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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GENE S. FEIN and EDWARD MERRITT

Appeal 2017-001564
Application 11/618,014
Technology Center 3600

Before JOHNNY A. KUMAR, HUNG H. BUI, and
CARL L. SILVERMAN, *Administrative Patent Judges*.

KUMAR, *Administrative Patent Judge*.

DECISION ON APPEAL¹

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 3, 4, 6–8, 11, 14, 18, 22, 23, 25, 27–30, and 32–38, which are all of the pending claims. Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Appellants indicate the real party in interest is CUFER ASSET LTD. L.L.C. App. Br. 3.

Illustrative Claim

Illustrative claims 1 and 18 under appeal read as follows:

1. A computer implemented method, comprising:
 - establishing a connection between a particular electronic device and a server configured to provide distribution of a plurality of different media types;
 - determining, by the server, a compatibility of the particular electronic device with the different media types according to which of the different media types the particular electronic device is configured to execute;
 - identifying, by the server, media types that are compatible with the particular electronic device;
 - transmitting, by the server, one or more representations of compatible media content to the particular electronic device in response to identifying the compatible media types, wherein the one or more representations are displayed on a user interface residing on the particular electronic device to enable user selection of the compatible media content;
 - determining, by the server, an additional media type that is provided by the server for distribution, wherein the additional media type is not compatible with the particular electronic device;
 - upgrading, by the server, the particular electronic device to be compatible with the additional media type in response to determining the additional media type, wherein the upgraded particular electronic device is configured to execute the additional media type in response to being upgraded;
 - transmitting, by the server, one or more representations of additional media content associated with the additional media type to the upgraded particular electronic device, wherein the user interface is updated to display the representations of the additional media content;
 - receiving, from the upgraded particular electronic device, a user request for distribution of the additional media content to the upgraded particular electronic device; and
 - transmitting, by the server, the additional media content to the upgraded particular electronic device in response to receiving the user request.

18. A memory device having instructions stored thereon that, in response to execution by a processing device, cause the processing device to perform operations comprising:

- establishing a connection with a particular electronic device and;
- determining a compatibility of the particular electronic device with different media types according to which of the different media types the particular electronic device is configured to execute;
- identifying media types that are compatible with the particular electronic device;
- determining an additional media type from the different media types, wherein the additional media type is not compatible with the particular electronic device;
- upgrading the particular electronic device to be compatible with the additional media type in response to determining the additional media type, wherein the upgraded particular electronic device is configured to execute the additional media type in response to being upgraded;
- updating the the [sic] determined capability to include the additional media type;
- transmitting data identifying additional media content associated with the additional media type to the upgraded particular electronic device, wherein the user interface is updated to display one or more representations of the additional media content;
- receiving, from the upgraded particular electronic device, a user request for distribution of the additional media content;
- locating the additional media content from a plurality of storage modules associated with the processing device in response to receiving the user request; and
- transmitting the additional media content.

Rejections

A.

The Examiner rejects claims 1, 3, 4, 6–8, 11, 14, 18, 22, 23, 25, 27–30, and 32–38 under 35 U.S.C. § 101 because “the claimed invention is directed to non-statutory subject matter.” Final Act. 2–4.

As to this rejection, our decision as to the § 101 rejection of claim 18 is determinative as to the § 101 rejection of all the claims. Therefore, except for our ultimate decision, we do not discuss further herein the § 101 rejection of claims 1, 3, 4, 6–8, 11, 14, 22, 23, 25, 27–30, and 32–38.

B.

The Examiner rejects claims 1, 3, 4, 6–8, 11, 14, 18, 22, 23, 25, 27–30, and 32–38 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Wisser et al., (US 6,868,403 B1, issued Mar. 15, 2005) (hereinafter “Wisser”), Spencer et al., (US 2003/0014630 A1, published Jan. 16, 2003) (hereinafter “Spencer”), and Chatani (US 7,076,467 B1, issued July 11, 2006). Final Act. 5–13.

Appellants present arguments for independent claims 1, 18, and 34. App. Br. 15–16. As to this rejection, our decision as to the § 103 rejection of claim 1 is determinative as to the § 103 rejection of all the claims. Therefore, except for our ultimate decision, we do not discuss further herein the § 103 rejection of claims 3, 4, 6–8, 11, 14, 18, 22, 23, 25, 27–30, and 32–38.

Issues on Appeal

Has the Examiner erred in rejecting claim 18 as being directed to patent-ineligible subject matter?

Has the Examiner erred in rejecting claim 1 as being obvious?

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ Appeal Brief and Reply Brief arguments that the Examiner has erred.

A. Mayo/Alice Analysis under 35 U.S.C. § 101

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). The Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–84 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

The first step in that analysis is to determine whether the claims at issue are directed to one of those patent-ineligible concepts, such as an *abstract idea*. Abstract ideas may include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Id.* at 2355–57.

If the claims are *not directed* to a patent-ineligible concept, *the inquiry ends*. See *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1262 (Fed. Cir. 2017).

Otherwise, the inquiry proceeds to the second step in which the elements of the claims are considered “individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78). We consider the question of whether the claims are directed to a *specific improvement* in the capabilities of the computing devices, or, instead, “a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

B. Examiner’s § 101 Determination

Applying step 1 of the *Alice/Mayo* analysis, the Examiner determines:

the claims are directed towards upgrading an electronic device to ensure that the device is compatible with the media type facilitating a media execution by the updated device executable programs, and tracking the user requests. Further, the claims recite a method for establishing a connection between devices, determining the compatibility between the devices, identifying and transmitting compatible media content files, upgrading the device with media type executable if the media type is not compatible so the device can play the media type after the upgrading, which is similar to concepts identified as abstract ideas by the courts such as collecting and comparing known information (*Classen*), process of organizing information, storing and transmitting information (*Cyberfone*) and data recognition and storage (*Content Extraction*) and thus, the claims include an abstract idea.

Ans. 3.

B. *Appellants' § 101 Arguments*²

Appellants raise the following arguments in contending that the Examiner erred in rejecting claim 1 as being directed to patent-ineligible subject matter because:

the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.

...

For example, claim 18 recites *upgrading the particular electronic device to be compatible with the additional media type in response to determining the additional media type, wherein the upgraded particular electronic device is configured to execute the additional media type in response to being upgraded*. Independent claims 1 and 34 recite similar features. As a result of the upgrade, the functioning of the electronic device is improved so that it is able to execute the additional media type after being upgraded.

App. Br. 13–14.

C. *Panel's § 101 Analysis*

According to the Federal Circuit, the first-stage filter in the § 101 analysis — is a meaningful one, sometimes ending the § 101 inquiry. *See Visual Memory LLC*, 867 F.3d at 1262 (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)); *see also Enfish*, 822 F.3d 1327; *Thales*, 850 F.3d at 1347. “In this regard, [the panel] must articulate with specificity what the claims are directed to . . . and ‘ask

² The contentions we discuss herein are determinative as to the § 101 rejection on appeal. Therefore, we do not discuss Appellants’ other § 101 contentions herein.

whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea’.” *Id.* (citing *Enfish*, 822 F.3d at 1335) (“[S]ome improvements in computer-related technology when appropriately claimed are undoubtedly not abstract, such as a chip architecture, an LED display, and the like.”). The key question is “whether the focus of the claims is on the specific asserted improvement in computer capabilities (*i.e.*, the self-referential table for a computer database [in *Enfish*]).” *Id.* (citing *Enfish*, 822 F.3d at 1335–36).

Claim 18, and similarly claims 1 and 34, recites “*upgrading the particular electronic device to be compatible with the additional media type in response to determining the additional media type, wherein the upgraded particular electronic device is configured to execute the additional media type in response to being upgraded.*” The focus of Appellants’ claims 1, 18, and 34 is to improve the functionality of an electronic device, particularly, upgrading the electronic device to be compatible with different types of media content in the event that particular electronic device is unable to receive and process additional media type that is not compatible with the particular electronic device. Spec. 5:8–19. Based on that focus, we determine Appellants’ claims are directed to an improved computer system (*i.e.*, electronic device), and not an abstract idea of upgrading an electronic device.

In addition, although the Examiner cites to the decisions in *Classen*,³ *Cyberfone*,⁴ and *Content Extraction*,⁵ the Examiner fails to explain the relevancy of these decisions to the claimed invention. In particular, claim 18 does not recite “collecting and comparing known information,” “organizing information, storing and transmitting information,” or “data recognition and storage.” Thus, we fail to see any particular relevance as to the Examiner’s citations as the subject matter of Appellant’s claim 18 is not directed to any abstract idea of these decisions.

As such, we agree with Appellants that the claims are not directed to an abstract idea under *Alice* step 1. If the claims are *not directed* to a patent-ineligible concept, we need not address *Alice* step 2. See *Visual Memory LLC*, 867 F.3d at 1262. Accordingly, for at least these reasons, we are constrained on this record to reverse the Examiner’s rejection under 35 U.S.C. § 101 of claims 1, 3, 4, 6–8, 11, 14, 18, 22, 23, 25, 27–30, and 32–38, as being purportedly directed to patent-ineligible subject matter in light of *Alice* and its progeny.

³ *Classen Immunotherapies, Inc. v. Elan Pharms, Inc.*, 786 F.3d 892 (Fed. Cir. 2015).

⁴ *Cyberfone Systems, LLC v. CNN Interactive Group, Inc.*, 558 F. App’x 988 (Fed. Cir. 2014).

⁵ *Content Extraction and Transmission LLC v. Wells Fargo Banks, Nat. Ass’n*, 776 F.3d 1343 (Fed. Cir. 2014).

*D. Panel's § 103 Analysis*⁶

The issue is whether the Examiner erred in finding that the combination of Wisner, Spencer, and Chatani teaches the limitation of “determining, by the server, an additional media type that is provided by the server for distribution, wherein the additional media type is not compatible with the particular electronic device,” and “upgrading, by the server, the particular electronic device to be compatible with the additional media type in response to determining the additional media type” as recited in independent claim 1. Independent claims 18 and 34 recite commensurate limitations.

We turn to Appellants' Specification to ascertain the meaning of the terms “upgrading” as recited in claim 1, because the Specification is the single best guide as to the meaning of a disputed term.

The claims, of course, do not stand alone. Rather, they are part of “a fully integrated written instrument” consisting principally of a specification that concludes with the claims. For that reason, claims “must be read in view of the specification, of which they are a part.” . . . [T]he specification “is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.”

Phillips v. AWH Corp., 415 F.3d 1303, 1315 (Fed. Cir. 2005) (citations omitted).

Appellants' Specification on page 5, lines 8–23 describes:

The variety of media content available for selection via the general user interface 170 for the network may include music, ring tones, feature films, live and cached television programs, software programs and applications, radio programs and other textual, graphical, audio, video and audiovisual

⁶ The contentions we discuss are determinative as to the § 103 rejections on appeal, so we do not discuss Appellant's other § 103 contentions herein.

content. The general user interface 170 may also be custom branded for distribution, hardware or content partners. The individual electronic devices 105a-105e may run software interfaces that are programmed to work with the capabilities of the device. For instance, *if certain portable devices do not play video content, then only textual and audio content options will appear on the interface, which may be updated later via download to accommodate an upgraded device that now accepts video.* Different interfaces will also require different download options via a menu selection to download the right interface for the right device. Specific interfaces may suit the screen size, functionality, technical and billing demands of the device, network partners and software and content partners. The interface and content download system is also be configured for specific device requirements utilizing the specifications made available by the device API's and compatible software formats such as Pocket PC and Symbian among many others.

(Emphasis added).

Appellants raise the following argument in contending that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a).

Even assuming, arguendo, that the Examiner's characterization of Spencer is proper in alleging that the particular type of programming language used might facilitate forwards and backwards compatibility, Appellant respectfully submits that this would not render obvious the features recited by claim 1, namely *determining, by the server, an additional media type that is provided by the server for distribution, wherein the additional media type is not compatible with the particular electronic device, and upgrading, by the server, the particular electronic device to be compatible with the additional media type in response to determining the additional media type.* Rather, as discussed above, Spencer describes that the devices would simply issue an error message when faced with incompatible media content, rather than be upgraded.

Reply Br. 5–6.

Here, the Examiner relies upon Spencer to teach or suggest the argued limitation. *See* Ans. 5–6. Therefore, our discussion will be limited thereto. Specifically, Spencer relates to downloading of audio files through a computer network. *See* Spencer ¶ 1. However, the Examiner has not shown that Spencer teaches *upgrading an electronic device* if that particular electronic device is not capable of processing video content that is not compatible. In addition, the Examiner has not shown that Wisner and Chatani make up for the deficiencies of Spencer.

Since we agree with at least one of the arguments advanced by Appellants, we need not reach the merits of Appellants’ other arguments.

We are therefore constrained by the record before us to find that the Examiner erred in rejecting independent claims 1, 18, and 34 and dependent claims 3, 4, 6–8, 11, 14, 22, 23, 25, 27–30, and 32–33, and 35–38 for similar reasons.

CONCLUSIONS

(1) Appellants have established that the Examiner erred in rejecting claims 1, 3, 4, 6–8, 11, 14, 18, 22, 23, 25, 27–30, and 32–38 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

(2) Appellants have established that the Examiner erred in rejecting claims 1, 3, 4, 6–8, 11, 14, 18, 22, 23, 25, 27–30, and 32–38 as being unpatentable under 35 U.S.C. § 103(a).

(3) Claims 1, 3, 4, 6–8, 11, 14, 18, 22, 23, 25, 27–30, and 32–38 have not been shown to be unpatentable.

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DECISION

The Examiner's rejection of claims 1, 3, 4, 6–8, 11, 14, 18, 22, 23, 25, 27–30, and 32–38 under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter is **reversed**.

The Examiner's rejection of claims 1, 3, 4, 6–8, 11, 14, 18, 22, 23, 25, 27–30, and 32–38 as being unpatentable under 35 U.S.C. § 103(a) is **reversed**.

REVERSED