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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AUGUSTIN J. FARRUGIA and
GIANPAOLO FASOLI

Appeal 2017-002549
Application 11/382,469
Technology Center 3600

Before JOSEPH L. DIXON, LINZY T. McCARTNEY, and
SCOTT E. BAIN, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants¹ appeal under 35 U.S.C. § 134(a) from a rejection of claims 91, 92, and 101–131. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

The claims are directed to digital rights management (DRM) systems that require a user to pay a periodic subscription fee and “in order to protect the content providers['] rights. The DRM process has to be able to determine the validity of [the] subscription when a user wants to use the content” and “there is, therefore a need in the art to determine whether a user’s subscription is still valid without solely relying on the user device clock, especially in environments where the user is not always connected to a DRM enforcing device.” (Spec. 2).

Independent claim 91, reproduced below, is illustrative of the claimed subject matter:

91. A digital rights management (DRM) method for determining whether a device has been manipulated, the method comprising:

at a first instance in time, receiving a first request to access a piece of content protected by a time-limited subscription on the device;

comparing a first set of attributes of a plurality of entities of the device from the first instance in time with a stored second set of attributes of the plurality of entities of the device from a second instance in time in order to identify differences between the second and first sets of attributes, the second instance in time earlier than the first instance in time;

¹ Appellants indicated that Apple Inc. is the real party in interest. (App. Br. 2)

determining whether the identified differences between the second and first sets of attributes are expected in accordance with a difference between a device clock value at the second instance in time and a device clock value at the first instance in time;

only granting access to the piece of content in response to the first request when the identified differences between the second and first sets of attributes are expected;

at a third instance in time later than the first instance in time, receiving a second request to access the piece of content;

comparing a third set of attributes of the plurality of entities of the device from the third instance in time with the first set of attributes from the first instance in time in order to identify differences between the first and third sets of attributes;

determining whether the identified differences between the first and third sets of attributes are expected in accordance with a difference between the device clock value at the first instance in time and a device clock value at the third instance in time; and

only granting access to the piece of content in response to the second request when the identified differences between the first and third sets of attributes are expected,

wherein each of the receiving, comparing, determining, and granting are performed by the device.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Ginter (hereinafter "Ginter")	US 5,892,900	Apr. 6, 1999
Zhuk (hereinafter "Zhuk")	US 7,594,271 B2	Sept. 22, 2009

REJECTIONS

The Examiner made the following rejections:

Claims 91, 92 and 101–131 stand rejected under 35 U.S.C. § 101, as being directed to non-statutory subject matter. (Final Act. 10).

Claims 91, 92 and 101–109 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. (Final Act. 14).

Claims 91, 92 and 101–131 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. (Final Act. 17).

Claims 91, 92 and 101–131 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginter in view of Zhuk. (Final Act. 19–25).

ANALYSIS

35 U.S.C. § 101 Rejection

With respect to claims 91, 92, and 101-131, Appellants rely on the same arguments for patentability for each of the independent claims and do not set forth separate arguments for patentability. (App. Br. 13–21). Therefore, we select independent claim 91 as the representative claim for the group and will address Appellants' arguments thereto. In addition, when Appellants do not separately argue the patentability of the dependent claims, the claims stand the fall with the claim from which they depend. *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986), *see also* 37 C.F.R. § 41.37(c)(1) (iv).

Appellants contend claim 91 is not directed to the abstract idea of granting access to content based on analysis of illicit activities, but rather, is directed to a novel and unobvious method of determining whether a device has been manipulated. Appellants argue the claims do not describe an abstract concept similar to those found by the courts to be abstract ideas because the Examiner has not clearly identified what type of abstract concept the claim describes. (App. Br. 13). Appellants further contend the claimed solution is inextricably tied to computer technology to overcome a problem specifically arising in the realm of device manipulation and that the device is not incidental to the claim, but is instead key to both the problem and solution. (App. Br. 13-14). Appellants argue the claimed invention provides a solution to a problem that specifically arises in electronic devices, “*namely how to grant access to content on a device while ensuring that the device has not been manipulated.*” (App. Br. 14) (emphasis added). Appellants also argue the claim elements either taken individually, and/or in combination, amount to significantly more than the abstract idea of fundamental practices of granting access to content based on analysis of illicit activities because it is improving the technology of DRM. (App. Br. 15).

Appellants present the same line of argument in the Reply Brief regarding claim 91 being more specific than an abstract idea and that the claims improve computer technology. (Reply Br. 2–3). Appellants contend that “the Federal Circuit in *Enfish* stated that certain claims directed to improvements in computer-related technology, including claims directed to software, are not necessarily abstract (*Enfish v. Microsoft Corp*, 2015-1244 (*Fed Cir*, May 12, 2016))” and that as in *Enfish*, the claimed invention

specifically assert[] improvement in computer capabilities. Specifically, the current invention achieves other benefits over conventional methods of granting access to content. That is the claims specifically describe key elements to achieve the desired improvements in computer-related technology and are not directed to generalized steps to be performed on a computer simply using conventional computer activity.

(Reply Br. 3).

We are unpersuaded by Appellants' arguments that the claim 91 complies with 35 U.S.C. § 101, as patent eligible subject matter. (App. Br. 13–21; Reply Br. 2–4)

The Examiner found that claim 91, when considered as a whole, did not amount to significantly more than an abstract idea and is directed to the idea of fundamental practices of granting access to content based on analysis of illicit activity. (Final Act. 10–11). Further, the Examiner found the additional elements of claim 91 amount to no more than reciting instructions to implement the idea on a computer and recite generic computer structures that are well-understood, routine, and conventional and the additional elements do not transform the idea into a patent eligible application. (Final Act. 11).

Moreover, in the Examiner's Answer, the Examiner maintained that "determining whether a device has been manipulated based on expected differences between attributed and entities within the device according to a system clock of the device" is an abstract idea similar to comparing new and stored information and using rules to identify options similar to claimed concepts of computing an alarm limit[] or calculating the difference between local and average data values previously identified by the courts, thus the

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Examiner maintained the concept in the claim is not meaningfully different than those concepts found by the courts to be abstract ideas. (Ans. 3–4).

The Examiner also maintained the claims are not directed to an improvement tied to computer technology to overcome a problem in the art because “the focus of the claim is not on an improvement in [the] computer as tools but on certain independently abstract ideas that use computers as tools (see *Electric Power Group, v Alston S.A. (Fed Cir, 2015-1778, 8/1/2016)*” (Ans. 4). We agree with the Examiner.

A patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has consistently held that this provision contains an important implicit exception: laws of nature, natural phenomena, and abstract ideas are not patentable. See *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work.”). Notwithstanding that a law of nature or an abstract idea, by itself, is not patentable, an application of these concepts may be deserving of patent protection. See *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71-72 (2012). In *Mayo*, the Court stated that “to transform an unpatentable law of nature into a patent-eligible *application* of such a law, one must do more than simply state the law of nature while adding the words ‘apply it.’” *Mayo*, 566 at 72 (citation omitted).

In *Alice*, the Court reaffirmed the framework set forth previously in *Mayo* “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 the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are directed to a patent-ineligible concept, then the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 566 U.S. at 78, 79).

In other words, the second step is to “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 on the [ineligible concept] itself.’” *Id.* (brackets in original) (quoting *Mayo*, 566 U.S. at 72-73). “A claim that recites an abstract idea must include ‘additional features’ to ensure the claim is more than a drafting effort designed to monopolize the [abstract idea].” *Id.* at 2357 (brackets in original)(quoting *Mayo*, 566 U.S. at 77-78).

The prohibition against patenting an abstract idea “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment or adding insignificant post solution activity.” *Bilski v. Kappos*, 561 U.S. 593, 610-11 (2010) (citation and internal quotation marks omitted). The Court in *Alice* noted that “[s]imply appending conventional steps, specified at a high level of generality,” was not “*enough*” [in *Mayo*] to supply an “‘inventive concept.’” *Alice*, 134 S. Ct. at 2357 (quoting *Mayo*, 132 S. Ct. at 1300, 1297, 1294).

Under the *Mayo* framework, and considering each of the steps in claim 91, we agree with the Examiner’s conclusion that claim 91 is directed to an abstract idea - the idea of comparing new and stored information using

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rules and/or mathematical correlation in granting access. (Final Act. 4). Each of the steps of claim 91 appear similar or analogous to claims found in other cases that our reviewing court has found to be directed to abstract ideas such that each of the determining and comparing steps broadly recite determining a difference in values is expected and comparing values to determine differences and granting access to data when the expected values match. *See Smartflash LLC v. Apple Inc.*, No. 2016–1059, 2017 WL 786431, at 4 (Fed. Cir. Mar. 1, 2017) (“directed to the abstract idea of conditioning and controlling access to data based on payment”) *In re Grams*, 888 F.2d 835 (Fed. Cir. 1989) (“an attempt to patent a mathematical algorithm rather than a process for producing a product”) and *FairWarning IP, LLC v. Iatric Systems*, 839 F.3d 1089 (Fed. Cir. 2016) (“directed to a patent-ineligible idea: “the concept of analyzing records of human activity to detect suspicious behavior”).

We are also not persuaded by Appellants’ argument that the claims recite an improvement in computer technology of “*how to grant access to content on a device while ensuring that the device has not been manipulated*”, and that “*the claimed solution is inextricably tied to computer technology to overcome a problem specifically arising in the realm of device manipulation.*” (App. Br. 13–14)(emphasis added).

Appellants have not identified any disclosure in the specification, or other persuasive evidence, of a technical advance in *the claimed device*. While claim 91 refers to performance of the steps by a device, no step (or collection of steps) in the claimed method encompass the improvement of ensuring a device has not been manipulated. Furthermore, Appellants have not identified any disclosure or technical reasoning as to how the

“determined difference between attributes of entities within the device” improves computer technology as in claim 91.

Rather, we find claim 91 is directed to a result or effect that itself is the abstract idea which merely invokes generic process or machinery and does not “focus on a specific means or method that improves the relevant technology,” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d at 1314 (Fed. Cir. 2016). Moreover, generically recited computers do not transform the “idea” into eligible subject matter (*See, e.g. Alice*, 134 S. ct. at 2360 (explaining that the claim limitations that “amount to nothing significantly more than an instruction to apply the abstract idea... using some unspecified, generic computer” “is not enough” to transform an abstract idea into a patent-eligible invention” (quoting *Mayo*, 566 U.S. at 77, 79)); *Intellectual Ventures*, 850 F.3d at 1342 (“The claim language here provides only a result oriented solution, with insufficient detail for how a computer accomplished it”).

Accordingly, for the reasons discussed above, we sustain the Examiner’s patent eligibility rejection of claim 91 under § 101. The Examiner and Appellants to argue claim 91 as representative of the group of claims 91, 92, and 101–131. Appellants do not set forth separate or additional arguments for patentability of claims 92, and 101–131 Therefore, we group claims 92, and 101–131 as falling with representative independent claim 91 for the same reasons above, and we sustain the rejection of independent claims 110 and 121 and dependent claims 92, 101–109, 111–120 and 122–131.

35 U.S.C. § 112, first paragraph Rejection

To satisfy the written description requirement, “the applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the claimed invention,” *Moba, B. V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319 (Fed. Cir. 2003), and “it is the specification itself that must demonstrate possession.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010). Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact. *Regents of Univ. of Cal. v. Eli Lilly and Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997) citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). The Examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. *In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976).

The Examiner finds that the original Specification does not provide support for the limitations of the claim 91 of “*comparing at a first instance of time a first set of attribute with a stored second set of attributes associated with a second instance in time and granting access to a piece of content based on the comparison*” and, “*a third instance of time, a third set of attributes with the first set of attributes associated with the first instance of time and granting access to the piece of content based on the second comparison*” (Final Act. 14–15). In the Examiner’s Answer, the Examiner finds the Appellants’ cited portions of the Specification broadly refer to a life cycle analysis and that the Specification does not disclose a “first request and second request [where the] second [] involves analysis specific to the

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comparing attributes from the time when the second request was received and attributes from the time when the first request was received.” (Ans. 8).

Appellants argue the original Specification describes using “a natural evolution test” as being performed to take snapshots of system attributes periodically based on events. The test compares the current snapshot attributes with the previous snapshot attributes to determine whether changes are acceptable. (App. Br. 22; Spec. 11–13, 19).

We find Appellants’ cited portions of the Specification provide evidence that describe the claim invention in sufficient detail that one skilled in the art would reasonably conclude that the inventors had possession of the claimed invention. Specifically, the original Specification refers to comparing the current snapshot of a population attributes with a previous snapshot, as illustrated in Figure 5. (Spec. 12, 19). We further find within Figure 5, the text on the bottom of either snapshot reflects the snapshot of files and directories having date and time values, as indicated by the user device clock. Furthermore the date accessed values are shown as changed at 5:48 pm. The total number of objects in the folder has increased from 99 to 120, the total size of the file has changed as well as other dates in the snapshot, when visually compared.

As the original Specification states, “Some embodiments perform several tests during the evolution test. Some embodiments perform individual as well as global tests.” To which the Specification further elaborates on:

An example of a global test was described above in reference with snapshots 535 and 540 in **Figure 5**. Several global tests can be performed on different groups of entities in a population. If any (or a certain number) of these tests fail, the evolution test as a whole would fail. Some embodiments perform a global

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evolution test for a set of entities by comparing a weighted computation (e.g., a weighted sum) of the changes in a set of attributes of the set of entities with a threshold to determine whether the set of entities passes the global evolution test.

(Spec. 22).

On this record, Appellants' argument is persuasive that claim 91 is fully supported by the Specification. Specifically, in the supporting sections, the claim limitation of "*comparing at a later time, a third instance of time, a third set of attributes with the first set of attributes associated with the first instance of time and granting access to the piece of content based on the second comparison*" are shown in the elements of Figure 5 cited by Appellants in the Appeal Brief. (App. Br. 21–23). Appellants' cited evidence demonstrates Appellants were in possession of the claimed invention at the time of filing. Thus, we do not sustain the Examiner's 35 U.S.C. § 112, first paragraph, rejection for lack of written description of claim 91.

As to claims 101 and 102, the Examiner finds the original Specification does not provide written description support for the claimed limitations of "wherein the device only performs the comparison and determination after attempting to validate the time-limited subscription by connecting to a DRM server through a network" and "when the identified differences are not expected, requiring the device to connect to a DRM server and validate that the time limited subscriptions has not expired before granting access to the piece of content." (Final Act. 15–16).

Appellants argue the original Specification states "[a]s long as the user is online, the DRM server can check the validity of the subscription by comparing ... with the time and/or data obtained from a trusted source" and

“[i]f the evolution test determines (at step 320)... to go online and synch up the subscription with the DRM server set” then the device would only use the alternate life cycle test when the device is offline and the evolution test result would yield a determination that the device was perhaps manipulated. (App. Br. 45–46; Spec. 12, Figure 3).

We agree with Appellants that Appellants’ cited evidence, in the Specification and drawings, demonstrates Appellants were in possession of the claimed invention. Thus, we do not sustain the Examiners 35 U.S.C. § 112, first paragraph, rejection for lack of written description of dependent claims 101 and 102.²

As to claims 92 and 103–109 the Examiner finds the claims are rejected similarly as claim 91, that the claims lack support in the written description (Final Act. 16). By virtue of dependency from selected claim 91³, we do not sustain for the same reasons presented herein the written description rejection of claims 92 and 103–109.

35 U.S.C § 112, second paragraph Rejection

The test for definiteness under 35 U.S.C. § 112, second paragraph is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). Language in a

² The Examiner also finds claims 112, 113, 123, and 124, also lack support in the written description. However, these claims 112, 113, 123, and 124 do not appear in the heading of the rejection, nor are the specifics of the additional limitations addressed within the final rejection. (Final Act. 15–16). We do not sustain this rejection for the same reason as claims 101 and 102.

³ 37 C.F.R. § 41.37(c)(1)(iv).

claim is unclear if, when given its broadest reasonable interpretation, it is ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention ... ,” *In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014), or if it is “is amenable to two or more plausible claim constructions ... ,” *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential).

The Examiner maintains claims 91, 92, and 101–131 are indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention, for the following limitations:

Per claim 91, the term “the identified differences between the second and first set of attributes” lack antecedent basis as there is no positively recited step of “identifying differences between the second and first set of attributes. Similar rationale applies to “the identified differences between the first and third set of attributes.”

...

Similarly, per claims 110 and 121, the claims recite “whether the identified differences between the first and second sets of attributes are expected” and “when the identified differences between the first and second sets of attributes are expected”. The terms “the identified differences between the second and first set of attributes” lack antecedent basis as there is no positively recited step of “identifying difference between the second and first set of attributes.

As per claims 92, 111, and 122, the scope of the claim is unclear. Specifically, the claims are directed to further limiting “expected differences.” The parent claim(s), however, is silent on expected differences.

As per claims 102, 106, 113, 117, 124, and 128, the term “the identified differences” lack antecedent basis. Furthermore, it is unclear which one of the differences refers to identified differences.

As per claims 107, 108, 118, 119, 129, and 130, it is unclear what the claim is attempting to further limit as there is no recitation of “manipulation” in the parent claims.

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(Final, 16-18).

Additionally, the Examiner finds “the claim merely suggests intended result/use of the comparison” and “the claim does not illuminate whether the identification of difference is performed by the device.” (Ans. 11).

Appellant argues that the limitation of “*identified differences between the second and first sets of attributes*” is clearly supported in line 3 of the second limitation of the claim. (App. Br. 24–25). Further, Appellants argue, the term “the identified differences between the first and third sets of attributes is also clearly supported in lines 2-3 of the sixth limitation.” (App. Br. 25). We agree with Appellants, as the recited “identified differences” in line 3 of the second limitation of claim 91, refers to a positively recited step and “gives antecedent support to the phrase.” (App. Br. 24, 26). Thus, we agree with Appellants and do not sustain the Examiner’s 35 U.S.C. § 112, second paragraph rejection over claim 91.

As to claims 92, 111, and 122, the Examiner finds the scope of the claims is “unclear” because the term “expected difference” in the dependent claims is not introduced in the parent claims and lacks antecedent basis. (Ans. 12).

Appellants contend the independent claim, to which the claims depend, indicate the notion of expected differences and the claims were amended to include “wherein expected differences are based on... .” Thus, Appellants contend no specific antecedent basis is required. (App. Br. 47). We disagree with the Appellants, and are not persuaded by Appellants’ response.

We agree with the Examiner that it is not clear from the claim language, as to which “expected difference” from independent claim 91 that the limitation depends. The claims do not elucidate which, difference (e.g.

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either between the second and first set or the difference between the third and first “identified differences”), is expected. Thus, the rejection of these claims is sustained.

As to dependent claims 102, 106, 113, 117, 124 and 128, Appellants contend that they have already provided support for the “identified differences” in the claims, and provide no further argument. (App. Br. 47).

The Examiner maintains the same basis for the dependent claims, as provided in the independent claims. (Final Act. 12). Therefore, we do not sustain the rejection as to claims 102, 106, 113, 117, 124 and 128 for the same reasons presented above for base claim 91.

As to claims 107, 108, 118, 119, 129, and 130, Appellants contend the term “manipulated” is defined in the parent claim to which the claim depends and further that “manipulation” is the noun form of the verb “manipulate.” (App. Br. 47–48).

The Examiner finds the limitation “wherein manipulation of the device comprises setting a device clock back” lacks specific grammatical article and that it is unclear that “manipulation” refers back to “manipulated” in at least claim 91. (Ans. 13). We agree with Appellants’ argument that the term “manipulation” is supported by the term manipulated in the parent claim. Further, we find the term “manipulation” does not appear ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed function *In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014). Finally, we find the Examiner has not explained why the claim language, when read in light of the Specification, would be unclear to one of ordinary skill in the art. Thus, we do not sustain the rejection of claims 107, 108, 118, 119, 129, and 130.

35 U.S.C. § 103

With respect to claims 91, 92, and 101–131, Appellants rely on the same arguments for patentability for each of the independent claims and do not set forth separate arguments for patentability. (App. Br. 31–45.) Therefore, we select independent claim 91 as the representative claim and address Appellants’ arguments thereto. 37 C.F.R. § 41.37(c)(1)(iv).

With respect to representative independent claim 91, Appellants contend:

First, Ginter and Zhuk do not disclose or suggest a method that compares a first set of attributes of several entities of a device from a first instance in time with a stored second set of attributes of several entities of the device from a second instance in time in order to identify differences between the second and first sets of attributes, determines whether the identified differences are expected in accordance with a difference between a device clock value at the second instance in time and a device clock value at the first instance in time, and only grants access to the piece of content when the identified differences are expected. *Second*, the cited references do not disclose or suggest a method that compares a first set of attributes from the first instance in time with a stored second set of attributes from a second instance in time and compares a third set of attributes from a third instance in time, later than the first instance in time, with the first set of attributes from the first instance in time. *Third*, the Office Action fails to provide a sufficient reason why it would have been obvious to one of ordinary skill in the art to combine the elements of Ginter and Zhuk to arrive at the claimed invention.

(App. Br. 31–32).

The Examiner finds that Ginter discloses “comparing a first set of attributes of a plurality of entities of the device at a first instance in time with a second set of a plurality of attributes of the set of entities of the device at a second instance in time wherein the attributes are values associated with the plurality of entities of the device, wherein comparing comprises comparing the values” by calculating difference values of: fingerprint (e.g. digital signatures), discrepancies of clocks, expected tampering control signals after appropriate number of clocks and obtaining trend information that suggest differences in two instances of time.

(Ans. 14).

The Examiner concludes that these calculations of differences of Ginter are used,

in order to identify difference between the second and the first sets of attributes, the second instance in time earlier than the first instance in time (the expression ‘in order to identify ... ’ represents intended use/result while the description of second instance in time represents nonfunctional descriptive material) wherein the attributes comprise at least one of size, creation date, last modification date, last access date, absence, and presence of files and directories of the device.

(Ans. 14–15) (citations omitted).

Appellants contend that “[o]f the sections cited in the Office Action, on pages 9-10, only a small subset even relate to comparisons of any kind, and none deal with comparing a first set of attributes with an earlier second set of attributes for identifying differences between the two sets.” (App. Br. 33, Reply Br. 5).

We are persuaded by Appellants’ argument that Ginter does not teach or suggest the limitation in claim 91 of “comparing a first set of attributes at a first instance in time and a second set of attributes, at an earlier second

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instance in time, in order to identify differences between the second and first attributes.” (*Id.*)

We additionally agree with Appellants’ argument that Zhuk does not provide a discussion in the cited portions “regarding determining differences between the second and the first set of attributes.” and “Zhuk does not actually describe a device clock nor determining differences between device clock values.” (App. Br. 34). Moreover, we agree that the Examiner does not set forth a persuasive motivation to combine the references and that the Examiner concludes that the combination would provide “a predictable result to one of ordinary skill would be to apply known technique, as taught by Zhuk to apply known secure methodology of tampering detection.” We also agree the Examiner has not provided an “articulated reasoning with some rationale underpinning” to explain why the specific elements of the specific references in this case would be obvious to combine, as required by *KSR*. (App. Br. 36).

Further, the Examiner asserts for the sake of *arguendo* that another U.S. Patent Publication 2003/0145083 (hereinafter *Cush*), discloses “comparing attributes... to identify differences,” as recited in claim 91. (Final Act. 24). The Examiner finds that in combination of *Ginter* and *Zhuk* with the teachings of *Cush* “would have been obvious to one of ordinary skill in the art of data security to substitute one known element for another for technique identification of trend/change in a computer.” (Final Act. 24). The Examiner however must positively recite the reference in the heading of the rejection if relied upon to support the rejection. *In re Hoch*, 428 F.2d 1341, n.3 (CCPA 1970). Because the Examiner has not done so here, we do not sustain the rejection of claims 91, 92, 102–111, 113–122 and 124–131.

As to claims 101, 112 and 123, the Examiner finds “Ginter discloses attempting to validate the time-limited subscription by connecting to a DRM server.” However, the Examiner finds Ginter does not disclose the timing aspect of such attempt, as recited in claim 91 and Ginter only performs tampering determinations. (Ans. 24). The Examiner further finds the “timing difference of performing the tampering determination is an obvious design choice. It would have been obvious to try any one of finite timing options, each of which had a reasonable expectation of success.” (Ans. 24).

Appellants contend the cited portions of Ginter used in rejecting claims 101, 112 and 123, are not related to tampering determinations. (App. Br. 49). Moreover, Appellant contends Ginter doesn’t even disclose a “relation between attempting to validate a time-limited subscription by connecting to a DRM server and performing comparisons” (App. Br. 49), thus the cited portions of Ginter used in the rejection “is not one of a design choice re-timing.”

We agree with Appellants’ argument that the cited portions do not mention the claimed limitation of re-timing, no such feature was listed in the cited portions. Moreover, the rejection does not include the requisite findings to support the Examiner assertion that it would have been obvious to try “any one of finite timing option...” under *KSR*. Thus, we do not sustain the rejection of claims 101, 112 and 123.

As discussed herein, Appellants’ arguments show error in the Examiner’s findings of fact and conclusion of obviousness that the combination of Ginter and Zhuk teaches or suggests the disputed limitations of claim 91. Specifically, Appellants are persuasive in arguing that only

small portions of cited sections of Ginter deal with comparisons of any kind and none deal with the claimed limitations. (App. Br. 33, Reply Br. 5).

Additionally, and for the same reasons, Appellants have also shown error in the Examiner's factual findings or conclusion obviousness that the combination of Ginter and Zhuk teaches or suggests the disputed limitations of independent claims 110 and 121. Further, Appellants' arguments have shown the Examiner's factual findings of the cited portion of Ginter for claims 101, 112 and 123 also do not provide support for the conclusion of obviousness, and we do not sustain the rejections thereof.

DECISION

For the above reasons, we sustain the Examiner's decision rejecting of claims 91, 92, and 101–131 under 35 U.S.C. § 101; we reverse the Examiner's decision rejecting claims 91, 92, and 101–109 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; we reverse the Examiner's decision rejecting claims 91 and 101–110, 112–121, 123–131 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention; we sustain the Examiner's decision rejecting claims 92, 111, and 122 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention; and we reverse the Examiner's decision rejecting claims 91, 92 and 101–131 based on obviousness under 35 U.S.C. § 103.

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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