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EXAMINER

SHERR, MARIA CRISTI OWEN

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VICTOR S. LEE

Appeal 2017-000359¹
Application 10/997,418²
Technology Center 3600

Before HUBERT C. LORIN, NINA L. MEDLOCK, and
BRADLEY B. BAYAT, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1, 4, 5, 7–29, 31, and 40–44.³ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

¹ Our decision references Appellant’s Appeal Brief (“App. Br.,” filed February 16, 2016) and the Examiner’s Answer (“Ans.,” mailed June 17, 2016) and Final Office Action (“Final Act.,” mailed September 24, 2015).

² Appellant identifies Microsoft Technology Licensing, LLC as the real party in interest. App. Br. 3.

³ Claims 2 and 3 are withdrawn. Claims 6, 30, and 32–39 are canceled. App. Br. 5.

CLAIMED INVENTION

Appellant's claimed invention "relates generally to multimedia networks and more specifically to synchronizing contents of removable storage devices with a multimedia network" (Spec. ¶ 2).

Claims 1, 26, 40, and 42 are the independent claims on appeal.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method comprising:
 - detecting, by a server connected to a multimedia network, a change in status of a connection between a removable storage device and a client computing node of the multimedia network;
 - receiving, by the server and from the client computing node, a local inventory list of recordings contained by the removable storage device;
 - comparing the local inventory list to a network inventory list of recordings to identify a recording on the local inventory list of recordings with which to update the network inventory list of recordings, wherein the network inventory list of recordings is associated with at least one or more other client computing nodes of the multimedia network; and
 - updating, by the server and based at least in part on detecting the change in status, the network inventory list of recordings with information associated with the recording on the local inventory list of recordings identified based on the comparing.

REJECTIONS⁴

Claims 40, 41, 43, and 44 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

⁴ The Examiner has withdrawn the separate rejections of dependent claims 31, 43, and 44 under 35 U.S.C. § 112, first paragraph. (*See* Ans. 2).

Claims 1, 4, 5, 7–29, 31, and 40–44 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1, 4, 5, 7–29, 31, and 40–44 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

Claims 1, 4, 5, 7–12, 14–19, 26, 28, 29, 40, and 42–44 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kusaka et al. (US 7,382,405 B2, iss. June 3, 2008) (“Kusaka”) and Kauffman et al. (US 6,260,040 B1, iss. July 10, 2001) (“Kauffman”).

Claims 13, 20–25, 27, 31, and 41 are rejected under 35 U.S.C. § 103(a) as unpatentable over Kusaka, Kauffman, and Stefik et al. (US 5,629,980, iss. May 13, 1997).

ANALYSIS

Non-Statutory Subject Matter

Independent claim 40 recites “[o]ne or more devices storing instructions” that, when executed, perform a number of steps. And each of claims 41, 43, and 44 depends from independent claim 40.

We are not persuaded by Appellant’s argument that the Examiner erred in rejecting claims 40, 41, 43, and 44 under 35 U.S.C. § 101 (Br. 12–13). Instead, we agree with the Examiner (*see* Final Act. 5–6; Ans. 2) that the phrase “[o]ne or more devices storing instructions,” when given its broadest reasonable interpretation in light of the Specification, includes transitory signals, which are non-statutory subject matter. *See In re Nuijten*,

500 F.3d 1346, 1356–57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter); *see also Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential) (finding a machine readable storage medium non-statutory under § 101).

Appellant argues that “the broadest reasonable interpretation of the term ‘device’ does not encompass a ‘signal’” (Br. 12), and that claims 40, 41, 43, and 44 are directed to an article of manufacture and, therefore, patent-eligible under § 101 (*id.* at 10). Yet, we find nothing in the Specification, nor does Appellant direct us to anything in the Specification, that imposes any limitation on the form of the “one or more devices” or that otherwise excludes transitory media. Instead, as the Examiner observes, the Specification “is silent as to the type (hardware or software) of device” (Ans. 2 (citing paragraph 79 of the published version of Appellant’s Specification)).⁵

We are not persuaded, for the foregoing reasons, that the Examiner erred in rejecting claims 40, 41, 43, and 44 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection.

Written Description

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact and is assessed on a case-by-case basis. *See, e.g., Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). The disclosure, as originally filed, need not literally describe the claimed subject matter (i.e.,

⁵ US 2006/0112018 A1, pub. May 25, 2006.

using the same terms or *in haec verba*) in order to satisfy the written description requirement. But the Specification must convey with reasonable clarity to those skilled in the art that, as of the filing date, Appellant was in possession of the claimed invention. *See id.*

In rejecting the claims under 35 U.S.C. § 112, first paragraph, the Examiner notes that independent claim 1 recites “detecting, by a server connected to a multimedia network, a change in status of a connection between a removable storage device and a client computing node of the multimedia network” (Final Act. 7; *see also*, Ans. 3–4). However, the Examiner finds that “in the Specification the said function is not recited as being in a ‘server’ but rather in [an] ‘engine’” (*id.*). The Examiner points to paragraphs 32 and 64 of the published version of Appellant’s Specification as disclosing that “the ‘media connection monitor’ is part of the ‘local inventory engine’ which ‘resides on a set top box’” (*id.*). And, the Examiner finds that the claimed “detecting” step being performed by a “server” lacks written description support in the Specification because the Specification only describes the “detecting” step being performed by local inventory engine 114 and not by a “server.”

We understand the rejection as applying to independent claims 1 and 42 only. Notwithstanding that the Examiner applies the same analysis to independent claims 1, 26, 40, and 42, only claims 1 and 42 contain the limitation that allegedly lacks written description support. Claim 42, similar to claim 1, recites that the “detecting” step is performed “at a multimedia hub.” However, as Appellant points out (App. Br. 18), independent claims 26 and 40 do not contain a similar limitation that requires the “detecting” step to be performed by a “server” or “hub.” Accordingly, we

do not sustain the rejection of claims 26 and 40 under § 112, first paragraph, because they do not contain the allegedly problematic limitation.

Turning to the rejection of independent claims 1 and 42, we are persuaded by Appellant’s argument that the Examiner erred in rejecting claims 1 and 42 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (App. Br. 13–19). As the Examiner correctly notes (Final Act. 7), the Specification discloses that local inventory engine 114 performs the claimed “detecting” step (*see, e.g.*, ¶ Spec. 23). However, the Specification discloses that the “detecting” step may also be performed by network inventory engine 110, which resides on multimedia server 104 (*see, e.g.*, Spec. ¶ 19 (“a network inventory engine 110 . . . resides in the multimedia server 104”), ¶ 22 (“all the functions of a local inventory engine 114 may be included in a network inventory engine 110”)). As such, we agree with Appellant that a person of ordinary skill in the art would understand from the Specification, additionally including paragraph 59 and Figures 1 and 6, that Appellant was in possession of the claimed invention, including “detecting, by a server connected to a multimedia network, a change in status of a connection between a removable storage device and a client computing node of the multimedia network,” as recited in independent claim 1, at the time the application was filed (App. Br. 14–15).

Regarding the substantially similar step of “detecting, at a multimedia hub, a change in a connection between a removable storage device and a client node on a multimedia network,” recited in claim 42, we note that the Specification discloses that “[t]he term ‘server’ will be used herein to refer to . . . a multimedia network hub . . .” (Spec. ¶ 17). Therefore, we find that

Appellant's Specification provides the requisite written description support for the "detecting" limitation in claim 42 for the same reasons set forth above with respect to claim 1.

In view of the foregoing, we do not sustain the Examiner's rejection of claims 1, 4, 5, 7–29, 31, and 40–44 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Indefiniteness

In rejecting the pending claims under 35 U.S.C. § 112, second paragraph, the Examiner asserts that independent claims 1, 26, 40, and 42 recite "recite detecting, by a computing device, a change in status of a connection between a storage device and a client computing node . . . and then receiving, from the client computing node, a list of inventories contained by the removable storage device" (Final Act. 8). The Examiner determines that the claims are indefinite because "[i]t is unclear – if the recordings are on the removable device – how the computing device can receive the recordings from the client computing node" (*id.* at 8; *see also* Ans. 4).

The Examiner's indefiniteness rejection, as best understood, appears based on absence of a claim step of retrieving/sending information contained by the removable storage device to the client computing node, prior to the step of "receiving" the information (i.e., a list inventories contained by the removable storage device."). Claims 1, 26, 40, and 42 admittedly are broad in that the claims do not require any specific way of retrieving/sending information contained by the removable device. However, "breadth is not to be equated with indefiniteness." *In re Miller*, 441 F.2d 689, 693 (CCPA 1971).

Therefore, we do not sustain the Examiner's rejection of claims 1, 4, 5, 7–29, 31, and 40–44 under 35 U.S.C. § 112, second paragraph.

Obviousness

Independent claim 1 and Dependent Claims 4, 5, 7–12, and 14–19

We are persuaded by Appellant's argument that the Examiner erred in rejecting independent claim 1 under § 103(a) because Kauffman, on which the Examiner relies, does not disclose or suggest “comparing the local inventory list to the network inventory list,” as recited in claim 1 (App. Br. 25–27).

Kauffman is directed to a shared file system, including a file management system that provides version control (Kauffman col. 2, ll. 9–15) via “a checking mechanism by which only one user is allowed to ‘check out’ a file at a time” (*id.* at col. 2, ll. 17–18). After editing the file, the user checks the file back in, and that copy of the file becomes the latest version of the file (*id.* at col. 2, ll. 24–26).

Kauffman, at column 6, lines 41–65, discloses a process for checking out a file from the file management system, and describes that the check-out process begins when a “user requests a file for a write operation at his workstation, thereby invoking a digital library client application.” The library client application sends the request to a digital library server. The server's file management system determines whether the user has write permission and, if the user has write permission, checks whether the file is already checked out (i.e., to another user/workstation). If the file is not checked out, the server checks it out to the requesting user and the file is copied onto a local store of the user's workstation.

The Examiner maintains that the “comparing” step, as recited in claim 1, is met by Kauffman’s disclosure of the check-out procedure in column 6, lines 41–65 (Final Act. 10; *see also* Ans. 5). However, we agree with Appellant that Kauffman’s disclosure of “controlling write protections is not the same as comparing a ‘local inventory list’ and a ‘network inventory list,’ as claim 1 recites” (App. Br. 27).

Claim 1, on its face, requires comparing two distinct inventory lists: a local inventory list of recordings contained by the removable storage device, and a second network inventory list of recordings. The Examiner has not pointed to any comparison of two different lists in Kauffman. The Examiner has merely pointed to disclosure in Kauffman that a single file may be checked out from a file management server.

Kauffman’s disclosure of checking out a single file is insufficient to meet the claim language. Therefore, we do not sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the Examiner’s rejection of dependent claims 4, 5, 7–12, and 14–19. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

Independent Claims 26, 40, and 42 and Dependent Claims 28, 29, 43 and 44

Independent claims 26, 40, and 42 include language substantially similar to the language of claim 1, and stand rejected based on the same rationale applied with respect to claim 1 (Final Act. 9–10). Therefore, we do not sustain the Examiner’s rejection under 35 U.S.C. § 103(a) of independent claims 26, 40, and 42, and claims 28, 29, 43, and 44, which

depend therefrom, for the same reasons set forth above with respect to claim 1.

Dependent claims 13, 20–25, 27, 31, and 41

Each of dependent claims 13, 20–25, 27, 31, and 41 depends from one of independent claims 1, 26, and 40. The Examiner’s rejections of these dependent claims under 35 U.S.C. § 103(a) are based on the same rationale with respect to Kauffman applied in the rejection of independent claims 1, 26, and 40. Therefore, we do not sustain the rejections of dependent claims 13, 20–25, 27, 31, and 41 under § 103(a) for substantially the same reasons set forth above with respect to the independent claims.

DECISION

The Examiner’s rejection of claims 40, 41, 43, and 44 under 35 U.S.C. § 101 as directed to non-statutory subject matter is affirmed.

The Examiner’s rejection of claims 1, 4, 5, 7–29, 31, and 40–44 under 35 U.S.C. § 112, first paragraph, is reversed.

The Examiner’s rejection of claims 1, 4, 5, 7–29, 31, and 40–44 under 35 U.S.C. § 112, second paragraph, is reversed.

The Examiner’s rejections of claims 1, 4, 5, 7–29, 31, and 40–44 under 35 U.S.C. § 103(a) are reversed.

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-IN-PART