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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDWARD DRAKE and ARNAUD ROBERT

Appeal 2017-008966
Application 13/457,057¹
Technology Center 3600

Before ELENI MANTIS MERCADER, JASON J. CHUNG, and
JASON M. REPKO, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Non-Final Rejection of claims 1–5, 8–18, and 21–27.² We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

The invention is directed to delivery of data content. Spec. ¶ 2.
Claim 1 is illustrative of the invention and is reproduced below:

1. A computer program product comprising a non-transitory computer readable storage device having a computer

¹ According to Appellants, Disney Enterprises, Inc. is the real party in interest. App. Br. 2.

² Claims 6, 7, 19, and 20 are canceled. App. Br. 15, 17. Claims 28–42 are withdrawn. *Id.* at 18–22.

readable program stored thereon, wherein the computer readable program when executed on a computer causes the computer to:

compose one or more auction publisher parameters as auction selection criteria for a selection of a content delivery network provider from one or more content delivery network providers, the auction selection criteria being based at least in part on one or more resource metrics for delivery of the content through a network, the one or more resource metrics being based on at least one of network traffic and content consumption patterns;

send the one or more auction publisher parameters from a content publisher to an auction engine; and

receive, from the auction engine, a selected bid based upon a bid selection process that evaluates a bid from each of the one or more of the plurality of content delivery network providers, the bid being based upon the one or more auction publisher parameters.

REJECTIONS AT ISSUE³

Claims 1–5, 8–18, and 21–27 stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more. Non-Final Act. 6–9.

Claims 1–5, 8–18, and 21–27 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Non-Final Act. 9–10.

Claims 1–5, 8–18, and 21–27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Non-Final Act. 10.

³ Claims 1–4, 11–18, and 24–27 were rejected previously under 35 U.S.C. § 103(a) as being unpatentable over the combination of DeAngelis and Jain et al. (US 2007/0011080 A1; published Jan. 11, 2007). Non-Final Act. 14. That rejection has been withdrawn. Ans. 12.

Claims 1–5, 11–18, and 24–27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by DeAngelis (US 2008/0140493 A1; published June 12, 2008). Non-Final Act. 11–13.

Claims 8, 9, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of DeAngelis and White et al. (US 7,340,428 B1; issued Mar. 4, 2008). Non-Final Act. 14–15.

Claims 10 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of DeAngelis, White, and Chatter et al. (US 2010/0169126 A1; published July 1, 2010). Non-Final Act. 15–16.

We have only considered those arguments that Appellants actually raised in the Briefs. Arguments Appellants could have made, but chose not to make, in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ANALYSIS

Claims 1–5, 8–18, and 21–27 rejected under 35 U.S.C. § 101

The Examiner concludes the present claims are directed to an abstract idea similar to *Dealertrack Inc. v. Huber*, 674 F.3d 1315 (Fed. Cir. 2012), *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014), *Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 1335 (Fed. Cir. 2013), and *SmartGene, Inc. v. Advanced Biological Laboratories, SA*, 555 F. App'x 950 (Fed. Cir. 2014). Non-Final Act. 6–7. Additionally, the Examiner concludes the present claims do not improve the underlying technology, like the claims in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), because the present claims are directed to an improved abstraction that happen to use computer tools (i.e., the claims are directed to provide the

content publisher a mechanism for efficiently managing what CDN provider is most economical to utilize at any point in time, present or future). *Id.* at 2–3.

In addition, the Examiner concludes the claims do not amount to significantly more than the abstract idea because the additional elements are: (1) automating mental tasks and receiving; or (2) transmitting data over a network. *Id.* at 7. The Examiner also concludes these additional elements operate using well-understood, routine, and conventional functions. *Id.* at 7–8.

Appellants argue the present claims use a particular set of resource metrics as criteria for selecting a content delivery network provider in a way that improves how a computer operates, similar to *Enfish*. App. Br. 6–7. Appellants argue the Examiner has not responded to Appellants’ specific application to *Enfish* to the instant claims. *Id.* at 7. Appellants also argue the claims amount to significantly more than the abstract idea because the claims provide a solution for a network delivery problem. Reply Br. 3–4. We disagree with Appellants.

Following the decision in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014), (citing *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–84 (2012)), we analyze claims where the abstract idea judicial exception to the categories of statutory subject matter is at issue using the following two-part analysis set forth in *Mayo*: 1) Determine whether the claim is directed to an abstract idea; and 2) if an abstract idea is present in the claim, determine whether any element, or combination of elements, in the claim is sufficient to ensure that

the claim amounts to significantly more than the abstract idea itself. *See Alice*, 134 S. Ct. at 2350.

As to the first part of the analysis, examples of abstract ideas referenced in *Alice* include: fundamental economic practices⁴; certain methods of organizing human activities⁵; “[a]n idea of itself”⁶; and, mathematical relationships or formulas.⁷ Claims that include abstract ideas like these are examined under the second part of the analysis to determine whether the abstract idea has been applied in an eligible manner.

As to the second part of the analysis, we consider the claim as a whole by considering all claim elements, both individually and in combination. *Id.* at 2355. Limitations referenced in *Alice* that may be enough to qualify as “significantly more” when recited in a claim with an abstract idea include, as non-limiting or non-exclusive examples: Improvements to another technology or technical field⁸; improvements to the functioning of the computer itself⁹; and meaningful limitations beyond generally linking the

⁴ *Alice Corp.*, 134 S. Ct. at 2350: e.g., intermediated settlement, i.e., the use of a third party intermediary to mitigate settlement risk.

⁵ *Id.* at 2356: e.g., a series of steps instructing how to hedge risk (citing *Bilski*, 561 U.S. at 599).

⁶ *Id.* at 2355: e.g., a principle, an original cause, a motive (citing *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) and *Le Roy v. Tatham*, 14 How. 156, 175 (1852)).

⁷ *Id.* at 2350: e.g., a mathematical formula for computing alarm limits in a catalytic conversion process (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)), or a formula for converting binary-coded decimal numerals into pure binary form (*Gottschalk*, 409 U.S. at 71–72).

⁸ *Id.* at 2358: e.g., a mathematical formula applied in a specific rubber molding process (citing *Diamond v. Diehr*, 450 U.S. 175, 177–78 (1981)).

⁹ *Id.* at 2359.

use of an abstract idea to a particular technological environment.¹⁰

Limitations referenced in *Alice* that are not enough to qualify as “significantly more” when recited in a claim with an abstract idea include, as non-limiting or non-exclusive examples: adding the words “apply it” (or an equivalent) with an abstract idea¹¹; mere instructions to implement an abstract idea on a computer¹²; or requiring no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry.¹³

If there are no meaningful limitations in the claim that transform the abstract idea into a patent eligible application such that the claim amounts to significantly more than the abstract idea itself, the claim is directed to non-statutory subject matter under 35 U.S.C. § 101.

The Federal Circuit held “merely selecting information, by content or source, for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes, whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas.” *Elec. Power Grp., LLC, v Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016). In addition, “merely presenting the results of abstract processes of collecting and analyzing information, without more (such as identifying a

¹⁰ *Id.* at 2360: noting that none of the hardware recited “offers a meaningful limitation beyond generally linking ‘the use of the [method] to a particular technological environment,’ that is, implementation via computers” (citing *Bilski v. Kappos*, 561 U.S. 593, 610–11).

¹¹ *Id.* at 2357–58.

¹² *Id.*: e.g., simply implementing a mathematical principle on a physical machine, namely a computer (citing *Mayo*, 566 U.S. at 84–85).

¹³ *Id.* at 2359: e.g., using a computer to obtain data, adjust account balances, and issue automated instructions.

particular tool for presentation), is abstract as an ancillary part of such collection and analysis.” *Id.* at 1354. The Federal Circuit further stated:

[t]he claims in this case do not even require a new source or type of information, or new techniques for analyzing it. . . . As a result, they do not require an arguably inventive set of components or methods, such as measurement devices or techniques, that would generate new data. They do not invoke any assertedly inventive programming. Merely requiring the selection and manipulation of information—to provide a “humanly comprehensible” amount of information useful for users . . . by itself does not transform the otherwise-abstract processes of information collection and analysis.

Id. at 1355 (internal citations omitted).

Alice Step 1

On this record, we see no error in the Examiner’s analysis and conclusion that the present claims are directed to an abstract idea. Non-Final Act. 2–3, 6–9. Regarding Appellants’ arguments (App. Br. 7) that the Examiner has not responded to Appellants’ specific application to *Enfish* to the instant claims, we disagree because the Examiner concludes that the present claims do not improve the underlying technology, like the claims in *Enfish*, because the present claims are directed to an improved abstraction that happen to use computer tools (i.e., the claims are directed to provide the content publisher a mechanism for efficiently managing what CDN provider is most economical to utilize at any point in time, present or future). Non-Final Act. 2–3.

Moreover, we conclude the present claims are similar to the abstract idea of collecting information, analyzing it, and displaying certain results of the collection and analysis in *Electric Power*. 830 F.3d at 1355. We also conclude the claims are similar to the abstract idea of determining a price,

using organizational and product group hierarchies in *Versata Software, Inc., v. SAP America, Inc.*, 717 F.3d 1255 (Fed. Cir. 2013).

Furthermore, the claims in *Enfish* recited means-plus-function limitations, so the Federal Circuit looked in the Specification to determine there was an improvement over the underlying technology (*see* 822 F.3d at 1336–37), whereas the alleged improvement over the underlying technology in the present case is not recited in the claims nor do the present claims recite means plus function limitations.

Because the present claims are directed to an abstract idea, we proceed to step (2) of the *Alice*, two-part test.

Alice Step 2

On this record, we see no error in the Examiner’s analysis and conclusion that the present claims are not directed to significantly more than the abstract idea. Non-Final Act. 2–3, 6–9. In particular, we agree with the Examiner’s conclusion that the present claims operate using well-understood, routine, and conventional functions.¹⁴

In addition, we note Appellants did not present any arguments pertaining to *Alice*, step 2 in the Appeal Brief; rather, Appellants arguments pertain to *Enfish*, which is an *Alice*, step 1 issue. *See* App. Br. 6–7. Appellants’ arguments filed in the Reply Brief (*see* Reply Br. 2–5),

¹⁴ The Specification states, “system 100 is implemented utilizing a **general purpose computer or any other hardware equivalents**” (emphasis added). Spec. ¶ 25. And the Specification states “[t]he processes described herein may be implemented in a **general**, multi-purpose or single purpose processor” (emphasis added). *Id.* ¶ 50. We, therefore, conclude the Specification recites generic elements that operate well-understood, routine, and conventional functions. *Alice* at 2359.

therefore, are untimely and waived because the Examiner did not change the theory in the Answer while Appellants' proffered new arguments in the Reply Brief. *See* 37 C.F.R. § 41.41(b)(2); *compare* Final Act. 2–3, 6–9, *with* Ans. 2–5, 12–13. Even if Appellants' *Alice*, step 2 arguments (Reply Br. 3–4) in the Reply Brief were timely, which they are not, Appellants' arguments are unpersuasive because the present claims are directed to an improved abstraction that happen to use computer tools (i.e., the claims are directed to provide the content publisher a mechanism for efficiently managing what CDN provider is most economical to utilize at any point in time, present or future). In addition, we conclude the present claims use generic elements in combination with abstract ideas. *Alice*, 134 S. Ct. at 2359.

Accordingly, we sustain the Examiner's rejection of: (1) independent claims 1, 14, and 27; and (2) dependent claims 2–5, 8–13, 15–18, and 21–26 under 35 U.S.C. § 101.

Claims 1–5, 8–18, and 21–27 rejected under 35 U.S.C. § 112, first paragraph

The Examiner concludes that there is no written description support for the limitation “one or more resource metrics for delivery of content through a network, the one or more resource metrics being based on at least one of network traffic and content consumption patterns” recited in claims 1, 14, and 27 because the disclosure does not describe how the resource metrics are ultimately determined or calculated. Non-Final Act. 9–10; Ans. 5–6.

Appellants argue “quality of service” is an example of one or more resource metrics that support this limitation. App. Br. 7–8 (citing Spec. ¶¶ 5–6); Reply Br. 4–5. We disagree with Appellants.

At the outset, although it is obvious that “consumption patterns,” without the modifier “content,” could mean “content consumption patterns,” obviousness is insufficient when determining whether the written description requirement is satisfied. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc). Moreover, the Specification’s disclosure of “consumption patterns” could also mean “network consumption patterns” rather than “content consumption patterns.” Spec. ¶ 6. For example, the Specification uses the term “anticipated consumption” after discussing “upcoming storage and traffic requirements,” which relate to network usage generally. *Id.* ¶ 23. As such, Appellants did not have possession of the limitation “content consumption patterns” recited in claims 1, 14, and 27 at the time of filing the application.

Regarding the Examiner’s conclusion that the disclosure does not describe how the resource metrics are ultimately determined or calculated (Non-Final Act. 9–10; Ans. 5–6), the present claims do not recite determining or calculating resource metrics, so the Examiner’s conclusion lacks relevance. Nonetheless, although it may be obvious that “quality of service” is based on at least one of network traffic and content consumption patterns, obviousness is insufficient when determining written description. In fact, it is well settled that a description that merely renders the invention obvious does not satisfy the written description requirement. *See Ariad*, 598 F.3d at 1352. In the present case, the Specification does not state an explicit nexus between a “quality of service” being based on at least one of network traffic and content consumption patterns.

Additionally, paragraph 5 of the Specification states “[t]he **cost** inferred by CDN providers for utilization of CDNs may vary dramatically at

any given time as a result of broad fluctuations in CDN resource utilization” (emphasis added). Spec. ¶ 5. Furthermore, the Specification states “[t]he CDN providers typically offer **pricing** structures that scale with usage, for example **based on storage, resulting network traffic, and consumption patterns**” (emphases added). *Id.* ¶ 6. We conclude the “cost”/“pricing structures” are not reasonable examples of the claimed “one or more resource metrics” that are “based on at least one of network traffic and content consumption patterns.” *Id.* ¶¶ 5–6. Even if the “cost”/“pricing structures” are reasonable examples, which they are not, it would be insufficient to overcome the shortcoming of claims 1, 14, and 27 explicitly stating “**content** consumption patterns” (emphasis added) as discussed *supra*.

Accordingly, we sustain the Examiner’s rejection of: (1) independent claims 1, 14, and 27; and (2) dependent claims 2–5, 8–13, 15–18, and 21–26 under 35 U.S.C. § 112, first paragraph.

Claims 1–5, 8–18, and 21–27 rejected under 35 U.S.C. § 112, second paragraph

The Examiner concludes the metes and bounds of the present claims are unclear because a person having ordinary skill in the art at the time of the invention cannot define a “resource metric” and the Specification does not describe any meaningful structure/algorithm explaining the meaning of “resource metric.” Non-Final Act. 10–11; Ans. 6–7.

Appellants argue “quality of service” is an example of one or more resource metrics that support this limitation. App. Br. 8–9 (citing Spec. ¶¶ 5–6); Reply Br. 5. We disagree with Appellants.

As discussed *supra*, the Specification lacks sufficient description as to the definition of a “resource metric.” Because the does not describe how the “resource metrics” are determined or calculated, this term can take multiple contradictory meanings when read in the context of this Specification. We, therefore, conclude a person having ordinary skill in the art at the time of the invention cannot define a “resource metric.”

Accordingly, we sustain the Examiner’s rejection of: (1) independent claims 1, 14, and 27; and (2) dependent claims 2–5, 8–13, 15–18, and 21–26 under 35 U.S.C. § 112, second paragraph.

Claims 1–5, 8–18, and 21–27 rejected under 35 U.S.C. §§ 102(b) and 103(a)

The Examiner DeAngelis discloses auction engine 60 matches bidding parameters from content providers 25 with DDS parameters 31 from owners 20; the DDS parameters define DDS connection bandwidth, anticipated impression as a function of an event proximate the DDS, length of impression, etc., which the Examiner maps to the limitation:

compose one or more auction publisher parameters as auction selection criteria for a selection of a content delivery network provider from one or more delivery network providers, the auction selection criteria being based at least in part on one or more resource metrics for delivery of the content through a network, the one or more resource metrics being based on at least one of network traffic and content consumption patterns recited in claim 1 (and similarly recited in claims 14 and 27). Non-Final Act. 11 (citing DeAngelis ¶¶ 30, 36); Ans. 7–8. The Examiner also finds the limitation “for a selection of a content delivery network provider from one or more delivery network providers” recited in claims 1, 14, and 27 is intended use and carry little patentable weight. Non-Final Act. 4–5.

Appellants argue DeAngelis fails to disclose “for selection criteria for a selection of a content delivery network provider” because DeAngelis discloses auction engine 60 determines auction close time for each time slot based upon DDS parameters 31. App. Br. 9–11 (citing DeAngelis ¶¶ 30, 36); Reply Br. 5–6. We disagree with Appellants.

At the outset, we note that paragraphs 30 and 36 of DeAngelis, cited by the Examiner, pertain to Figure 1B of DeAngelis; Figure 1B pertains to paragraph 43. DeAngelis ¶¶ 30, 36, 43, Figs. 1B, 2. DeAngelis discloses using DDS parameters 31 to determine an auction winner. DeAngelis ¶ 43, Figs. 1B, 2.

The cited portions of DeAngelis disclose auction engine 60 matches bidding parameters from content providers 25 with DDS parameters 31 from owners 20 (i.e., one or more auction publisher parameters that are used for an eventual selection of a content delivery network provider via auction). Non-Final Act. 11 (citing DeAngelis ¶¶ 30, 36); Ans. 7–8. The cited portions of DeAngelis disclose DDS parameters 31 define DDS connection bandwidth, anticipated impression as a function of an event proximate the DDS (i.e., based on one or more resource metrics for delivery of the content through a network, the one or more resource metrics being based on at least content consumption patterns), length of impression (i.e., also a content consumption pattern), etc., which the Examiner maps to the limitation:

compose one or more auction publisher parameters as auction selection criteria for a selection of a content delivery network provider from one or more delivery network providers, the auction selection criteria being based at least in part on one or more resource metrics for delivery of the content through a network, the one or more resource metrics being based on at least one of network traffic and content consumption patterns

recited in claim 1 (and similarly recited in claims 14 and 27). Non-Final Act. 11 (citing DeAngelis ¶¶ 30, 36); Ans. 7–8.

Accordingly, we sustain the Examiner’s rejection of: (1) independent claims 1, 14, and 27; and (2) dependent claims 2–5, 8–13, 15–18, and 21–26 under 35 U.S.C. §§ 102(b) and 103(a).¹⁵

DECISION

We affirm the Examiner’s decision rejecting claims 1–5, 8–18, and 21–27 under 35 U.S.C. §§ 101, 102(b), and 103(a).

We affirm the Examiner’s decision rejecting claims 1–5, 8–18, and 21–27 under 35 U.S.C. § 112, first paragraph and second paragraph.

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

¹⁵ We disagree with the Examiner’s finding that the limitation “for a selection of a content delivery network provider from one or more delivery network providers” recited in claims 1, 14, and 27 is intended use and carries little patentable weight. Non-Final Act. 4–5. We disagree because the limitation “the bid being based upon the one or more auction publisher parameters” makes clear that the “selection of a content delivery network provider” has already occurred, and, therefore, is not intended use. Nonetheless, the intended-use issue is not dispositive of the rejections under 35 U.S.C. §§ 102(b) and 103(a) because DeAngelis anticipates claims 1, 14, and 27.