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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* CHRISTOPHER J. ROURK

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Appeal 2017-003576<sup>1</sup>  
Application 13/043,373<sup>2</sup>  
Technology Center 3600

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Before BIBHU R. MOHANTY, NINA L. MEDLOCK, and  
ROBERT J. SILVERMAN, *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 21–23 and 40–56. We have jurisdiction under 35 U.S.C. § 6(b). An oral hearing in this appeal was held on March 13, 2019.

We AFFIRM.

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<sup>1</sup> Our decision references Appellant’s Appeal Brief (“App. Br.,” filed January 13, 2016) and Reply Brief (“Reply Br.,” filed December 20, 2016), and the Examiner’s Answer (“Ans.,” mailed October 20, 2016) and Final Office Action (“Final Act.,” mailed July 14, 2015). The record includes a transcript of the March 13, 2019 oral hearing.

<sup>2</sup> Appellant identifies the inventor, Christopher John Rourk, as the real party in interest. App. Br. 4.

CLAIMED INVENTION

Appellant's invention "relates to an audiovisual programming selection system and method of use that allows a user to select between receiving the content free with commercials or paying for the content to receive it commercial-free" (Spec. ¶ 2).

Claims 21 and 40, reproduced below, are the independent claims on appeal and representative of the claimed subject matter:

21. A method performed by a content service for generating revenue from supplied content without establishing contracts with, or receiving payments from, a plurality of consumers, the content service linking one or more content providers to one or more network operators that use the content service to supply content to the consumers via one or more respective networks, the method comprising:

using at least one computer to perform the steps of:

[(a)] licensing the content from the one or more content providers;

[(b)] allowing the consumers to select content available from the one or more content providers;

[(c)] directly supplying the selected content to the consumers via the one or more respective networks of the one or more network operators without the content service or the one or more content providers charging the consumers;

[(d)] charging the one or more network operators for the content supplied to the consumers through the one or more respective networks; and

[(e)] forwarding a portion of payments received from the one or more network operators for the supplied content to the content provider that licensed the supplied content to the content service.

40. A method for providing content comprising:  
controlling delivery of content from two or more content providers using a processor;  
generating content suggestions for a user at a content management system operating on a processor as a function of a viewing history of the user and a plurality of viewing histories of other users;  
receiving a user selection from a user device to select content available from the two or more content providers at the processor;  
directly supplying the selected content to the user device via one or more networks without charging the user;  
generating compensation data for the selected content provider for the content supplied to the user device based on a charge structure selected by the content provider; and  
generating payment data at a revenue tracking system operating on a server as a function of the compensation data.

#### REJECTIONS

Claims 21–23 and 40–56 are rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter.

Claims 21–23 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 21, 22, and 40–56 are rejected under 35 U.S.C. § 103(a) as unpatentable over Stefik et al. (US 5,634,012, iss. May 27, 1997) (“Stefik”) and Cannon et al. (US 2002/0016736 A1, pub. Feb. 7, 2002) (“Cannon”).

Claim 23 is rejected under 35 U.S.C. § 103(a) as unpatentable over Stefik, Cannon, and Knepper et al. (US 2001/0042249 A1, pub. Nov. 15, 2001) (“Knepper”).

## ANALYSIS

### *Patent-Ineligible Subject Matter*

Appellant argues the pending claims as a group (App. Br. 11–18). We select independent claim 21 as representative. The remaining claims stand or fall with claim 21. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

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 (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 Corp.*, 573 U.S. at 217. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “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 79, 78).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. Therefore, the Federal Circuit has

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instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner determined that the claims are directed to “the abstract idea of allowing consumers to choose content” (Final Act. 5–6), and that the additional elements or combination of elements, other than the abstract idea per se, amounts to no more than “providing consumers with the content they have chosen and charging the consumers for the provided content” (*id.*). The Examiner further determined that “[v]iewed as a whole, these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such that the claim(s) amount to significantly more than the abstract idea itself” (*id.*).

Focusing on step one of the *Mayo/Alice* framework, we are not persuaded that the Examiner erred in determining that claim 21 is directed to an abstract idea. The Federal Circuit has explained that “the ‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the [S]pecification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp.*, 790 F.3d at 1346). It asks whether the focus of the claims is on a specific improvement in relevant technology or on a process that itself qualifies as an “abstract idea” for which computers are invoked merely as a tool. *See id.* at 1335–36. Here, the Specification, including the claim language, make clear that the claims

focus on an abstract idea, and not on any improvement to computer technology and/or functionality.

The Specification is entitled “AUDIOVISUAL PROGRAMMING SELECTION SYSTEM AND METHOD OF USE,” and discloses that the present invention “pertains to the field of audiovisual programming selection systems.” (Spec. ¶ 2). The Specification, thus, describes that the present invention allows users to select audiovisual programs for viewing based on content, “how well the programs have been enjoyed by others, the cost or incentives for the program, or other suitable criteria” (*id.* ¶ 9).

Understood in light of the Specification, claim 21 is directed to a method for generating revenue from supplied content comprising:

- (1) licensing content from a content provider, i.e., “licensing the content from the one or more content providers” (step (a));
- (2) supplying selected content to consumers via one or more networks, i.e., “allowing the consumers to select content available from the one or more content providers” and “directly supplying the selected content to the consumers via the one or more respective networks of the one or more network operators” (steps (b) and (c));
- (3) charging the network operators for the supplied content, i.e., “charging the one or more network operators for the content supplied to the consumers through the one or more respective networks” (step (d));
- and (4) forwarding a portion of the payments received from the network operators to the content provider, i.e., “forwarding a portion of payments received from the one or more network operators for the supplied content to the content provider that licensed the supplied content to the content service” (step (e)).

Simply put, claim 21 is directed to supplying licensed content of choice to consumers via a computer network, and compensating the content provider with a portion of the proceeds received

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from the network operator who supplied the content. In other words, claim 21 is directed to a commercial interaction, which is a method of organizing human activity and, therefore, an abstract idea, *see* 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50, 52 (Jan. 7, 2019) (“Revised Guidance”), substantially similar to other concepts that the courts have held abstract. *See, e.g., buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1353–54 (Fed. Cir. 2014) (creating contractual relationships); *Smartflash LLC v. Apple Inc.*, 680 F. App’x 977, 982 (Fed. Cir. 2017) (claims directed to the abstract idea of “conditioning and controlling access to data based on payment”).

We find no indication in the Specification, nor does Appellant direct us to any indication, that the operations recited in claim 21 invoke any assertedly inventive programming, require any specialized computer hardware or other inventive computer components, i.e., a particular machine, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) (“[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible.”).

We also find no indication in the Specification that the claimed invention effects a transformation or reduction of a particular article to a different state or thing. Nor do we find anything of record, short of attorney argument, that attributes an improvement in computer technology and/or functionality to the claimed invention or that otherwise indicates that the

claimed invention integrates the abstract idea into a “practical application,” as that phrase is used in the Revised Guidance.<sup>3</sup>

Appellant argues that the rejection under § 101 cannot be sustained because the Examiner has provided no evidence to support the rejection; therefore, according to Appellant, the Examiner has failed to establish a prima facie case of patent-ineligibility (App. Br. 11). Appellant notes that the Supreme Court, in *Bilski v. Kappos*, 561 U.S. 593 (2010), and also in *Alice*, cited specific references (e.g., three finance textbooks in *Bilski*), to substantiate its finding in *Bilski*, that “hedging,” and in *Alice*, that “intermediated settlement,” is a fundamental economic practice (*id.* at 14). And Appellant ostensibly maintains that the Examiner is likewise required to

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<sup>3</sup> We note that Appellant’s briefs were filed, and the Examiner’s Answer mailed, before the USPTO issued the Revised Guidance, which, by its terms, applies to all applications, and to all patents resulting from applications, filed before, on, or after January 7, 2019. In accordance with the Revised Guidance, a claim is generally considered “directed to” an abstract idea if (1) the claim recites subject matter falling within one of the following groupings of abstract ideas: (a) mathematical concepts; (b) certain methods of organizing human activity, e.g., fundamental economic principles or practices, commercial or legal interactions; and (c) mental processes, and (2) the claim does not integrate the abstract idea into a practical application i.e., apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception. *See* Revised Guidance, 84 Fed. Reg. at 54–55. The Revised Guidance references the MANUAL OF PATENT EXAMINING PROCEDURE (“MPEP”) §§ 2106.05(a)–(c) and (e)–(h) in describing the considerations that are indicative that an additional element or combination of elements integrates the judicial exception, e.g., the abstract idea, into a practical application. *Id.* at 55. If the recited judicial exception is integrated into a practical application, as determined under one or more of these MPEP sections, the claim is not “directed to” the judicial exception.

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cite authority here in order to establish a prima facie case of patent-ineligibility (*id.*). We disagree.

As an initial matter, we find nothing in *Bilski* or *Alice* that requires the Office to identify specific references to support a finding that a claim is directed to an abstract idea. Nor, contrary to Appellant’s assertion (*id.*), did this Board hold in *PNC Bank v. Secure Access*, CBM2014-00100, 2014 WL 4537440 (PTAB Sept. 9, 2014) that an examiner must provide evidentiary support in every case before a determination can be made that a claim is directed to an abstract idea.<sup>4</sup> Appellant also has not articulated sufficiently Appellant’s assertion that the USPTO’s “2014 Interim Guidance on Patent Subject Matter Eligibility”<sup>5</sup> and/or the Administrative Procedure Act impose any such requirement (*id.* at 11). Evidence may be helpful, e.g., where facts are in dispute, but it is not always needed. *See Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325–26 (Fed. Cir. 2016) (“[I]t is also possible, as numerous cases have recognized, that a § 101 analysis may sometimes be undertaken without resolving fact issues.”). Appellant’s bare assertion that evidence is needed here, without any supporting reasoning as to why, is insufficient to require the Examiner to provide evidentiary support.<sup>6</sup>

The Federal Circuit, moreover, has observed repeatedly that “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d. 1365, 1369

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<sup>4</sup> We would not be bound, in any event, by a non-precedential decision of another panel of the Board.

<sup>5</sup> 79 Fed. Reg. 74618 (December 16, 2014).

<sup>6</sup> We note that Appellant has put forward no rebuttal evidence showing the claims are not directed to an abstract idea.

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(Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

The court has, thus, held that the USPTO carries its procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for the rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (alteration in original). Thus, what is required of the Office is that it sets forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (“Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

In rejecting the pending claims under 35 U.S.C. § 101, the Examiner set forth the statutory basis of the rejection in a sufficiently articulate and informative manner as to meet the notice requirement of 35 U.S.C. § 132 (*see* Final Act. 5–6). And, in doing so, the Examiner set forth a prima facie case of patent-ineligibility. *See* “July 2015 Update: Subject Matter Eligibility,”<sup>7</sup> p. 6 (setting forth a general notice requirement to establish a prima facie rejection under 35 U.S.C. § 101); May 4, 2016 Memorandum to the Patent Examining Corps on “Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant’s Response to a Subject Matter Eligibility Rejection,”<sup>8</sup> p. 2 (“[T]he rejection . . . must provide an

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<sup>7</sup> Available at <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf>.

<sup>8</sup> Available at <https://www.uspto.gov/sites/default/files/documents/ieg-may-2016-memo.pdf>.

explanation . . . which [is] sufficiently clear and specific to provide applicant *sufficient notice* of the reasons for ineligibility and enable the applicant to effectively respond.”) (emphasis added). Appellant does not contend that the Examiner’s rejection was not understood or that the Examiner otherwise failed to comply with the notice requirements of § 132.

We also do not agree with Appellant that the Examiner has mischaracterized the claims as directed to “allowing consumers to choose content” (App. Br. 12–13). Appellant argues that, in characterizing the claimed invention as an abstract idea, the Examiner omits and also misstates material limitations of claim 21 (*id.* at 12). Yet, there is no requirement that the Examiner’s formulation of the abstract idea must copy the claim language. That claim 21 includes more words than the phrase the Examiner used to articulate the abstract idea to which the claim is directed is an insufficient basis to persuasively argue that the claim language has been mischaracterized or that the Examiner has otherwise failed to consider all of the limitations of the claim. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.”).

Turning to step two of the *Mayo/Alice* framework, Appellant argues that the claims, when considered as a whole, “contain additional limitations that are not ‘well understood, routine, and conventional in the field,’ and thus provide an inventive concept” (App. Br. 15). Yet, the features that Appellant identifies as providing the inventive concept, i.e.,

licensing the content from the one or more content providers; allowing the consumers to select content available from the one or more content providers; [and] directly supplying the selected content to the consumers via the one or more respective networks of the one or more network operators without the content service or the one or more content providers charging the consumers, as recited in claim 21 (*id.*), are part of the abstract idea itself. They are not additional elements to be considered in determining whether claim 21 includes additional elements or a combination elements that is sufficient to amount to significantly more than the judicial exception.

Addressing step two of the *Mayo/Alice* framework in *Berkheimer*, the Federal Circuit held that the question of whether a claim element or combination of elements is well-understood, routine, and conventional to a skilled artisan in the relevant field is a question of fact. *Berkheimer v. HP, Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018). But, it could not be clearer from *Alice*, that under step two of the *Mayo/Alice* framework, the elements of each claim are considered both individually and “as an ordered combination” to determine whether the additional elements, i.e., the elements *other* than the abstract idea itself, “transform the nature of the claim” into a patent-eligible application. *Alice Corp.*, 573 U.S. at 217. *See Mayo*, 566 U.S. at 72–73 (requiring that “a process that focuses upon the use of a natural law also contain *other* elements or a combination of elements, sometimes referred to as an ‘inventive concept,’ sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the natural law itself” (emphasis added)). In other words, the inventive concept under step two of the *Mayo/Alice* test cannot be the abstract idea itself:

It is clear from *Mayo* that the “inventive concept” cannot be the abstract idea itself, and *Berkheimer* . . . leave[s] untouched the numerous cases from this court which have held claims ineligible because the only alleged “inventive concept” is the abstract idea.

*Berkheimer v. HP, Inc.*, 890 F.3d 1369, 1374 (Fed. Cir. 2018) (Moore, J., concurring). *See also BSG Tech. LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290–91 (Fed. Cir. 2018) (“Our precedent has consistently employed this same approach. If a claim’s only ‘inventive concept’ is the application of an abstract idea using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea.”).

The only claim elements in claim 21 beyond the abstract idea are the claimed “computer” and one or more “networks.” Appellant cannot reasonably contend, nor does he, that there is a genuine issue of material fact regarding whether operation of these components is well-understood, routine, or conventional, where, as here, there is nothing in the Specification to indicate that the operations recited in claim 21 require any specialized hardware or inventive computer components or that the claimed invention is implemented using other than generic components operating in their normal, routine, and ordinary capacity.

Appellant also misapprehends the controlling precedent to the extent Appellant maintains that the claims are patent-eligible because there is no risk of preemption (App. Br. 15–17). Although the Supreme Court has described “the concern that drives [the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption,” *Alice Corp.*, 573 U.S. at 216, characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of

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preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 134 S. Ct. at 2354).

“[P]reemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

We are not persuaded, on the present record, that the Examiner erred in rejecting claim 21 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection of claim 21, and claims 22, 23, and 40–56, which fall with claim 21.

#### *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., 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 claims 21–23 under § 112, first paragraph, the Examiner determines that the Specification does not provide adequate written description support for “charging the one or more network operators for the content supplied to the consumers through the one or more respective networks,” as recited in claim 21 (Final Act. 7–8). The Examiner explains that although claim 21 suggests that network operators are being charged for

the content as well as supplying the content, this is not disclosed in the Specification (*id.* at 7–8).

We are not persuaded by Appellant’s argument that the Specification, in paragraph 36,<sup>9</sup> provides the requisite written description support (App. Br. 19; *see also* Reply Br. 3). There, the Specification discloses, with reference to Figure 3, that charge structure system 302 allows the content provider to select a charge structure for the audiovisual content. The Specification further describes that, in one exemplary embodiment, the content provider can elect to allow the content to be provided “on a free basis with commercial insertion, to be included in conjunction with flat fee billing structures, to be provided on a pay-per-view basis only, to be provided with incentives such that viewers that watch the content will receive compensation, or on other suitable charge structures.” But, we find nothing in that paragraph, nor did the Examiner, that discloses that network operators are charged for the audiovisual content (Final Act. 3–4).

Appellant argues, as best understood, that by disclosing that the content provider can elect to allow the content to be provided in conjunction with a *flat fee billing structure*, the network operator is necessarily placed between the consumer and the content provider such that the network operator is required to collect funds from the consumer and to pay the charges submitted by the content provider as part of the flat fee structure (Reply Br. 3). But Appellant does not adequately explain why, and we fail to see why, election of a flat fee structure necessarily requires that the network operator be charged for program content.

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<sup>9</sup> Appellant references paragraph 36 of US 2011/0161997 A1, published June 30, 2011. The same language appears in paragraph 35 of the original Specification.

In view of the foregoing, we sustain the Examiner's rejection of claims 21–23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.<sup>10</sup>

*Obviousness*

*Independent Claim 21 and Dependent Claim 22*

In rejecting claim 21 under 35 U.S.C. § 112, first paragraph, the Examiner determined, as described above, that the Specification lacks written description support for “charging the one or more network operators for the content supplied to the consumers through the one or more respective networks,” as recited in claim 21 (Final Act. 7). And the Examiner stated that claim 21 would be interpreted, “[f]or purposes of examination,” as reciting “charging the consumers for the content supplied to the consumers through the one or more respective networks” (*id.* at 8). The Examiner, thus, chose to interpret and examine claim 21 as though it were directed to the allegedly “disclosed invention” rather than to the “claimed invention,” as recited in claim 21. This is not appropriate at least because it does not comport with the requirements for examiner's action, as set forth in 37 C.F.R. § 1.104(a)(1).<sup>11</sup>

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<sup>10</sup> We need not, and do not, address the Examiner's further rejection of claims 22 and 23 as lacking written description support for the term “playlist,” as recited in claim 22, and for the terms “playlist,” “profile,” and “like/dislike,” as recited in claim 23 (Final Act. 8).

<sup>11</sup> 37 C.F.R. § 1.104(a)(1) reads:

(a) Examiner's action.

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both

The Examiner must examine the “invention as claimed” by the applicant even when there is an alleged conflict with the disclosure. Because the Examiner admits claim 21, as it appears before us on appeal, has not been examined, the Examiner has failed to establish a prima facie case of obviousness.

Therefore, we do not sustain the rejection of claim 21 under 35 U.S.C. § 103(a). For the same reason, we also do not sustain the rejection of dependent claim 22.

*Dependent Claim 23*

Claim 23 ultimately depends from independent claim 21. The rejection of claim 23 does not cure the deficiency in the Examiner’s rejection of claim 21. Therefore, we do not sustain the Examiner’s rejection of claim 23 for the same reason set forth above with respect to claim 21.

*Independent Claim 40 and Dependent Claims 41–56*

We are persuaded by Appellant’s argument that the Examiner erred in concluding, based on the March 23, 2015 Decision on Petition, that claims 21 and 40 are not patentably distinct, and that the patentability of claims 40–56, therefore, stands or falls with claim 21 (App. Br. 25–26; *see also* Final Act. 2). As Appellant accurately observes, the Decision on Petition does not indicate that independent claims 21 and 40 define “the same disclosed invention” (App. Br. 26). Instead, the Decision states that a “comparison of claim 21 and claim 40 shows that both claims define the

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to compliance of the application or patent under reexamination with the applicable statutes and rules and *to the patentability of the invention as claimed*, as well as with respect to matters of form, unless otherwise indicated.

(Emphasis added).

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same disclosed invention of varying degrees in scope” (*id.*). Claims 40–56 clearly include limitations that are not recited in claims 21–23.

The Examiner admittedly has not examined claims 40–56 and, as such, has not established a prima facie case of obviousness with respect to these claims. Therefore, we do not sustain the Examiner’s rejection of claims 40–56 under § 103(a).

#### DECISION

The Examiner’s rejection of claims 21–23 and 40–56 under 35 U.S.C. § 101 is affirmed.

The Examiner’s rejection of claims 21–23 under 35 U.S.C. § 112, first paragraph, is affirmed.

The Examiner’s rejections of claims 21–23 and 40–56 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