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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SANJEEV KUMAR BISWAS,
PRADEEP CYRIL EKKA, SURAJ RANJAN,
and VIKAS KAMATE

Appeal 2017-000019
Application 12/273,925
Technology Center 3600

Before JAMES R. HUGHES, JUSTIN BUSCH, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

BUSCH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellants appeal from the Examiner's decision to reject claims 1–17 and 27–36, which constitute all the claims pending in this application. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b). Claims 18–26 were previously canceled. We affirm.

CLAIMED SUBJECT MATTER

Appellants' invention is generally directed to using a hierarchical license tree, which is a tree used to manage software licenses wherein each node in the hierarchical tree represents a software resource with associated

license information. Spec. 3. The claimed system and methods (1) receive license information, (2) identify a node in the hierarchical license tree based on that license information, then (3) store a software resource license that indicates the software resources corresponding to that node and each node below that node are licensed for use. *See, e.g.*, Spec. 20–21. Claims 1 and 31–33 are the independent claims. Claim 1 is representative and reproduced below:

1. A computer-implemented method comprising:
receiving, by a processor, license information;
identifying, by the processor, a first node in a software resource hierarchical license tree based at least in part on the received license information, the software resource hierarchical license tree comprising a plurality of nodes, each of the plurality of nodes corresponding to a respective software resource; and
storing, by the processor, a software resource license corresponding to the first node, the software resource license indicating that the software resource corresponding to the first node and software resources corresponding to nodes beneath the first node in the software resource hierarchical license tree are licensed for use.

REJECTIONS

Claims 1–17 and 27–36 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. Final Act. 5–6.

Claims 1–17 and 27–36 stand rejected under 35 U.S.C. § 103(a) as obvious in view of Ishiguro (US 2003/0159033 A1; Aug. 21, 2003), Stefik (US 2006/0190404 A1; Aug. 24, 2006), and Markov (US 7,743,378 B1; June 22, 2010). Final Act. 8–26.

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments that the Examiner erred. In reaching this decision, we have

considered all evidence presented and all arguments Appellants made. Appellants argue the claims as a group. *See* App. Br. 4–5, 7, 11. Therefore, we select claim 1 as representative and decide the appeal of all claims based on independent claim 1. 37 C.F.R. § 41.37(c)(1)(iv). Arguments Appellants could have made, but chose not to make in the Briefs, have not been considered and are deemed waived. *See id.*

THE § 101 REJECTION

The Examiner concludes claims 1–17 and 27–36 are directed to judicially excepted subject matter. Final Act. 4–5; Ans. 3–11. In particular, the Examiner finds representative claim 1 merely recites receiving, identifying, and storing information and, accordingly, concludes that claim 1 is directed to data recognition and storage. Ans. 5. The Examiner concludes the claimed concept of “enforcing digital rights management restrictions based upon a hierarchical tree architecture” is judicially excepted subject matter and the particular elements recited in the claims are merely generic computer components performing generic computing functions, without imposing meaningful limits on the claims. *Id.* at 6–10 (quoting *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343 (Fed. Cir. 2014) (finding claims directed to collecting data, recognizing certain data within the collected set, and storing that data in memory to be no more than an abstract idea)).

Prima Facie Case

Appellants argue the Examiner failed to state a prima facie rejection under 35 U.S.C. § 101 in the Final Rejection. App. Br. 5–6. Appellants further contend the Examiner’s additional explanation of the rejection under § 101 in the Answer “is too late.” Reply Br. 2–3.

The Examiner has a duty to give notice of a rejection with sufficient particularity to give Appellants a fair opportunity to respond to the rejection. *See* 35 U.S.C. § 132(a). To the extent that the Examiner’s additional explanation and citation to case law should have been designated as a new ground of rejection, that would be a matter addressed by petition. 37 C.F.R. § 41.40 (“Any request to seek review of the primary examiner’s failure to designate a rejection as a new ground of rejection in an examiner’s answer must be by way of a petition to the Director under §1.181 of this title filed . . . before the filing of any reply brief”). “Failure of appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.” *Id.* Accordingly, for purposes of this Appeal, we consider the Examiner’s findings and conclusions from both the Final Rejection and the Examiner’s Answer.

Here, we find the Examiner’s rejection satisfies the initial burden of production by identifying that the claims include limitations similar to the identified abstract idea of collecting, identifying, and storing data, and that the remainder of the claims do not include significantly more than the abstract idea because the generically recited routine use of a computer does not add meaningful limitations to the abstract idea. Final Act. 4–5; Ans. 3–11. The Examiner set forth the statutory basis for the rejection (i.e., 35 U.S.C. § 101) and concluded the claims are directed to a judicial exception to § 101 (i.e., an abstract idea), adding too little to the abstract idea to render the claims patent eligible. Thus, the Examiner explained the rejection in sufficient detail to permit Appellants to respond meaningfully. *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011).

In fact, Appellants specifically argue against the Examiner’s findings and conclusions relating to what Appellants’ claims are directed to, whether that is an abstract idea, and whether the claims recite significantly more than the abstract idea itself. App. Br. 6–9; Reply Br. 3–5. Accordingly, we conclude that the Examiner set forth a prima facie case of ineligibility.

Alice/Mayo Framework

The Patent Act defines patent-eligible subject matter broadly: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. There is no dispute in this Appeal that the pending claims are directed to one of these categories.

In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 70 (2012), and *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2354 (2014), the Supreme Court explained that § 101 “contains an important implicit exception” for laws of nature, natural phenomena, and abstract ideas. *See Diamond v. Diehr*, 450 U.S. 175, 185 (1981). In *Mayo* and *Alice*, the Court set forth a two-step analytical framework for evaluating patent-eligible subject matter: (1) “determine whether the claims at issue are directed to” a patent-ineligible concept, such as an abstract idea; and, if so, (2) “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements” add enough to transform the “nature of the claim” into “significantly more” than a patent-ineligible concept. *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79); *see Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Step one in the *Mayo/Alice* framework involves looking at the “focus” of the claims at issue and their “character as a whole.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). Step two involves the search for an “inventive concept.” *Alice*, 134 S. Ct. at 2355; *Elec. Power*, 830 F.3d at 1353. For an inventive concept, “more is required than ‘well-understood, routine, conventional activity already engaged in’” by the relevant community. *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1047 (Fed. Cir. 2016) (quoting *Mayo*, 566 U.S. at 79–80).

Step One of Alice Framework

Turning to step one of the *Alice* framework, the Examiner finds the claims are directed to the concept of managing digital rights using a hierarchical tree architecture, which is merely the receipt, identification, and storage of information. Ans. 5–6. The Examiner finds *Content Extraction*’s claims, which were found to be directed to abstract ideas, are similar to Appellants’ claims. Ans. 8–10 (citing *Content Extraction*, 776 F.3d at 1343).

Appellants assert “there is nothing ‘fundamental’ to the general practice of licensing that requires the practice of the method recited in claim 1,” and the claims do not preempt the entire field of licensing. App. Br. 7. Appellants also contend the Examiner’s characterization of claim 1 views the claim at too high a level of abstraction and reads out details of the claim. Reply Br. 3. In particular, Appellants argue the Examiner’s characterization ignores the data structure recited in the claims and how the recited “data structure provides the licensing (or lack thereof) of one [or more] software applications.” *Id.* at 4. Appellants contend the recited data

structure provides a technical improvement. *Id.* (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336–38 (Fed. Cir. 2016)).

We are not persuaded by Appellants’ arguments. Rather, we agree with the Examiner that claim 1, as a whole, is directed to receiving information, recognizing or identifying other data (in a hierarchical tree structure) based on the received information, and storing additional information.

The Federal Circuit has “treated *collecting information*, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.” *Elec. Power*, 830 F.3d at 1353–54 (emphasis added) (finding collecting, analyzing, and displaying information, regardless of particular content, is an abstract idea); *Content Extraction*, 776 F.3d at 1347 (finding collecting, recognizing, and storing information is an abstract idea); *see also Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348–49 (Fed. Cir. 2015); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015).

Appellants’ assertion regarding pre-emption is unpersuasive, because although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“And [the fact] that the claims do not preempt all price optimization or may be

limited to price optimization in the e-commerce setting do[es] not make them any less abstract.”).

Finally, Appellants’ argument that claim 1 recites a technological improvement is also unavailing. In *Enfish*, the Federal Circuit found the self-referential table recited in the claims was a *new* data structure; on the other hand, Appellants’ claim 1 merely recites populating an existing data structure with specific data, namely licensing information.

For the above reasons, we are unpersuaded the Examiner erred in concluding the claims are directed to an abstract idea.

Step Two of Alice Framework

Next, we turn to step two of *Alice* to determine whether the limitations, when considered both “individually and ‘as an ordered combination’” contain an “inventive concept” sufficient to transform the claimed “abstract idea” into a patent-eligible application. *Alice*, 134 S. Ct. at 2355–58. The Examiner finds the claims merely recite using generic computer elements performing generic computer functions without imposing meaningful limits or improving the functioning of the computer itself or any other technology. Ans. 7. Thus, the Examiner concludes the claims do not recite significantly more than the abstract idea itself sufficient to transform the claim into a patent-eligible invention. *Id.*

Appellants argue the Examiner has not shown the claims fail to recite significantly more than the abstract idea itself because the claims recite a software resource hierarchical license tree. App. Br. 7–8. Appellants allege the recited tree can be used for managing software licenses, which is “a result that overrides the routine and conventional use of the Internet or a conventional computer.” *Id.* (citing *DDR Holdings, LLC v. Hotels.com*,

L.P., 773 F.3d 1245, 1255 (Fed. Cir. 2014)). Appellants analogize their claims to those in *DDR* and contend “[c]hanging the typical operation of a conventional computerized process is sufficient for patent-eligibility.” *Id.* at 8–9 (citing *DDR*, 773 F.3d at 1258–59).

We are unpersuaded the Examiner erred in concluding the claims do not recite significantly more than the abstract idea itself. Appellants’ claim 1 merely recites receiving information, identifying a data structure (a node in a hierarchical tree) based on the received information, and stores information that can be used for managing licenses in the identified node.

As discussed above, Appellants’ use of a known hierarchical tree structure to store particular information is nothing more than the routine use of a conventional computer. *See Enfish*, 822 F.3d at 1335–36 (“[T]he first step . . . 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.”); *see also Alice*, 134 S. Ct. at 2358–59. Here, the focus of the claims is not on an improvement in computers as tools or upon an innovative way to use computers or other devices, but is focused on an independently abstract idea that uses generic and routine equipment as tools.

More specifically, hierarchical tree structures are designed to store data or data structures at each node of the tree. The fact that the particular information stored in that node could be used to determine whether or not a particular computer or user is licensed to use the software resource affiliated with that node does not change how the computer or the data structure functions. Thus, Appellants’ analogy to *DDR* is misplaced and not persuasive.

For the above reasons, Appellants have not persuaded us of error in the rejection of the claims under 35 U.S.C. § 101.

THE § 103 REJECTION

The Examiner finds Ishiguro teaches or suggests the receiving and identifying steps other than “a software resource.” Final Act. 9 (citing Ishiguro ¶ 7, Figs. 8–9, 12–14, 21–22, 30, 38, and accompanying text). The Examiner appears to rely on Stefik for teaching the software resource, stating Stefik “discloses a hierarchical tree structure for associating digital rights to digital works.” *Id.* (citing Stefik ¶ 55). Finally, the Examiner finds Markov teaches or suggests the storing step because Markov “discloses hierarchical node characteristics.” *Id.* at 10 (citing Markov 3:15–27, 4:3–7, 4:30–38).

Of particular note, Markov is directed to methods for scheduling computing jobs in a system having multiple computing nodes, wherein the computing jobs have required resources. Markov Abstract. Markov’s computing nodes may be arranged in a hierarchical tree structure, such that nodes may have parent-child relationships to other nodes. *Id.* at 3:5–27. Markov describes each node as having both fixed and floating resources that may be used to execute computing jobs. *Id.* at 3:40–42. “One example of a floating resource is a software license.” *Id.* at 4:3. When Markov’s computing nodes are arranged in a tree structure, a software license available to a particular node may also be available to any child node of that particular node. *Id.* at 4:4–7.

Among other arguments, Appellants contend the Examiner finds only that Markov discloses hierarchical node characteristics, not the “a software resource license corresponding to the first node, the software resource

license indicating that the software resource corresponding to the first node and software resources corresponding to nodes beneath the first node in the software resource hierarchical license tree are licensed for use” (the “disputed limitation”), as recited in claim 1. App. Br. 11 (citing Final Act. 10). Appellants assert the Examiner merely concludes (without explaining what a hierarchical node characteristic is, how it teaches the disputed limitation, or any supporting rationale) that, because Markov teaches a hierarchical node characteristic, Markov teaches the disputed limitation. *Id.* at 11–12.

Appellants further argue Markov describes a software license as a floating resource that may be assigned to, or available for use by, a particular computing node in the node hierarchy and any of that particular node’s children. App. Br. 12. Appellants contend Markov’s floating resource concept that allows multiple computers to share a single license to a single software resource is unrelated to the disputed limitation that indicates which particular software resources within the software resource hierarchical license tree are licensed for use (by a particular computer or user). *Id.* at 12–13.

The entirety of the Examiner’s response is: (1) quoting a portion of Appellants’ argument; (2) stating disagreement; (3) identifying essentially the same portions of Ishiguro, Stefik, and Markov referenced in the Final Action; and (4) stating that “it appears as if the Appellant is attacking the references in a piecewise fashion, instead of in combination, as intended by the Examiner and as shown above in the rejections under 35 USC § 103(a).” Ans. 12.

We agree with Appellants that the Examiner has not demonstrated the combination of Ishiguro, Stefik, and Markov teaches the disputed limitation. As pointed out by Appellants, the Examiner appears to rely on Markov's "hierarchical node characteristics" as teaching the disputed limitation. However, the Examiner provides no explanation regarding how the fact that Markov discloses a hierarchical tree architecture for arranging its computing nodes teaches the disputed limitation. Furthermore, even to the extent the Examiner relies on Markov as teaching the disputed limitation, we agree with Appellants' that Markov's computing node arrangement and availability of a software license as a floating resource fails to teach or suggest the disputed limitation, which relates to identifying software resources licensed to a particular user or computer. To the extent the Examiner relies on Ishiguro and/or Stefik, alone or in combination (with or without Markov), the Examiner fails to provide a clear mapping and explanation sufficient to determine whether such a proposed combination teaches or suggests the disputed limitation.

For the reasons discussed above, we are persuaded the Examiner erred. Accordingly, we do not sustain the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a). For similar reasons, we also do not sustain the Examiner's rejection of independent claims 31 and 32, which also recite the disputed limitation, or claims 2–17, 27–30, 35, and 36, which ultimately depend from claim 1.

Claims 33 and 34 do not recite the disputed limitation and, therefore, Appellants' arguments are not commensurate with the scope of claims 33 and 34. Accordingly, we summarily affirm the Examiner's rejection of claims 33 and 34, which are not argued separately with particularity.

DECISION

We affirm the Examiner's decision to rejection claims 1–17 and 27–36 as directed to ineligible subject matter under 35 U.S.C. § 101.

We affirm the Examiner's decision to reject claims 33 and 34 under 35 U.S.C. § 103(a).

We reverse the Examiner's decision to reject claims 1–17 and 27–32, 35, and 36 under 35 U.S.C. § 103(a).

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

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