the alert message is transmitted to the communication device on, over, or via, a digital television broadcast network, on, over, or via, the Internet or the World Wide Web, or on, over, or via, a cellular communication network or a wireless communication network.

REFERENCES

The Examiner relies on the following prior art in rejecting the claim on appeal:

Del Sesto	US 6,985,882 B1	Jan. 10, 2006
Anaya et al. (“Anaya”)	US 7,454,372 B1	Nov. 18, 2008
Wiser et al. (“Wiser”)	US 2010/0031162 A1	Feb. 4, 2010

REJECTIONS

The Examiner makes the following rejections, which are before us on appeal:

claim 1 under 35 U.S.C. § 101 as non-statutory subject matter; and
claim 1 under 35 U.S.C. § 103(a) as unpatentable over Anaya,
Del Sesto, and Wiser.

ANALYSIS

Non-Statutory Subject Matter

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 implicit exceptions: “[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) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). To “distinguish[] patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts,” the Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), which, in the first step, considers whether a claim is directed to a patent-ineligible concept, e.g., an abstract idea, and, if so, considers, in the second step, whether the claim recites an inventive concept—an element or combination of elements sufficient to ensure the claim amounts to significantly more than the abstract idea and transform the nature of the claim into a patent-eligible application. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1294, 1296–98).

In rejecting claim 1 as non-statutory subject matter, i.e., subject matter judicially excepted from statutory subject matter, the Examiner analyzes the claim using this two-step framework. Final Act. 2–5. Pursuant to the first step, the Examiner determines that the claim is directed to “providing information in a digital television and internet convergent function,” which is a fundamental economic practice and a method of organizing human activity, and, therefore, an abstract idea. *Id.* at 3. Under the second step, the Examiner determines that the elements of the claim do not amount to significantly more than the abstract idea because they do not effect an improvement to another technology or technical field or improve the functioning of a computer itself. *Id.* at 5. The Examiner also determines that the claim simply links the use of the abstract idea to a particular

technological environment, and that the claim amounts to instructions to apply the abstract idea on generic computer. *Id.*

As an initial matter, we are not persuaded of error by Appellant’s argument that claim 1 does not preempt or monopolize the abstract idea. Br. 10, 15–16. Although preemption may be the concern behind the judicial exceptions to statutory subject matter, preemption is not the test for eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability. For this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citation omitted). Accordingly, we consider Appellant’s arguments under the two-step patent-eligibility analysis.

Pursuant to the first step, Appellant asserts that claim 1 is not directed to an abstract idea, but rather to an inventive, novel, and nonobvious digital television broadcast apparatus. Br. 10. Appellant’s argument does not apprise us of error.

At the outset, we note our reviewing court has explained that “not every claim that recites concrete, tangible components escapes the reach of the abstract-idea inquiry.” *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016) (citations omitted). Consequently, the fact that claim 1 is directed to a digital television broadcast apparatus does not preclude a determination that the claim is directed to an abstract idea.

We further note that patentability over the prior art in accordance with 35 U.S.C. §§ 102 or 103 is not the test for patent-eligibility under § 101. *See, e.g., Diamond v. Diehr*, 101 S. Ct. 1048, 1058 (1981) (“The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no

relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.”). That said, novelty in the implementation of an abstract idea can affect patent-eligibility under the second step. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (“[N]ovelty in implementation of the idea is a factor to be considered only in the second step of the *Alice* analysis.”). Accordingly, we address Appellant’s argument regarding the alleged novelty and nonobviousness of the claimed invention under the second step.

In regard to the first step of the patent-eligibility analysis where we determine whether a claim is directed to excluded subject matter, e.g., an abstract idea, our reviewing court has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). For computer-implemented inventions in particular, such as the present invention, “the first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Id.* at 1335–36.

Here, claim 1 recites: storing a plurality of news stories and ratings information for the news stories; storing information regarding a request by an individual to receive an alert message for a posting of a news story, wherein the request to receive an alert message includes search criteria; detecting a posting of a news story and determining whether the news story

satisfies the search criteria; if the news story satisfies the search criteria, generating an alert message containing information regarding the news story and ratings information for the news story; and transmitting the alert message. Thus, the claimed invention enables an individual to receive an alert upon the posting of a news story that satisfies the criteria in the individual's request. *See also* Br. 13–14 (acknowledging that the digital television broadcast apparatus “allows an individual to request and be provided, in a broadcast television and Internet-convergent environment, with an alert message containing information regarding the posting or the storing of a news story and ratings information regarding that news story”).

Furthermore, as Appellant points out (Br. 10), claim 1 additionally recites a digital television broadcast apparatus comprising a database, memory device, processor, and transmitter. There is no indication, however, that the claimed components are something other than generic computing components. *Cf.* Spec. 35–36 (describing central processing computer 10), Fig. 2.

Moreover, Appellant's Specification does not describe an improvement to the computer capabilities of the claimed invention. Rather, the Specification explains that the claimed invention addresses a drawback associated with conventional broadcasting services, namely individuals having to rely on news reporting services that typically gather and disseminate news stories in a fashion or order geared toward maximizing advertising revenues. *Id.* at 2. As a result, an individual interested in a particular news story may have to watch the better part of a television news broadcast before the story is presented. *Id.* By the same token, stories of a particular interest might be gathered by different news reporting services and

therefore not available to an individual watching one news broadcasting service. *Id.* The Specification further explains that the invention resolves this drawback by providing information in a convergent environment. *Id.* at 3.

Accordingly, the claimed invention uses the recited computing components to perform the functions that enable an individual to receive an alert upon the posting of a news story that satisfies the criteria in the individual's request. The focus of the claimed invention is not on an improvement in computer capabilities, but rather on a process for providing information relating to broadcasted news stories for which computing devices are invoked merely as tools. Appellant, therefore, does not apprise us of error in the Examiner's determination that the character of claim 1, as a whole, is directed to "providing information in a digital television and internet convergent function."

Appellant does not refute that "providing information in a digital television and internet convergent function" is an abstract idea. *See* Ans. 2–3 (comparing the concept of "providing information in a digital television and internet convergent function" to other concepts the courts have held to be abstract ideas). Consequently, Appellant does not apprise us of error in the Examiner's determination that claim 1 is directed to the abstract idea of "providing information in a digital television and internet convergent function."

Turning to the second step of the patent-eligibility analysis, Appellant alleges that claim 1 recites an inventive concept under the second step for essentially the same reason Appellant argues that claim 1 is not directed to an abstract idea under the first step. Namely, Appellant contends the claim

recites an inventive, novel, and nonobvious digital television broadcast apparatus such that the claim is directed to a particular application. Br. 12–15. Appellant’s argument does not apprise us of error in the Examiner’s determination pursuant to the second step.

Although the second step of the patent-eligibility analysis is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or nonobviousness, but rather, a search for “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1294). The question in the second step is not whether the claimed invention is novel, but rather whether the implementation of the abstract idea involves “more than performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) (quoting *Alice*, 134 S. Ct. at 2359).

Here, claim 1 recites a computer-implemented invention. Namely, claim 1 recites a digital television broadcast apparatus comprising a database, memory device, processor, and transmitter. *See also* Spec. 6 (“Any number of central processing computers can be utilized in the apparatus of the present invention in order to perform the operations and/or functions described herein as being provided by the apparatus of the present invention.”). As set forth above, however, there is no indication that the claimed computing components are something other than generic computing components. *Cf.* Spec. 35–36 (describing central processing computer 10), Fig. 2. Also, there is no indication that the performance of the recited

functions, i.e., storing news stories, ratings information, and an individual's request including search criteria, detecting the posting of a news story, determining whether a news story satisfies the search criteria, generating an alert message, and transmitting the alert message to the individual, requires something apart from computer functions that are well-known, routine, and conventional activities, such as storing, receiving, processing, and transmitting data. As such, we fail to see how the claimed invention is something other than the generic computer implementation of the abstract idea, which is not sufficient to transform the invention into a patent-eligible application. *See Alice*, 134 S. Ct. at 2358 (“[W]holly generic computer implementation is not generally the sort of ‘additional featur[e]’ that provides any ‘practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.’” (quoting *Mayo*, 132 S. Ct. at 1297)).

Furthermore, claim 1 includes limitations relating to broadcasting. In particular, claim 1 recites storing a plurality of news stories and ratings information and processing information regarding digital television broadcasting content. As such, claim 1 is linked to the field of broadcasting by only the nature of the data, which is not sufficient to transform the invention into a patent-eligible application. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) (“[M]erely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes, whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas.”).

In view of the foregoing, Appellant does not apprise us of error in the Examiner's determination that claim 1 is patent-ineligible, i.e., judicially excepted from statutory subject matter. Accordingly, we sustain the rejection of claim 1 under 35 U.S.C. § 101.

Obviousness

Appellant argues that the Examiner has not provided sufficient reasons for combining the teachings of the cited prior art such that the Examiner is using hindsight to reconstruct the claimed invention. Br. 17–22. We are not persuaded of error.

In rejecting claim 1, the Examiner finds Anaya discloses the invention substantially as claimed. Final Act. 6–8. Although Anaya discloses a database storing a plurality of news stories, the Examiner acknowledges Anaya does not disclose that each news story contains video information and audio information and is capable of being transmitted on, over, or via a digital television broadcast network, the Internet, the World Wide Web, a cellular communication network, or a wireless network. *Id.* at 8. For this, the Examiner relies on Del Sesto (*id.* at 8–9), and determines it would have been obvious to a person of ordinary skill in the art to modify the teachings of Anaya to include Del Sesto's teaching of audio and video information that is capable of being transmitted over a network Sesto "to allow sellers to download content from the storage to their own systems via the SMOS network for convenience and easy access" (*id.* at 9).

Here, the Examiner is proposing to modify the data stored in Anaya's database to include the data taught by Del Sesto. A person of ordinary skill in the art would have understood that making data capable of transmission

over a network would make the data more accessible. As such, the Examiner has provided a reason supported by rational underpinning for modifying Anaya's data to include Del Sesto's data containing audio and video information and being capable of transmission over a network.

The Examiner also finds that Anaya discloses transmitting an alert to a communication device, but does not disclose that the communication device is associated with an individual. Final Act. 7–8. For this, the Examiner relies on Del Sesto (*id.* at 9–10), and determines it would have been obvious to modify Anaya's disclosure to include Del Sesto's teaching of transmitting an alert to an individual's communication device “in order to reach the communication device associated with the individual, and further reach users with alert messages of newly acquired information or update the users with current messages” (*id.* at 10). A person of ordinary skill would have appreciated that associating a communication device with a user would enable an alert to more easily reach the individual. Accordingly, the Examiner has provided a reason supported by rational underpinning for modifying Anaya's communication device to be a communication device associated with an individual, as taught by Del Sesto.

Lastly, the Examiner finds Anaya and Del Sesto do not disclose that the database stores ratings information for the news stories, and the Examiner relies on Wiser for teaching the claimed ratings information. Final Act. 10. The Examiner determines it would have been obvious to combine the teachings Anaya and Del Sesto with Wiser's teaching of storing ratings information “to allow the recommendation engine to match content to the viewer's individual interests and preferences.” *Id.* Indeed, a person of ordinary skill would have understood that including ratings information

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would allow for more acute matching of the stored information to the individual's interests and preferences. Thus, the Examiner's reason for combining the teachings of the references is supported by rational underpinning.

In view of the foregoing, Appellant does not apprise us of Examiner error. Accordingly, we sustain the rejection of claim 1 under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision to reject claim 1 under 35 U.S.C. § 101 is affirmed.

The Examiner's decision to reject claim 1 under 35 U.S.C. § 103(a) 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). 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED