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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYMANTEC CORPORATION
Requester

v.

INTELLECTUAL VENTURES I, LLC
Patent Owner

Appeal 2017-007100
Reexamination Control No. 95/002,202
Patent No. US 6,460,050 B1
Technology Center 3900

Before JAMES T. MOORE, MARC S. HOFF, and STEPHEN C. SIU,
Administrative Patent Judges.

HOFF, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Patent Owner (Intellectual Ventures, LLC) appeals under 35 U.S.C.
§§ 134(b) and 315(a) (2002) from the rejection of claims 1, 2, 4–6, 8–10,

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12–17, and 21–24¹ as set forth in the Right of Appeal Notice (“RAN”) mailed October 1, 2014. Patent Owner filed a brief (“PO App. Br.”) on June 12, 2015. Requester (Symantec Corporation) filed a respondent brief (“Req. Br.”) on July 13, 2015. Patent Owner filed a rebuttal brief (“PO Reb. Br.”) on November 16, 2015. The Examiner mailed an Examiner’s Answer (“Ans.”) on October 16, 2015, which incorporated the RAN by reference. We have jurisdiction under 35 U.S.C. §§ 134 and 315.

We affirm the rejection of the appealed claims on new grounds, in view of the Federal Circuit’s decision in *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307 (Fed. Cir. 2016), which concluded that certain claims of the ’050 Patent are directed to patent-ineligible subject matter under 35 U.S.C. § 101.

The ’050 Patent was issued to Pace on October 1, 2002. The ’050 Patent concerns a file content classification system, intended to determine whether a piece of e-mail is to be classified as SPAM, or copyrighted material, or as containing a virus. *See* ’050 Patent, Abstract; col. 3, ll. 16–20. In one aspect of the invention, the system includes a digital ID generator and an ID database coupled to receive IDs from the ID generator. The system further includes a characteristic comparison routine identifying the file as having a characteristic based on ID appearance in the appearance database. ’050 Patent, col. 2, ll. 24–29.

¹ Patent Owner does not appeal rejected claims 3, 7, 11, 18, 19, 26, 28–39, and 42–59. Claims 20, 25, 27, 40, and 41 stand confirmed or patentable. RAN 2.

Claim 1, which is illustrative of the appealed subject matter, reads as follows:

1. A file content classification system comprising:
 - a plurality of agents, each agent including a file content ID generator creating file content IDs using a mathematical algorithm, at least one agent provided on one of a plurality of clients;
 - an ID appearance database, provided on a server, coupled to receive file content IDs from the agents; and
 - a characteristic comparison routine on the server, identifying a characteristic of the file content based on the appearance of the file content ID in the appearance database and transmitting the characteristic to the client agents.

The appealed claims stand rejected as follows:

Claims 1, 2, 4–6, 8–10, 12–17, and 21–24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Townshend. RAN 8.

Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over McCormick and Townshend. RAN 14.

Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Townshend and Norton AntiVirus for Internet Email Gateways (1998) (“NAV”). RAN 16.

Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Townshend and Applicant’s Admitted Prior Art (“AAPA”). RAN 16.

ISSUES

The following issues are presented in light of *Intellectual Ventures I*:

1. Is the claimed invention directed to an abstract idea?
2. Do the claims nevertheless recite 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 upon the abstract idea itself?

ANALYSIS

NEW GROUND OF REJECTION UNDER 35 U.S.C. § 101

The Federal Circuit concluded that claims 9, 13, 16, 22, and 24 of the '050 Patent, asserted in litigation by Patent Owner Intellectual Ventures against Third Party Requester Symantec Corp., are directed to patent-ineligible subject matter under 35 U.S.C. § 101. *Intellectual Ventures I*, 838 F.3d at 1311. That decision became final as of January 19, 2017, the date of issuance of the mandate to the United States District Court for the District of Delaware. We, therefore, consider proceedings terminated as to claims 9, 13, 16, 22, and 24 of the '050 Patent.

Claims 1, 2, 4–6, 8, 10, 12–15, 17, 21, and 23² are newly rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

Claims 1 and 21 are independent. Each of these independent claims recites subject matter analogous to that of claim 9, selected as representative

² In the event of further proceedings, the Examiner may also wish to consider the applicability of the Federal Circuit's conclusion, that asserted claims 9, 13, 16, 22, and 24 constitute patent-ineligible subject matter, to the remaining, un-appealed claims of the '050 Patent.

by the Federal Circuit and determined to be directed to patent-ineligible subject matter. *See Intellectual Ventures I*, 838 F.3d at 1313. This chart shows the parallel claim limitations:

Claim 9	Claim 1	Claim 21
<p>A method for identifying characteristics of data files, comprising:</p>	<p>A file content classification system comprising:</p>	<p>A file content classification system for a first computer and a second computer coupled by a network, comprising:</p>
<p>Receiving, on a processing system, file content identifiers for data files from a plurality of file content identifier generator agents, each agent provided on a source system and creating file content IDs using a mathematical algorithm, via a network;</p>	<p>A plurality of agents, each agent including a file content ID generator creating file content IDs using a mathematical algorithm, at least one agent provided on one of a plurality of clients;</p>	<p>a client agent file content identifier generator on the first computer, the file content identifier comprising a computed value of at least two non-contiguous sections of data in a file; and</p>

<p>Determining, on the processing system, whether each received content identifier matches a characteristic of other identifiers; and</p>	<p>a characteristic comparison routine on the server, identifying a characteristic of the file content based on the appearance of the file content ID in the appearance database and</p>	<p>A server comparison agent and data-structure on the second computer receiving identifiers from the client agent, determining if the file comprises at least one of SPAM or a virus based on the identifiers, and</p>
<p>Outputting, to at least one of the source systems responsive to a request from said source system, an indication of the characteristic of the data file based on said step of determining.</p>	<p>Transmitting the characteristic to the client agents.</p>	<p>Providing replies to the client agent, wherein the replies comprise an indication that the file comprises at least one of SPAM or a virus; wherein the client agent processes the file based on replies from the server comparison agent.</p>

The Federal Circuit analyzed the asserted claims under the test set forth in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct.

1289 (2012) and *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014). At step one of the analysis, a court must “determine whether the claims at issue are directed to one of those patent-ineligible concepts [i.e., laws of nature, natural phenomena, or abstract ideas].” *Alice*, 134 S. Ct. at 2355. If a claim is directed to a patent-ineligible concept, the court must proceed to *Mayo/Alice* step two and ask, “[w]hat else is there in the claims before us?” *Alice*, 134 S. Ct. at 2355. The second step is “a 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 upon the [ineligible concept] itself.’” *Alice*, 134 S. Ct. at 2355.

The Federal Circuit found that the content of claims 9, 13, 16, 22, and 24, i.e., “receiving e-mail (and other data file) identifiers, characterizing e-mail based on the identifiers, and communicating the characterization—in other words, filtering files/e-mail—is an abstract idea.” *Intellectual Ventures I*, 838 F.3d at 1313. Proceeding to step two of the *Mayo/Alice* analysis, the court found no element or combination of elements sufficient to ensure that the patent would amount to significantly more than a patent upon the ineligible concept. “The steps of the asserted claims of the ’050 patent do not ‘improve the functioning of the computer itself.’” *Intellectual Ventures I*, 838 F.3d at 1315 (quoting *Alice*, 134 S. Ct. at 2359). “[T]hese claims use generic computers to perform generic computer functions.” *Intellectual Ventures I*, 838 F.3d at 1315. Further, the court found that “[t]here is not, in the ’050 patent, any ‘specific or limiting recitation of . . . improved computer technology.’” *Intellectual Ventures I*, 838 F.3d at 1316

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(quoting *CLS Bank Int'l v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1286 (Fed. Cir. 2013) (en banc)).

We find that claims 1 and 21 recite an invention analogous to that recited in claim 9. Like claim 9, we find that claims 1 and 21 are directed to the abstract idea of receiving e-mail (and other data file) identifiers, characterizing e-mail based on the identifiers, and communicating the characterization. Like claim 9, we further find that claims 1 and 21 do not recite an element or elements sufficient to ensure that the patent would amount to significantly more than a patent upon the abstract idea. The steps of claims 1 and 21 do not improve the functioning of the computer itself, or contain any specific or limiting recitation of improved computer technology.

We conclude that independent claims 1 and 21, like independent claim 9 (and independent claims 16 and 24), are directed to an abstract idea and lack an inventive concept sufficient to transform the claimed abstract idea into a patent eligible application. Therefore, we conclude that independent claims 1 and 21 are directed to patent-ineligible subject matter under § 101.

Claims 2, 4–6, and 8 depend from independent claim 1. The dependent claim limitations do not alter the independent claim's recitation of the abstract idea of receiving e-mail (and other data file) identifiers, characterizing e-mail based on the identifiers, and communicating the characterization. The dependent claim limitations also fail to recite an inventive concept that is sufficient to transform the claimed abstract idea into a patent-eligible application. As a result, we conclude that claims 2, 4–6, and 8 are directed to patent-ineligible subject matter under § 101.

Claims 10 and 12–15 depend from independent claim 9. The dependent claim limitations do not alter the independent claim’s recitation of the abstract idea of receiving e-mail (and other data file) identifiers, characterizing e-mail based on the identifiers, and communicating the characterization. The dependent claim limitations also fail to recite an inventive concept that is sufficient to transform the claimed abstract idea into a patent-eligible application. As a result, we conclude that claims 10 and 12–15 are directed to patent-ineligible subject matter under § 101.

Claim 17 depends from independent claim 16. The dependent claim limitations do not alter the independent claim’s recitation of the abstract idea of receiving e-mail (and other data file) identifiers, characterizing e-mail based on the identifiers, and communicating the characterization. The dependent claim limitations also fail to recite an inventive concept that is sufficient to transform the claimed abstract idea into a patent-eligible application. As a result, we conclude that claim 17 is directed to patent-ineligible subject matter under § 101.

Claim 23 depends from independent claim 22. The dependent claim limitations do not alter the independent claim’s recitation of the abstract idea of receiving e-mail (and other data file) identifiers, characterizing e-mail based on the identifiers, and communicating the characterization. The dependent claim limitations also fail to recite an inventive concept that is sufficient to transform the claimed abstract idea into a patent-eligible application. As a result, we conclude that claim 23 is directed to patent-ineligible subject matter under § 101.

OTHER REJECTIONS

Because our decision to enter a new ground of rejection under § 101 is dispositive regarding the unpatentability of all appealed claims, we need not reach the merits of the Examiner's decision to reject the appealed claims on other grounds. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (approving ITC's determination based on a single dispositive issue, and not reaching other issues not decided by the lower tribunal).

CONCLUSIONS

1. The claimed invention is directed to an abstract idea.
2. The claims do not recite an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the abstract idea itself.

DECISION

37 CFR § 41.77(b) provides that “a new ground of rejection . . . shall not be considered final for judicial review.” That section also provides that Patent Owner, **WITHIN ONE MONTH FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal proceeding as to the rejected claims:

- (1) *Reopen prosecution*. The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

In accordance with 37 C.F.R. § 41.79(a)(1), the “[p]arties to the appeal may file a request for rehearing of the decision within one month of the date of . . . [t]he original decision of the Board under § 41.77(a).” A request for rehearing must be in compliance with 37 C.F.R. § 41.79(b). Comments in opposition to the request and additional requests for rehearing must be in accordance with 37 C.F.R. § 41.79(c)–(d), respectively. Under 37 C.F.R. § 41.79(e), the times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (c) of this section, and for submitting comments under paragraph (b) of this section may not be extended.

An appeal to the United States Court of Appeals for the Federal Circuit under 35 U.S.C. §§ 141–144 and 315 and 37 C.F.R. § 1.983 for an *inter partes* reexamination proceeding “commenced” on or after November 2, 2002, may not be taken “until all parties’ rights to request rehearing have been exhausted, at which time the decision of the Board is final and appealable by any party to the appeal to the Board.” 37 C.F.R. § 41.81. *See also* MPEP § 2682 (8th ed., Rev. 8, July 2010).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

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Requests for extensions of time in this *inter partes* reexamination proceeding are governed by 37 C.F.R. § 1.956. *See* 37 C.F.R. § 41.79.

In the event neither party files a request for rehearing within the time provided in 37 C.F.R. § 41.79, and this Decision becomes final and appealable under 37 C.F.R. § 41.81, a party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

AFFIRMED
37 C.F.R. § 41.77(b)

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