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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RODERICK A. HYDE, ROYCE A. LEVIEN,
RICHARD T. LORD, ROBERT W. LORD, MARK A. MALAMUD,
TONY S. PAN, and LOWELL L. WOOD JR.

Appeal 2017-010256
Application 13/905,839
Technology Center 2100

Before ST. JOHN COURTENAY III, LARRY J. HUME, and
JOYCE CRAIG, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1, 91, 96–101, 104, 105, 107, 108, 110, 124, 127, 128, 138, 139, 141, 146, 150, 152–155, 162–164, 166, 168–171, 173, 174, and 178–183, which are all the claims pending in this application. Claims 2–90, 92–95, 102, 103, 106, 109, 111–123, 125, 126, 129–137, 140, 142–145, 147–149, 151, 156–161, 165, 167, 172, and 175–177 are cancelled. We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We affirm.

¹ The real party in interest in this appeal is Elwha LLC. App. Br. 5.

STATEMENT OF THE CASE

Introduction

Appellants' invention is directed to "PRESENTING CONTENT AS A RESULT, AT LEAST IN PART, TO RELAYING OF A BID AND FOLLOWING LAPSE OF A SPECIFIC AMOUNT OF CONTENT ACCESS LATENCY." (Title).

Exemplary Claim

1. A computationally-implemented method, comprising:
presenting an interface for soliciting a bid for accessing a content following lapse of a specific amount of content access latency, the bid to be solicited including at least one user elected fee amount elected from a plurality of fee amounts available for election for the specific amount of content access latency, the user elected fee amount being an amount of fee being offered through the bid in exchange for accessing the content following lapse of the specific amount of content access latency;
relaying the bid in response, at least in part, to obtaining the bid as a result of the soliciting, the bid to be relayed indicating at least the user elected fee amount;
acquiring at least access to the content as a result, at least in part, of the relaying; and presenting at least the access to the content following lapse of the specific amount of content access latency.

*Rejections*²

R1. Claims 91 and 181 are provisionally rejected under the doctrine of non-statutory obviousness-type double patenting (OTDP) over claim 182 of co-pending U.S. Patent Application No. 13/906,633. (Final Act. 9).

² Instant Application No. 13/905,839 on appeal is a Continuation-In-Part (CIP), pre-America Invents Act (AIA) application, because it claims the benefit of the filing date of co-pending United States Patent Application No.

R2. Claims 182 and 183 are rejected under pre-AIA 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. (Final Act. 12).

R3. Claims 91, 96–101, 104, 105, 107, 108, 110, 124, 127, 128, 138, 139, 141, 146, 150, 152–155, 162–164, 166, 168–171, 173, 174, and 178–180 are rejected under pre-AIA 35 U.S.C. § 112, second paragraph, as being indefinite. (Final Act. 13).

R4. Claims 1, 91, 96–101, 104, 105, 107, 138, 139, 146, 150, 152, 162–164, 168–171, 173, 174, and 181–183 are rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over the combined teachings and suggestions of Dankberg et al., (US 2014/0164586 A1; published June 12, 2014) (“Dankberg”) and Lo et al., (US 2010/0037248 A1; published Feb. 11, 2010) (“Lo”). (Final Act. 17–18).

R5. Claims 108 and 110 are rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over the combined teachings and suggestions of Dankberg, Lo, and Bantz et al., (US 2007/0180061 A1, published Aug. 2, 2007) (“Bantz”). (Final Act. 33).

R6. Claims 124, 127, 128, 141, 166, and 178–80 are rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over the combination of Dankberg, Lo, and Mikurak, (US 2011/0251868 A1, published Oct. 13, 2011) (“Mikurak”). (Final Act. 35).

R7. Claims 153–155 are rejected under pre-AIA 35 U.S.C. § 103(a) as obvious over the combination of Dankberg, Lo, and Erisman. (US 2011/0078037 A1, published Mar. 31, 2011) (“Erisman”). (Final Act. 40).

13/795,612, filed on March 12, 2013, this date being *before* the first-inventor-to-file AIA effective date of March 16, 2013. *See* Spec. 2, ¶ 1.

Grouping of Claims

Based on Appellants' arguments in the Appeal Brief, we decide the appeal of rejection R4 of independent claims 1, 91, and 181 based on representative independent claim 1. We decide the appeal of dependent claims 96–101, 104, 105, 107, 138, 139, 146, 150, 152, 162–164, 168–171, 173, 174, 182, and 183, also rejected under rejection R4 and not separately argued, upon representative claim 1. To the extent Appellants have not advanced separate, substantive arguments for any claims on appeal, such arguments are considered waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

ANALYSIS

In reaching this decision, we consider all the evidence presented and all arguments actually made by Appellants. We find Appellants' arguments unpersuasive for the reasons discussed *infra*. We adopt as our own: (1) the findings and legal conclusions set forth by the Examiner in the Final Office Action (2–42) from which this appeal is taken, and (2) the findings, legal conclusions, and explanations set forth in the Answer (3–6), in response to Appellants' arguments in the Appeal Brief (8–52). We highlight and address specific findings and arguments for emphasis in our analysis below.

Double Patenting Rejection R1 of Independent Claims 91 and 181

The Examiner indicates the non-statutory obviousness-type double patenting (OTDP) rejection R1 of claims 91 and 181 will be held in abeyance until allowable subject matter is found in either the present or co-pending applications. (Final Act. 9).

However, holding a rejection in *abeyance* is not equivalent to *withdrawing* the rejection. Pursuant to 37 C.F.R. § 41.39(a)(1), this

rejection is before the Board on appeal because the Examiner has not expressly withdrawn it. At the time of this Decision, co-pending Application No. 13/906,633 has not issued or been abandoned, therefore the OTDP rejection is still provisional.

Accordingly, we *pro forma* sustain provisional OTDP rejection R1 of claims 91 and 181, because the Examiner has not expressly withdrawn this rejection, and Appellants have not traversed the rejection. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

*Rejection R2 of Claims 182 and 183 under
35 U.S.C. § 112, first paragraph, enablement requirement*

The Examiner sets forth the basis for the rejection, as follows:

Claims 182 and 183 recite “the specific amount of content access latency does not exceed 0.00003 seconds” and “the specific amount of content access latency is in a range between 0.000025 and 0.000060 seconds” respectively. However, the Applicant’s [S]pecification is silent in regards to how the claimed invention is able to accurately control the latency in delivering content down to the microseconds level. It is not a common knowledge on how to guarantee the delivery latency in the microseconds level. Thus, the [S]pecification does not provide enough disclosure to enable one of ordinary skill in the art to make and use the claimed invention.

(Final Act. 12–13).

Appellants contend: “Claims 182 and 183 specifically recite ‘content access latency,’ and as it is *well known* in the art of computing that content access may have latency in the microseconds, one of ordinary skill in the art

would have been enabled to make and use the claimed invention.” (App. Br. 9) (emphasis added).³

The “enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation.” *AK Steel Corp. v. Sollac and Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003) (citation omitted). Although a “specification need not disclose what is well known in the art,” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984), this “is merely a rule of supplementation, not a substitute for a basic enabling disclosure.” *Genentech, Inc. v. Novo Nordisk, A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997). It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. *Id.* However, it is the specification, *not the knowledge of one skilled in the art* that must supply the novel aspects of an invention in order to constitute adequate enablement. *Id.*

Applying this reasoning here, we note Appellants’ argument regarding what is purportedly *well-known in the art* is not supported with any evidence of record. As such, it is mere attorney argument and is not persuasive.⁴ We,

³ We note Appellants’ 66-page Appeal Brief (including the Claims Appendix) is not page-numbered. This omission necessitated manual numbering of the pages of the Appeal Brief by the panel, as required to reference it, which is an unreasonable burden upon the Board. *We urge Appellants to include page numbers in all future correspondence with the USPTO and PTAB.*

⁴ It is well settled that mere attorney arguments and conclusory statements, which are unsupported by factual evidence, are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (attorney argument is not

therefore, sustain the Examiner's rejection R2 of claims 182 and 183 under 35 U.S.C. § 112, first paragraph.

Rejection R3 of Claims 91, 96–101, 104, 105, 107, 108, 110, 124, 127, 128, 138, 139, 141, 146, 150, 152–155, 162–164, 166, 168–171, 173, 174, and 178–180 under 35 U.S.C. [§] 112, second paragraph, indefiniteness

Appellants' contend:

Appellant[s] additionally note[] that the USPTO has rejected Claims 91, 96–101, 104, 105, 107, 108, 110, 124, 127, 128, 138, 139, 141, 146, 150, 152–155, 162–164, 166, 168–171, 173, 174, and 178–180 under 35 U.S.C. §[]112(b) and objected to an alleged informality in claim 152. Final Office Action, pp. 13-17 and p. 9 (16 June 2016). **Appellant[s] do[] not appeal these rejections and this objection at this time, however, Appellant[s] reserve[] the right to appeal these rejections and this objection at a later date.**

(App. Br. 8 (emphasis added)).

Pursuant to 37 C.F.R. § 41.31(c), an appeal is presumed to be taken from the rejection(s) of all claims under rejection, unless cancelled by an amendment that is entered by the Examiner. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). *See also Hyatt v. Dudas*, 551 F.3d 1307, 1313–14 (Fed. Cir. 2008) (the Board may treat arguments Appellants failed to make for a given ground of rejection as waived).

Accordingly, we sustain the Examiner's rejection R3 under § 112, second paragraph, (indefiniteness), of claims 91, 96–101, 104, 105, 107,

evidence). *See also* Manual of Patent Examining Procedure (MPEP) § 2145 (9th ed. Nov. 2015) (“Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection.”).

108, 110, 124, 127, 128, 138, 139, 141, 146, 150, 152–155, 162–164, 166, 168–171, 173, 174, and 178–180, because Appellants fail to traverse this rejection.

Rejection R4 of Claims 1, 91, 96–101, 104, 105, 107, 138, 139, 146, 150, 152, 162–164, 168–171, 173, 174, and 181–183 under 35 U.S.C. § 103(a)

Based upon Appellants’ arguments (App. Br. 39–47), we decide the appeal of all claims rejected under rejection R4 on the basis of representative claim 1. Appellants contest all of the limitations of representative independent claim 1 in its entirety. (App. Br. 40–41).

Appellants additionally contend, *inter alia*:

[T]he Examiner misapplied Dankberg in stating “Dankberg disclosed a graphical user interface prompting user to select a media content cost and delivery timeframe (pg. 1, [0005]), where media content can be delivered at an earlier timeframe at a specific cost or a later timeframe at a lower cost (pg. 1, [0004]” which **teaches away** from [] “an interface for soliciting a bid” as claimed.”

(App. Br. 43) (emphasis added).

Our reviewing court guides that a prior art reference does not teach away from the claimed subject matter unless the prior art reference criticizes, discredits, or otherwise discourages the solution claimed. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004); *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (“A reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed”) (citing *Fulton*).

Applying this reasoning here, we find Appellants’ “teaching away” argument unpersuasive, because Appellants do not point to an express disavowal in Dankberg of an interface for soliciting a bid.

Appellants further contend:

“[A]n interface for soliciting a bid for accessing a content” as claimed is not equivalent to “content objects is offered in association with a media plan” or “a data allowance policy (DAP)”. Lo fails to correct the deficiencies of Dankberg. Specifically, “soliciting a bid from a user” as claimed is not taught by a system with SUBSCRIBERS as in Dankberg, which is required for a “data allowance policy” for such subscribers. Lo does not make up for this teaching away from Appellants claims.

(App. Br. 44).

The Examiner finds the combination of Dankberg and Lo teach or at least suggest the disputed limitations. (Ans. 3–4). The Examiner notes “[t]he claim does not explicitly disclose how a bid is solicited.” (Ans. 3). Applying a broad but reasonable interpretation,⁵ the Examiner finds “soliciting a bid” (claim 1) from a user is taught or suggested by Dankberg’s description of *prompting a user* through a graphical user interface (Ans. 3–

⁵ We give the claims their broadest reasonable interpretation consistent with the Specification. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). Although 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). Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (internal citation omitted).

4), when combined with Lo’s auction, which asks users to submit bids in order to access certain content. (Ans. 4).⁶

We find Appellants are attacking Dankberg in isolation. We emphasize the Examiner’s rejection relies upon the *combination* of Dankberg and Lo for teaching or suggesting the disputed limitations. (Final Act. 19).⁷

Further, Appellants do not provide evidence sufficient to demonstrate that combining the teachings of the cited references, in the manner proffered by the Examiner (Final Act. 19), would have been “uniquely challenging or difficult for one of ordinary skill in the art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citation omitted).

Appellants additionally argue Lo doesn’t teach “content access latency.” (App. Br. 47).

We are not persuaded by Appellants’ argument because the Examiner cites to Dankberg, not Lo, for teaching this disputed limitation. (Ans. 4–5).

We note Appellants have not filed a Reply Brief to rebut the Examiner’s responsive explanations and findings in the Answer (3–6).

⁶ Our reviewing court guides: “the question under 35 USC 103 is not merely what the references expressly teach but what they would have *suggested* to one of ordinary skill in the art at the time the invention was made.” *Merck & Co. Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989) (quoting *In re Lamberti*, 545 F.2d 747, 750 (CCPA 1976)). (emphasis added); *see also* MPEP § 2123.

⁷ *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.).

Accordingly, on this record, and based upon a preponderance of the evidence, we are not persuaded the Examiner erred in combining the cited references, or regarding the legal conclusion of obviousness. We, therefore, sustain the Examiner's rejection R4 of representative independent claim 1, and independent claims 91 and 181, and dependent claims 96–101, 104, 105, 107, 138, 139, 146, 150, 152, 162–164, 168–171, 173, 174, 182, and 183, which fall with claim 1. *See supra* Section, Grouping of Claims.

We also sustain Rejection R5 of claims 108 and 110, Rejection R6 of claims 124, 127, 128, 141, 166, and 178–180, and Rejection R7 of claims 153–155, all rejected under § 103(a), as Appellants have not advanced separate, substantive arguments for these rejected claims. Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

CONCLUSIONS ⁸

The Examiner did not err in provisionally rejecting claims 91 and 181 on the ground of non-statutory obviousness-type double patenting.

⁸ In the event of further prosecution, we leave it to the Examiner to consider whether all claims on appeal should be rejected under 35 U.S.C. § 101, to the extent these claims could be performed as mental steps by a human, albeit with the aid of pen and paper. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) (“That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*”). “[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.” *CyberSource*, 654 F.3d at 1373. Moreover, “the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention.” *See Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2358 (2014). Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) § 1213.02.

The Examiner did not err in rejecting claims 182 and 183 under 35 U.S.C. § 112, first paragraph, for failing to comply with the enablement requirement.

The Examiner did not err in rejecting claims 91, 96–101, 104, 105, 107, 108, 110, 124, 127, 128, 138, 139, 141, 146, 150, 152–155, 162–164, 166, 168–171, 173, 174, and 178–180, under 35 U.S.C. § 112, second paragraph, for indefiniteness.

The Examiner did not err in rejecting claims 1, 91, 96–101, 104, 105, 107, 108, 110, 124, 127, 128, 138, 139, 141, 146, 150, 152–155, 162–164, 166, 168–171, 173, 174, and 178–183, under pre-AIA 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner’s decision rejecting claims 1, 91, 96–101, 104, 105, 107, 108, 110, 124, 127, 128, 138, 139, 141, 146, 150, 152–155, 162–164, 166, 168–171, 173, 174, and 178–183.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED