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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte KYLE PRESTENBACK, EVAN TAHLER, BRIAN KWAN,
and EVAN ACOSTA

Appeal 2017-004454
Application 12/238,335
Technology Center 2400

Before ST. JOHN COURTENAY III, THU A. DANG, and
LARRY J. HUME, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL¹

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–31, which constitute all claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ In a prior Decision (Appeal Number 2013-002198, decided April 16, 2015, hereafter “Prior Decision”), we affirmed the Examiner’s rejection of claims 1–31 under 35 U.S.C. § 102(e) as being anticipated by Bishop, and left it to the Examiner to evaluate the claims for compliance with 35 U.S.C. § 101.

STATEMENT OF THE CASE

According to Appellants, the claimed invention relates to methods and apparatuses for use with an optical disc and/or data access device such as an optical disc player device (Spec. ¶ 1). Claim 1, illustrative of the invention and the subject matter of the appeal, reads as follows:

1. A method comprising:

accessing, with an optical disc player device, content information stored on an optical disc, said content information comprising video data, audio data, and advertisement data, said advertisement data being associated with at least one of a product and a service that is not adapted for use by the optical disc player-device, said advertisement data comprising at least one of advertisement video data, advertisement audio data, advertisement image data, advertisement graphic data, and advertisement textual data; and

generating, with the optical disc player device, at least one content presentation signal associated with at least a portion of said content information comprising at least a portion of said advertisement data, said at least one content presentation signal being adapted for use by at least one of a video monitor device and an audio monitor device;

accessing, with the optical disc player device, instructional information stored on said optical disc, said instructional information comprising computer implementable instructions;

determining, with the optical disc player device based upon the instructional information, user input data that identifies user contact information and at least one advertisement selection associated with the advertisement data; and

initiating, with the optical disc player device based upon the instructional information, transmission of an information request for additional information via a network interface through a network to at least one network resource device, the additional information corresponding to at least one of a product and a service associated with the advertisement selection without receiving the additional information at the optical disc player device, said information request comprising at least said user contact information and being adapted for use by at least one information delivery system that is operably associated with the at least one network resource device and is adapted to respond to said information request by initiating subsequent user contact to a device that is distinct from the optical disc

player device to send the additional information to the device, the additional information being distinct from said at least one of said product and said service, the information request being initiated prior to completion of a purchase of at least one of said product and said service.

The Rejections on Appeal

1. Claims 1–31 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter (App. Br.12).
2. Claims 1–31 stand rejected under 35 U.S.C. § 112, 1st Paragraph as not complying with the written description requirement (*id.*).
3. Claims 1–31 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Bishop (US 2008/0071834 A1; published Mar. 20, 2008) and Khusheim (US 2003/0221191 A1; published Nov. 27, 2003)(*id.*).

ISSUES

The principal issues before us are whether the Examiner erred in finding that:

1. The claimed method comprising the steps of “accessing” content information, “generating” content presentation signal,” “accessing” instructional information, “determining” user input data, and “initiating” transmission of an information request “based upon the instructional information” (claim 1) is directed to patent ineligible subject matter.
2. The limitation “the additional information being distinct from said at least one of said product and said service, the information request being initiated prior to completion of a purchase of at least one of said product and said service” (claim 1) is not supported by Applicants’ disclosure as originally filed.

3. Bishop in view of Khusheim teaches or suggests “initiating . . . transmission of an information request for additional information via a network interface,” the additional information “corresponding to at least one of a product and a service associated with the advertisement selection without receiving the additional information at the optical disc player device” (*id.*).

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Bishop

1. Bishop discloses a computer readable medium 100 comprising program instructions 200 that are executable by the computer 102 for generating a graphical user interface (GUI) 124 on the monitor 116, wherein the GUI 124 allows a user to interact with the computer readable medium 100, and wherein the user can select media items 202 for transfer to the media player 122 (¶ 20; Fig. 2).
2. Predetermined content can be sampled and purchased directly from the GUI 124, wherein the user can enter standard personal information associated with e-commerce to enable authorization of the purchase, and wherein the user is prompted to enter information about the mobile phone, for example (¶¶ 31–32; Figs. 3–4).

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments presented in this appeal. Arguments which Appellants could have made, but did not make in the Briefs are deemed to be waived. *See*

37 C.F.R. § 41.37(c)(1)(iv). On the record before us, we are not persuaded the Examiner has erred. We adopt as our own the findings and reasons set forth in the rejections from which the appeal is taken and in the Examiner's Answer, and provide the following for highlighting and emphasis.

Rejection Under 35 U.S.C. § 101

Appellants argue the Examiner erred in concluding the claims are directed to an abstract idea and, therefore, constitute patent ineligible subject matter. App. Br. 12–16.² Specifically, Appellants contend “the problem identified by the instant Specification is a network centric problem particular to the Internet just as in *DDR*.” *Id.* at 13, citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014). According to Appellants, “[t]he configurations provided in claims 1-31 use a **network** to send an information request from an optical disc player to at least one network resource device,” which then “responds to the information request via a device that is distinct from the optical disc player device.” *Id.* at 14. Thus, “claims 1-31 of the instant patent application are directed toward a solution that is necessarily rooted in computer technology,” i.e., “the networked configuration that removes the complexity of an optical disc player device and still provides an enhanced user experience.” *Id.* Appellants then argue “claims 1-31 improve the functioning of a computer in a way that is specifically outlined by *Enfish*,” and thus, “claims 1-31 are not directed toward an abstract idea.” *Id.* at 16, citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1338 (Fed. Cir. 2016).

² Appellants argue all claims as a group for purposes of the ineligible subject matter rejection, and we choose claim 1 as representative of the group. 37 C.F.R. § 41.37(c)(1)(iv).

Based on the record before us, we are not persuaded of Examiner error.

Under 35 U.S.C. § 101, the Supreme Court has long interpreted the statute to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014). The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1300 (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 is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea, as the Examiner concludes in this case. If the claims are not directed to 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.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297).

Here, the Examiner concludes the claims are directed to “a well-known and widely used business method of ordering content from a catalogue.” Ans. 4. In particular, according to the Examiner, “[i]n the instant claims, an optical device” is “being ‘adapted’ to perform the business method of viewing advertisement and ordering product/services where the product service is delivered to another system,” which “solely capture an abstract idea.” *Id.* We agree.

The claims merely recites the steps of “accessing” stored information comprising advertisement data, “generating” content presentation signal associated with the stored information comprising the advertisement data, “accessing” instructional information, “determining” user input data based upon the instructional information and advertisement selection associated with the advertisement data, and then “initiating” transmission of an information request for additional information via a network interface based on the instructional information without receiving the additional information at the optical disc player device (claim 1). That is, claim 1 merely recites “accessing” stored information/data, “generating” signal/data associated with the stored data, associating other stored information/data, “determining” user input data based on the accessed stored information/data, and “initiating . . . transmission” of request(data) for additional information data based on the accessed information/data, wherein the transmitted request(data) comprises certain information/data and is adapted for use for certain functions and the requested information/data contains certain characteristics. *Id.*

Accordingly, we conclude the claims are directed to collecting and analyzing various information/data. Claims involving data collection and analysis are directed to an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent ineligible concept”); *see also In re TLI Commc ’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016). As such, claim 1 is directed to the abstract

idea of accessing, generating, analyzing/determining, and initiating transmission of data. On this record, we agree with the Examiner that claim 1 is directed to an abstract idea under step one of *Alice*.

As to *Alice* step two, although Appellants contend “the problem identified by the instant Specification is a network centric problem particular to the Internet” wherein “claims 1-31 of the instant patent application are directed toward a solution that is necessarily rooted in computer technology” (App. Br. 13–14), “the relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice*, 134 S. Ct. at 2359. As we stated in our previous Decision, “we leave it to the Examiner to evaluate the claims as to whether they solely capture an abstract idea without any ties to a specific structure or machine.” Decision 6. Here, the Examiner concludes, and we agree, “[t]he recitation of ubiquitous computer structure recited in the instant claims to implement the business method does not amount to ‘significantly more’” because “the said computer structure is being used in the traditional manner of passing and receiving information related to the business method without improving the computer technology itself.” Ans. 5. That is, we agree that these are all generic computer functions (i.e., the accessing, generating, determining and initiating the transmission of data) that are well-understood, routine, and conventional activities previously known to the industry. *Id.*

Although Appellants contend “[t]he configurations provided in claims 1-31 use a *network* to send an information request from an optical disc player to at least one network resource device,” which then “responds to the information request via a device that is distinct from the optical disc player device” (App. Br. 14), we find the “network” that is “rooted in computer

technology” does not add meaningful limitation to the idea of sending an information request beyond generally linking the method to a particular technological environment. That is, contrary to Appellants’ contention, providing a “network” that sends data from one device to another device, which then responds via yet another device (*id.*) is not sufficient to transform the claims into a patent-eligible application.

For at least the aforementioned reasons, on this record, we sustain the patent-ineligible subject matter rejection under 35 U.S.C. § 101 of claim 1 and claims 2–31 falling therewith.

Rejection Under § 112, 1st Paragraph

The Examiner rejects claims under § 112, 1st Paragraph as failing to comply with the written description requirement (Final Rej. 10–11). In particular, the Examiner finds the limitation “the additional information being distinct from said at least one of said product and said service, the information request being initiated prior to completion of a purchase of at least one of said product and said service” is not supported by the Disclosure as originally filed. *Id.*

In response, Appellants contend,

Par. [0034] of the instant Specification states the following: “[f]or example, a user may indicate an interest in receiving more information regarding a product’s cost, specifications, options, etc.” Appellants respectfully submit that those skilled in the art would understand “more information” as explicitly stated to be information other than the product and service, e.g., cost is information that is distinct from a product or service itself.

App. Br. 16.

Further, Appellants contend,

[T]hose skilled in the art would understand that a user typically expresses interest in receiving more information prior to a purchase. . . . In other words, a user would not typically request information regarding the cost of a product or service after the user has already purchased the product or service. As the type of information being requested is known to those skilled in the art as being information prior to completion of a purchase, e.g., cost, specifications, options, etc., Appellants respectfully submit that para. [0034] provides disclosure for “ . . . the information request being initiated prior at completion of a purchase of at least one of said product and said service.”

Id. at 16–17.

We are not persuaded by Appellants’ arguments because Appellants appear to be contending the contested limitation would have been obvious to one of ordinary skill in the art upon reading the Specification. However, a Specification which merely renders obvious the claimed invention is not sufficient to satisfy the written description requirement. Our reviewing court guides the written description “must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (*en banc*) (citation and quotations omitted). The test is whether the disclosure “conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* “[A]ctual ‘possession’ or reduction to practice outside of the specification is not enough. Rather, . . . it is the specification itself that must demonstrate possession.” *Id.* at 1352; *see also PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306–07 (Fed. Cir. 2008) (emphasis added) (explaining that § 112, ¶ 1 “requires that the written description actually or inherently disclose the claim element”).

[I]t is ‘not a question of whether one skilled in the art might be able to construct the patentee’s device from the teachings of the disclosure. . . . Rather, it is a question whether the application necessarily discloses that particular device.’ . . . A description which renders obvious the invention for which an earlier filing date is sought is not sufficient.

Lockwood v. Am. Airlines, Inc., 107 F.3d 1565, 1572 (Fed. Cir. 1997) (quoting *Jepson v. Coleman*, 314 F.2d 533, 536 (CCPA 1963)) (emphasis added).

Applying this reasoning here, we are not persuaded by Appellants’ statements that upon reading paragraph 34’s “more information regarding a product’s cost, specifications, options, etc.” that “those skilled in the art would understand ‘more information’ as explicitly stated to be information other than the product and service,” and that “those skilled in the art would understand that a user typically expresses interest in receiving more information prior to a purchase.” App. Br. 16–17.

Instead, as the Examiner points out, “[i]t is not clear how information such as ‘a product’s cost, specifications, options, etc’ regarding the product as recited in para. [0034] of Appellants’ disclosure can be reasonably construed as ‘distinct’ from the product/service” (Ans. 6). Similarly, we agree with the Examiner that “the disclosure supports a user may indicate interest in receiving product information ‘**by submitting a purchase order, accepting an offer, etc.**’” but “[t]here’s no support in the disclosure for the limitation ‘the additional information being distinct from said at least one of said product and said service, the information **request being initiated prior to completion of a purchase of at least one of said product and said service.**’” *Id.* at 7.

On this record, we are not persuaded the Examiner erred. Accordingly, we sustain the Examiner's rejection of representative claim 1, and grouped claims 2–31, under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Rejection Under Pre-AIA 35 U.S.C. § 103(a)

Appellants contend, “Bishop is directed toward a system, which has a physical medium, that transfers data to a device, e.g., portable media player, at which the user can perform playback of the transferred content” (App. Br. 18), wherein

[T]he ringtone may be sent “directly to the mobile phone” via SMS or an Internet download link only after stating that the user “. . . selects or clicks on the ‘Send to Player’ control 314” In other words, the term “directly” used by the Bishop would be understood by those skilled in the art reading the entirety of Bishop to mean that the *computer 102*, at which the Send to Player control 314 is displayed, sends a compatible version of the ringtone to the mobile telephone. (*Id.* at 20).

Therefore, Appellants contend “Bishop does not teach ‘. . . without receiving the additional information at the optical disc player device’” (*id.*).

Further, Appellants contend “Khuseim does not alleviate the deficiencies of Bishop” (*id.*). According to Appellants, since the principle of operation of Bishop is “having the computer 102, which receives the computer readable medium 100, perform the transfer of the media file,” if the media file is not received by the computer 102, “Bishop would be modified into an entirely different configuration that would not be able to perform the principle of operation” (*id.* at 21).

We have considered all of Appellants' arguments and any evidence presented. However, we find no error with the Examiner's broad but reasonable interpretation of the claims, or the Examiner's conclusion that claim 1 would have been obvious over Bishop and Khusheim.

As a preliminary matter of claim construction, we give the claims their broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). While we interpret claims broadly but reasonably in light of the Specification, we nonetheless must not import limitations from the Specification into the claims. *See In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Although Appellants contend "Bishop would be understood by those skilled in the art reading the entirety of Bishop to mean that the **computer 102**, at which the Send to Player control 314 is displayed, sends a compatible version of the ringtone to the mobile telephone" (App. Br. 20), we note such contention is not commensurate with the language of the claim. In particular, nothing in claim 1 precludes the computer sending a compatible version of the ringtone "directly" to the mobile telephone (*id.*). Instead, claim 1 merely recites a method comprising a step of "initiating, with the optical disc player . . . , transmission" of an information request for data (additional information) "via a network interface through a network," and "without receiving the additional information at the optical disc player device" (claim 1).

Given the broadest, reasonable interpretation of the claims, we find no error with the Examiner's reliance on Bishop in view of Khusheim to teach or suggest the contested limitation.

Here, Appellants' Specification and claims do not provide any clear definition for "without receiving the additional information at the optical disc player" (claim 1). In fact, Appellants' citations to the Specification (App. Br. 4, citing paras. 34, 42) do not provide supporting disclosure relating to any specialized structure or reason to exclude in support of the disputed negative limitation. *See Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1351 (Fed. Cir. 2012) ("Negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant limitation. Such written description support need not rise to the level of disclaimer. In fact, it is possible for the patentee to support both the inclusion and exclusion of the same material."). *See also* Manual of Patent Examining Procedure (MPEP) § 2173.05(i) (9th Ed., Mar. 2014) ("Any negative limitation or exclusionary proviso must have basis in the original disclosure The mere absence of a positive recitation is not basis for an exclusion").

This reasoning is applicable here as the citations to the Specification merely describes a user's interests and instructional information stored, without any mention of "without" receiving additional information at the optical disc player device (paras. 34, 42). Thus, as a matter of claim construction consistent with the Specification, this contested, but unsupported, negative limitation of claim 1 (i.e., "without receiving the additional information at the optical disc player device") should not be accorded patentable weight.

Nevertheless, given the broadest reasonable interpretation of the claims, we find no error with the Examiner's reliance on Bishop for teaching the contested limitation (Ans. 7-9, FF 1-2), as recited in claim 1. In

particular, as the Examiner finds, “Bishop explicitly supports products such as ringtone media and information regarding the products can be sent directly to a user’s mobile device or sent to another device via the optical device/computer” (*id.* at 7). That is, “contrary to Appellant’s argument, Bishop explicitly discloses sending the product directly to the mobile device via an SMS messaging service, wherein a download link (i.e., additional information) is sent directly to the mobile device via an SMS” . . . “...without receiving the additional information at the optical disc player device” (*id.* at 8–9).

On this record, in view of the broadest reasonable interpretation of the claims consistent with the Specification, we are not persuaded the Examiner erred in relying on Bishop to teach or suggest the contested limitation.

Consequently, we find no reversible error in the Examiner’s rejection of claim 1 and claims 2–10 falling therewith (App. Br. 21) over Bishop and Khusheim. Appellants do not provide substantive arguments for claims 11–31 separate from those of claim 1 (*id.* at 22–23), and thus, claims 11–31 also fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

We affirm the Examiner’s rejections of claims 1–31 under 35 U.S.C. §§ 101, 112, and 103.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED