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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARTIN PAUL RIGBY

Appeal 2016-007094
Application 13/012,002¹
Technology Center 3600

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
NINA L. MEDLOCK, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Martin Paul Rigby (Appellant) seeks our review under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–9, 12–14, 16–23, 25–27, 29–32 and 34. We have jurisdiction under 35 U.S.C. § 6(b).

An oral hearing was held on March 29, 2018.

SUMMARY OF DECISION

We AFFIRM.

¹ The Appellant identifies PSONAR LIMITED as the real party in interest. App. Br. 3.

THE INVENTION

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

1. A computer implemented method of distributing media content within a computer network that includes a communications system; an account database associating users with account data; a content database storing a plurality of media files; and a user terminal, the method comprising:

receiving a download request via the communications system from a user via the user terminal for purchase of a media file stored in the content database, wherein the media file requires purchase according to one of limited play status that allows a finite number of plays of the media file and unlimited play status that allows an unlimited number of plays of the media file, wherein said download request includes data identifying a media file stored in the content database and status data indicative of either limited play status or unlimited play status when the media file is purchased;

updating the account data within the account database associated with a user making the request via the user terminal on the basis of the status information included in the request by decrementing the account data by a first amount if a download request includes data indicative of the media file purchased with limited play status and decrementing the account data by a second amount if a download request includes data indicative of the media file purchased with unlimited play status wherein the second amount is greater than the first amount;

transmitting, via the computer network, data corresponding to the media file identified in the received request to the user terminal, such that complete media files are transmitted and associated with a set number of plays, including limited or unlimited play status, which enables utilization of the media files without connecting to the content database and thereby reduces data transfer that would otherwise be required;

inhibiting, via the computer network, the utilization of the transmitted media file more than a predetermined number of times

without updating the account database if the download request includes status data indicative of limited play status; and

permitting utilization, via the computer network, of the transmitted media file more than a predetermined number of times without updating the account database if the download request includes status data indicative of unlimited play status.

THE REJECTION

The following rejection is before us for review:

1. Claims 1–9, 12–14, 16–23, 25–27, 29–32 and 34 are rejected under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

ISSUE

Did the Examiner err in rejecting claims 1–9, 12–14, 16–23, 25–27, 29–32 and 34 under 35 U.S.C. § 101 as being directed to judicially-excepted subject matter.

ANALYSIS

The Appellant argued these claims as a group. *See* App. Br. 14–21. We select claim 1 as the representative claim for this group, and the remaining claims 2–9, 12–14, 16–23, 25–27, 29–32 and 34 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Alice Corp. Party. Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under §101.

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

In that regard, the Examiner determined that “[t]he claim(s) is/are directed to the abstract idea of a fundamental economic practice of distributing media content within a computer network.” Final Rej. 5.

The Appellant does not dispute that distributing media content within a computer network is an abstract idea. Rather, the Appellant argues that “the claimed subject matter is not directed to merely implementing a basic economic practice with a computer, and instead includes elements that address issues and solve problems ‘specifically arising in the realm of computer networks.’” App. Br. 20. In other words, the Appellant disagrees with the Examiner’s characterization of what the claims are directed to. Rather, according to the Appellant, the claims recite an improvement to the functioning of a computer itself. App. Br. 21.

The Appellant contends that the claims recite an improvement to the functioning of a computer itself because it recites “complete media files are transmitted and associated with a set number of plays, including limited or unlimited play status, which enables utilization of the media files without connecting to the content database and thereby reduces data transfer that would otherwise be required.” App. Br. 21 (reproducing the claim limitation in claim 1; the same limitation appears in the other independent claims – claims 14, 16, 25 and 30).

The difficulty with this contention is that the subject matter as claimed does not necessarily lead to the argued-over improvement to the functioning

of the computer. Although the claims include the phrase “reduc[ing] data transfer that would otherwise be required” which, in practice, is arguably indicative of an improvement to the functioning of a computer, the data-reduction in data transfer is (according to the claims) a consequence of the “utilization of the media files without connecting to the content database” (claim 1). In other words, only when the media files are utilized “without connecting to the content database” does one achieve the “reduc[ing] data transfer that would otherwise be required” computer-functioning improvement. Put another way, there is no “reduc[ing] data transfer that would otherwise be required” computer-functioning improvement unless the media files are utilized “without connecting to the content database.” However, the claims currently only require the “utilization of the media files without connecting to the content database and thereby reduces data transfer that would otherwise be required” be *enabled*.

Accordingly, the Appellant’s argument that the claims *recite* an improvement to the functioning of a computer itself (i.e., “reduc[ing] data transfer that would otherwise be required”) is not commensurate in scope with what is claimed. The claims are not limited to necessarily achieve that result. This point was made during the hearing. *See* Record of Oral Hearing, mailed April 18, 2018. During said hearing, counsel agreed that the claims simply call for “*enabl[ing]* utilization of the media files without connecting to the content database and thereby reduces data transfer that would otherwise be required.” Claim 1 (emphasis added). Because the process as claimed does not actually require “utilization of the media files without connecting to the content database” and thus does not actually yield

the “reduc[ing] data transfer that would otherwise be required” computer-functioning improvement, the Appellant’s argument challenging the Examiner’s determination under step one is unpersuasive.

We make no comment on the patent-eligibility of claims were they to reflect the argued-over inventive improvement.

Step two is “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.’” *Id.* (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)).

In that regard, the Examiner determined, *inter alia*, that

[t]he additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount(s) to no more than: (i) mere instructions to implement the idea on a computer, and/or (ii) recitation of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry. Viewed as a whole, these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such that the claim(s) amounts to significantly more than the abstract idea itself. The claim limitations in addition to the abstract idea include a computer implemented method of distributing media content within computer network. This is simply a generic recitation of a computer and a computer network performing their basic functions. The claim amounts to no more than stating process of a user's download request for purchase of a media file over the network, transmitting data corresponding to the media file over the network and utilizing the transmitted data file via the network. These generic computing elements alone do not amount to significantly more than the judicial exception.

Final Rej. 5–6.

Here, again, the Appellant challenges said determination by arguing that “[t]he claims now specifically recite a structure that ‘reduces data transfer that would otherwise be required.’” App. Br. 14. However, for the reasons discussed, the claims are not in fact limited to achieving said result. Accordingly, the Appellant’s argument challenging the Examiner’s determination under step two because “[t]he claims now specifically recite a structure that ‘reduces data transfer that would otherwise be required’” is unpersuasive.

As we stated, we make no comment on the patent-eligibility of claims were they to reflect the argued-over inventive improvement.

For the foregoing reasons, the Appellant’s argument is unpersuasive as to error in the Examiner’s determination that claim 1 does not include an element or combination of elements sufficient to ensure that the claimed subject matter in practice amounts to significantly more than to be upon the abstract idea itself.

We have considered all of the Appellant’s remaining arguments and have found them unpersuasive. Accordingly, we find the Examiner’s determination that representative claim 1, and claims 2–9, 12–14, 16–23, 25–27, 29–32, which stand or fall with claim 1, are directed to ineligible subject matter under 35 U.S.C. § 101 has not been shown to be in error. *Cf. LendingTree, LLC v. Zillow, Inc.*, 656 F. App’x 991, 997 (Fed. Cir. 2016) (“We have considered all of LendingTree’s remaining arguments and have found them unpersuasive. Accordingly, because the asserted claims of the patents in suit are directed to an abstract idea and do not present an

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‘inventive concept,’ we hold that they are directed to ineligible subject matter under 35 U.S.C. § 101.”).

DECISION

The decision of the Examiner to reject claims 1–9, 12–14, 16–23, 25–27, 29–32 and 34 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)(1)(iv).

AFFIRMED