



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/853,239	08/09/2010	Lambertus Hesselink	LP4578-PRI-US-1	5470
140742	7590	12/04/2017	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			CIVAN, ETHAN D	
			ART UNIT	PAPER NUMBER
			3684	
			NOTIFICATION DATE	DELIVERY MODE
			12/04/2017	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jayna.cartee@knobbe.com
efiling@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LAMBERTUS HESSELINK

Appeal 2016-005857
Application 12/853,239¹
Technology Center 3600

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

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's non-final rejection of claims 1–22. We have jurisdiction under 35 U.S.C. § 6(b). A hearing was held on October 31, 2017.

SUMMARY OF DECISION

We AFFIRM.

¹ Appellant identifies Western Digital Corporation as the real party in interest. App. Br. 3.

THE INVENTION

Appellant claims a solution for allowing users to aggregate multimedia content and provide a way for them to legitimately duplicate the content, if desired. Spec. ¶ 3.

Claim 1 reproduced below, is representative of the subject matter on appeal.

1. A personal content archive device configured to consolidate multimedia content for a user, said personal archive device comprising:
 - an input interface for receiving a signal indicating when multimedia content stored on a data storage medium has been inputted;
 - a secured storage configured to protect information based on at least one digital rights management scheme;
 - a network interface capable of communicating with a registration server over a network; and
 - a processor, configured by instructions, to:
 - automatically detect input of the data storage medium based on the signal from the input interface;
 - automatically identify the multimedia content stored on the data storage medium;
 - register the data storage medium with the registration server;
 - request download of an authorized version of the multimedia content;
 - download the authorized version of the multimedia content; and

Appeal 2016-005857
Application 12/853,239

store the authorized version of the multimedia
content.

THE REJECTION

Claims 1–22 are rejected under 35 U.S.C. § 101 as directed to non-
statutory subject matter.

ANALYSIS

35 U.S.C. § 101 REJECTION

Claims 1–22 are rejected under 35 U.S.C. § 101 as directed to non-
patent eligible subject matter. We sustain this rejection.

Representative independent claim 1 recites in pertinent part:

*automatically detect[ing] input of the data storage
medium based on the signal from the input interface;
automatically identify[ing] the multimedia content
stored on the data storage medium;
register[ing] the data storage medium with the
registration server;
request[ing] download of an authorized version of
the multimedia content;
download[ing] the authorized version of the
multimedia content; and*

Appeal 2016-005857
Application 12/853,239

*stor[ing] the authorized version of the multimedia
content.*

Appeal Br. 18.

The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First,[] determine whether the claims at issue are directed to one of those patent-ineligible concepts. If so, we then ask, “[w]hat else is there in the claims before us?” To answer that question,[] consider the elements of each 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. [The Court] described step two of this analysis as a search for an “inventive concept”—*i.e.*, 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 Corp. Pty. Ltd. v. CLS Bank Int’l, 134 S. Ct. 2347, 2355 (2014)
(citations omitted) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

Although the Court in *Alice* made a direct finding as to what the claims were directed to, we find that this case’s claims themselves and the

Appeal 2016-005857
Application 12/853,239

Specification provide enough information to inform one as to what they are directed to.

The steps in claim 1 result in downloading the authorized version of the multimedia content and storing the authorized version of the multimedia content. The Specification at paragraph 2 recites:

However, commercially available multimedia content is protected by copyrights. The content providers also employ strong measures in preventing pirate copying of media like CDs, DVDs, BDs and other media, etc. This leads to some of the devices of a user unable to read such protected content items stored on optical discs or magnetic disks. Another limitation is that these protection schemes prevent a user from creating backup copies for personal use or for use on a different device.

It follows from Supreme Court cases, and *Gottschalk v. Benson*, 409 U.S. 63 (1972) in particular, that the claims at issue here are directed to an abstract idea. Insuring authorized transfer of a product/service in a transaction is a fundamental economic practice because it insures that transfer occurs subject to some exchange of value. The patent-ineligible end of the 35 U.S.C. § 101 spectrum includes fundamental economic practices. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2355–57. Thus, insuring authorized transfer of the product/service in a transaction is an “abstract idea” beyond the scope of 35 U.S.C. § 101.

As in *Alice Corp. Pty. Ltd.*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction

Appeal 2016-005857
Application 12/853,239

between the concept of an intermediated settlement in *Alice* and the concept of insuring authorized transfer of a product/service in a transaction, at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. That the claims do not preempt all forms of the abstraction or may be limited to digitized content, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1360–61 (Fed. Cir. 2015).

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two.

[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implemen[t]” an abstract idea “on ... a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our [35 U.S.C.] § 101 jurisprudence. Given the ubiquity of computers, wholly 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.”

Alice Corp. Pty. Ltd., 134 S. Ct. at 2358 (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to transfer data, i.e., take in data, compute a result, and return the result to a user amounts to electronic data query and retrieval—some of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellant’s method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellant’s claims simply recite the concept of insuring authorized transfer of a product/service in a transaction. The claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than instructions to insure authorized transfer of a product/service in a transaction, on a generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360.

As to the structural claims, they

Appeal 2016-005857
Application 12/853,239

are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea. This Court has long “warn[ed] ... against” interpreting [35 U.S.C.] § 101 “in ways that make patent eligibility ‘depend simply on the draftsman’s art.’”

Alice Corp. Pty. Ltd., 134 S. Ct. at 2360 (citations omitted).

Appellant argues:

Claim 1 is analogous to the claims in DDR, and therefore likewise is not directed to an abstract idea. Specifically, claim 1 includes “**automatically detect[ing]** input of the data storage medium” and “**automatically identify[ing]** the multimedia content stored on the data storage medium,” among other features (emphasis added). Claim 1 further addresses a business challenge (preserving digital rights of digital media content) that is particular to the Internet and data storage/access technologies.

Appeal Br. 11.

We disagree with Appellant. In *DDR*, the claims at issue involved, inter alia, “web pages displays [with] at least one active link associated with a commerce object associated with a buying opportunity of a selected one of a plurality of merchants.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) (claim 1 of US 7,818,399). There is no such web page with an active link in the claims here before us. All that is required by claim 1 is “an input interface,” “secure storage,” a “processor,” a “data storage medium,” and a “computing device”—all generic device components. The Specification supports the view that the device/system are

Appeal 2016-005857
Application 12/853,239

conventional. *See, e.g.*, Spec. ¶¶ 31, 32. “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2358 (citation omitted).

Appellant further argues,

Claim 1 further recites a number of features that go beyond the alleged abstract idea. In discussing the patent eligibility of the subject matter of claims in SiRF Technology Inc. v. International Trade Commission, 601 F.3d 1319 (Fed. Cir. 2010) (SiRF Tech), the Abstract Ideas Examples find it material that the subject claims were “further limited to a mobile device comprising a GPS receiver, microprocessor, wireless communication transceiver and a display.” p. 12. In the present Application, claim 1 is limited to “personal content archive device” comprising “an input interface,” “a secured storage,” “a network interface” and “a processor.” The Applicant submits that at least these additional features of claim 1, similarly to the relied-upon features in SiRF, are “meaningful limitations,” *Id.*, and establish claim 1 as being directed to patent eligible subject matter.

Appeal Br. 13.

We disagree with Appellant. Appellant’s analysis, based on the premise that both cases involve devices, stops there. In *SiRF*, the ensuing method was used to effect an improvement in the device itself, namely, effecting more accurate position results in the GPS device—a device specially programmed for rendering global position. In the case at hand, however, the method only uses known device elements to improve how the abstraction is effected, namely how content is managed. That claim 1 recites

Appeal 2016-005857
Application 12/853,239

transferring the content via a processor, a data storage medium, and a network interface does not make it patent eligible because claim 1 does not recite any specific means constituting an improvement in the technical field or technology of storage devices/systems. *See McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016).

Appellant's remaining arguments are covered in our analysis *supra* and are not deemed persuasive for the reasons set forth therein.

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 1–22 under 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 1–22 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.