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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICK A. HAMINTON II, PAUL A. MOSKOWITZ, BRIAN M. O'CONNELL, and CLIFFORD A. PICKOVER

Appeal 2017-001501
Application 13/792,371
Technology Center 3600

Before: STEFAN STAICOVICI, LEE L. STEPINA, and ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Rick A. Haminton II et al. ("Appellants") appeal under 35 U.S.C. § 134(a) from a rejection of claims 1, 2, 4–15, and 17–22.[1] We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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[1] Appellants submit the real party in interest is International Business Machines Corporation. Appeal Br. 2.

CLAIMED SUBJECT MATTER

Appellants' invention relates to "utilizing digital media as a function of environmental impact data" of the digital media. Spec. ¶ 2. Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. A computer implemented method for providing digital media content with an embedded environmental impact data value, the method comprising executing on a central processing unit the steps of:
>
> determining a first environmental impact value for a first digital multimedia item that comprises a tangible machine-readable article and a digital multimedia file stored thereon as a total of an amount of energy used in creating the first digital multimedia item, an amount of energy used to physically deliver the tangible machine-readable article to a user, and an amount of energy used to recycle or dispose of the tangible machine-readable article;
>
> encoding the determined first environmental impact value; and
>
> embedding the encoded first environmental impact value within digital data stored on the first digital multimedia item for decoding by a receiver of the first digital multimedia item.

THE REJECTION[2]

Claims 1, 2, 4–15, and 17–22 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

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[2] A rejection of claims 1, 4–15, and 17–22 under 35 U.S.C. § 103(a) as unpatentable over Svensson (US 2003/0146924 A1, published Aug. 7, 2003), Evevsky (US 2009/0313060 A1, published Dec. 17, 2009), Rhoads (US 2007/0250195 A1, published Oct. 25, 2007), and Daken (US 2009/0254387 A1, published Oct. 8, 2009) is withdrawn in the Answer. Ans. 3. A rejection of claim 2 under 35 U.S.C. § 103(a) as unpatentable over Svensson, Evevsky, Rhoads, and Daken is also withdrawn in the Answer. *Id.*

DISCUSSION

The Examiner finds that the claims are ineligible for patent protection under§ 101 because they "describe the concept of recording energy usage and assessing environmental impact during creating and recycling of a multimedia item," which is an abstract idea. Final Act. 2. According to the Examiner the limitations including determining a first environmental impact value "do not add significantly more to the exception." *Id.* at 3.

Appellants argue that following USPTO guidance with respect to the two part test (the "Alice test") for determining whether a claim recites patent-eligible subject matter (*see Alice Corp. Pty, Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014)), "the 'significantly more inquiry' in the Step 2B analysis defined in the 2014 Interim Guidance provides 'an additional pathway to eligibility.'" Appeal Br. 4. According to Appellants, determining impact value is performed "via non-conventional routines that are unknown in the prior art," and that "pursuant to consideration (5) of the Step 2B analysis 'Significantly More' considerations … the claim limitations 'add a specific limitation other than what is well-understood, routine and conventional in the field.'" *Id.* at 5. Appellants, thus, assert that "consideration (5) of the Step 2B analysis establishes and supports a finding that the claimed inventions at issue are statutory subject matter under 35 USC 101." *Id.*

The Examiner responds that using generic computer components to perform the recited steps "does not constitute a meaningful limitation that would amount to significantly more than the judicial exception," because "claim 1 [only] requires [] *gathering* information about energy used during a

life cycle of a multi-media item, and *embedding* said information into the media items for *decoding* by a receiver." Ans. 6. The Examiner states that "[u]nder the 'broadest reasonable interpretation' said *determining* could be understood as simply selecting or accessing a pre-stored (pre-defined) values from a database - the Internet, or entered by an operator into the computer," and, thus, "does not constitute *significantly more*." Ans. 7.

Appellants reply that after the filing of the Appeal Brief and prior to the Examiner's Answer, the Federal Circuit provided additional guidance for determining patent eligibility under 35 U.S.C. § 101 including *Bascom Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016). Reply Br. 2.[3] Appellants assert that the claims are analogous to the claims in Bascom, because "the claims do not preempt the use of a general abstract idea (here, providing digital media content with embedded environmental impact data values), [] on the Internet or on generic computer components performing conventional activities." Reply Br. 7. Appellants point out that "the claimed steps act in concert" and thus, the "claims are not 'well-understood,' 'routine' or 'conventional' in the field of 'providing media items.'" *Id.* According to Appellants, the claims "carve out a specific implementation, utilizing and requiring the *specifically claimed* impact value as defined by the *specifically claimed combination* of limitations," and, thus, "comprise statutory subject matter under 35 USC [§] 101." Reply Br. 7–8.

We agree with Appellants that the claims, when considered as an ordered combination of steps, recite more than the abstract idea of providing digital media content with embedded environmental impact data values

[3] We note that the Examiner does not address the Federal Circuit's holding in *Bascom* in the Answer. *See* Ans. *passim*.

along with the requirement to perform it on the Internet, or to perform it on a set of generic computer components. Nor do the claims preempt all ways of providing digital media content with embedded environmental impact data values on the Internet; rather, they recite a specific, discrete implementation of the abstract idea of providing digital media content with embedded environmental impact data values.

Providing digital multimedia content on the Internet is a known concept (*see* Spec. ¶ 3) as is embedding data (*see* Spec. ¶ 22). Appellants, however, describe how their particular arrangement of elements is a technical improvement over prior art ways of providing such digital media content with specific embedded environmental impact data values. *See* Appeal Br. 7–8. Appellants note that prior environmental impact data was accessible from an "*external*" location as separate values and did not total the values in one location and embed the data in the media being used. *Id.* at 7 (citing Svensson ¶¶ 39 and 43). According to Appellants, the prior art only supplies "general teachings" of embedding data. *Id.* at 8. In contrast, the invention improves how the data is organized (total amount of energy relating to a first digital multimedia item) and presented to the user (embedded within digital data stored on the first digital multimedia item) and then decoded by a receiver of the same first digital multimedia item. *See* Reply Br. 9.

We agree with Appellants, and determine that the specific manner in which the first digital multimedia item is implemented with respect to (1) determining an environmental impact value of the multimedia item, (2) embedding data on the multimedia item, and (3) decoding by a receiver of the multimedia item "do[es] not preempt the use of the abstract idea of"

providing digital media content with embedded environmental impact data values on the Internet or on generic computer components performing conventional activities, because each of the three above-noted items need to be implemented and are presented as an "ordered combination of claim limitations that transform the abstract idea" of providing digital media content with embedded environmental impact data values "into a particular, practical application of that abstract idea." *Bascom* 827 F.3d at 1352.

Accordingly, we do not sustain the rejection under 35 U.S.C. § 101 of claims 1, 2, 4–15, and 17–22 as directed to non-statutory subject matter.

DECISION

The Examiner's decision rejecting claims 1, 2, 4–15, and 17–22 under 35 U.S.C. § 101 is reversed.

REVERSED