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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JAN SENDEREK, DANIEL TOBIAS WAGNER, and  
LEONARD FINK

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Appeal 2018-001127  
Application 14/481,783  
Technology Center 2400

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Before MICHAEL J. STRAUSS, JOSEPH P. LENTIVECH, and  
MICHAEL J. ENGLE, *Administrative Patent Judges*.

LENTIVECH, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellants appeal from the Examiner's decision to reject claims 1–3, 5, 6, and 8–22. Claims 4 and 7 have been canceled. *See* App. Br. 29 (Claims App'x). We have jurisdiction over the pending claims under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

*Appellants' Invention*

Appellants' invention generally relates to “managing edits to one or more content items.” Spec. ¶ 2. Claim 1, which is illustrative of the claimed invention, reads as follows:

1. A method comprising:

generating, by at least one processor at a server device, a plurality of reduced resolution content items corresponding to a content item, the plurality of reduced resolution content items comprising multiple content items having different resolutions based on display specifications of a plurality of client devices associated with a user account;

providing, to a first client device of the plurality of client devices, the plurality of reduced resolution content items for storage on the first client device;

maintaining, at the server device, the plurality of reduced resolution content items on a user account associated with the plurality of client devices;

receiving, from the first client device, an edit applied to a first reduced resolution content item from the plurality of reduced resolution content items stored on the client device; and

applying the edit to the plurality of reduced resolution content items maintained at the server device.

*Rejections*

Claims 1–3, 5, 6, and 8–22 stand rejected under 35 U.S.C. § 101 because the claimed subject matter is judicially-excepted from patent eligibility under § 101. Final Act. 5–7.

Claims 1–3, 5, 6, and 8–22 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Erlichson et al.

(US 2009/0100096 A1; published Apr. 16, 2009) (“Erlichson”) and Gottlieb (US 2014/0229866 A1; published Aug. 14, 2014). Final Act. 8–18.

## ANALYSIS

### *Rejection under 35 U.S.C. § 101*

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). 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, 82–84 (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 in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* The inquiry often is whether the claims are directed to “a specific means or method” for improving technology or whether they are simply directed to an abstract end-result. *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016). If the claims are not directed to a patent-ineligible concept, 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 the additional

elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78–79). We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

The Examiner determines the claims are directed to the abstract idea of “using categories to organize, store and transmit information, ‘An Idea Of Itself.’” Final Act. 5 (citing *Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 F. App’x 988 (Fed. Cir. 2014)); *see also* Ans. 12–15 (additionally citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016)). The Examiner further determines that the additional elements recited in the claims are not sufficient to amount to significantly more than the abstract idea. Final Act. 6–7; Ans. 15–16. We disagree.

“The Supreme Court has recognized that all inventions . . . embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas. But not all claims are *directed to* an abstract idea.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241 (Fed. Cir. 2016) (citation and quotation marks omitted). We disagree with the Examiner that the independent claims are directed to the types of abstract ideas in *Cyberfone* (i.e., using categories to organize, store, and transmit information) and *Electric Power Group* (i.e., displaying results from collected and analyzed information). *See* Final Act. 5; Ans. 12–15. We agree with Appellants that the Examiner “has erroneously described the claims at a high level of abstraction using language untethered from the language of the claims” and

that “‘using categories to organize, store, and transmit information,’ is in no way an accurate characterization of the subject matter of the claims.” App. Br. 21, 22; *see also* Reply Br. 7. As noted by the Examiner, the independent claims recite limitations “for providing access and applying [an] edit to reduced resolution content items.” Final Act. 5. The Examiner does not explain how *Cyberfone* and *Electric Power Group* support the proposition that a claim that recites limitations directed to providing a plurality of reduced resolution content items to a client device and applying an edit, received from the client device, to the plurality of reduced resolution content items is directed to the abstract idea of “using categories to organize, store, and transmit information.” In other words, the Examiner’s determination is too high of a level of abstraction that is untethered from the specific language of the claims. *See Enfish*, 822 F.3d at 1337.

Further, we agree with Appellants that the Examiner improperly concludes “that the claims are directed to an abstract idea based on a selective analysis of individual limitations” and “fails to consider the claims as a whole and in light of the specification as required under *Alice* step one.” App. Br. 22. In this regard, the Specification explains that “accessing and editing content items suffers from a number of limitations and drawbacks.” Spec. ¶ 5. For example, “computing devices often have space limitations that limit the number of content items that may be stored and/or maintained” and “[l]imited space often diminishes the performance of the computing device.” Spec. ¶ 5. The Specification further explains that remote storage of content items often reduces accessibility to content items because the user may not have access to a network for accessing the content items and “due

to limited bandwidth or the size of a content item, a user may spend a substantial amount of time retrieving a particular content item.” Spec. ¶ 7.

To address these limitations and drawbacks, independent claim 1, for example, recites:

generating, by at least one processor at a server device, a plurality of reduced resolution content items corresponding to a content item, the plurality of reduced resolution content items comprising multiple content items having different resolutions based on display specifications of a plurality of client devices associated with a user account;

providing, to a first client device of the plurality of client devices, the plurality of reduced resolution content items for storage on the first client device;

maintaining, at the server device, the plurality of reduced resolution content items on a user account associated with the plurality of client devices;

receiving, from the first client device, an edit applied to a first reduced resolution content item from the plurality of reduced resolution content items stored on the client device; and

applying the edit to the plurality of reduced resolution content items maintained at the server device.

Claim 1.<sup>1</sup> The Specification explains that the claimed method has the advantages of allowing a user to “edit a reduced resolution content item on a local client device without [using] as many resources as would be required when editing an original content item.” Spec. ¶ 22. As noted by Appellants:

the claim limitations constitute an “ordered combination” of steps, that, when performed in combination, provide a non-

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<sup>1</sup> Similarly, independent claims 16 and 20 recite a system and a non-transitory computer readable medium, respectively, of commensurate scope in the aspects of their recitations relevant to our § 101 analysis.

conventional and previously unknown improvement upon an existing technological process that notably improves a process for providing access to content items and edits to the content items across multiple devices.

App. Br. 20.

Because we determine the claims are not directed to an abstract idea, we do not need to proceed to the second step of the analysis. *See Enfish*, 822 F.3d at 1339 (citing *Alice*, 134 S. Ct. at 2355).

Accordingly, we do not sustain the Examiner's rejection of claims 1–3, 5, 6, and 8–22 under 35 U.S.C. § 101.

*Rejections under 35 U.S.C. § 103(a)*

Appellants contend the combination of Erlichson and Gottlieb fails to teach or suggest

generating, by at least one processor at a server device, a plurality of reduced resolution content items . . . comprising multiple content items having different resolutions based on display specifications of a plurality of client devices associated with a user account; [and]

providing, to a first client device of the plurality of client devices, the plurality of reduced resolution content items for storage on the first client device,

as recited in claim 1, and similarly recited in independent claims 16 and 20.

App. Br. 13–14. Appellants argue the cited references fail to teach or suggest the disputed limitations because neither Erlichson nor Gottlieb teaches or suggests providing a plurality of reduced resolution content items to a first client device, as required by claims 1, 16, and 20. App. Br. 13–15; Reply Br. 3–4. We agree.



The Examiner finds Erlichson teaches “applying transformation at the server to create transformed version and down-sample the transformed or received version” and, therefore, teaches “generating, by at least one processor at a server device, a plurality of reduced resolution content items corresponding to a content item.” Ans. 5 (citing Erlichson Fig. 13; ¶ 104). The Examiner finds Erlichson further teaches “transmitting communication regarding version number of the server or client and transmitting [a] current version (reduced resolution content item) to the client” and therefore, teaches “providing, to a first client device of the plurality of client devices, the plurality of reduced resolution content items for storage on the first client device.” Ans. 6 (citing Erlichson Fig. 13; ¶ 104). As such, the Examiner relies upon Erlichson’s transformed version and down-sampled version for teaching or suggesting the claimed plurality of reduced resolution content items. However, Erlichson does not teach that the transformed version *and* the down-sampled version are provided to the client. Instead, Erlichson teaches “the server’s most recent version of a website, collection, album, and/or image can be transmitted to the client and/or to every client.” Erlichson ¶ 104. Erlichson, therefore, teaches providing a single reduced resolution content item to the client, not a plurality of reduced resolution content items.

Accordingly, we do not sustain the Examiner’s rejection under 35 U.S.C. § 103 of independent claims 1, 16, and 20; and claims 2, 3, 5, 6, 8–15, 17–19, 21, and 22, which depend therefrom.

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DECISION

We reverse the Examiner's rejection of claims 1–3, 5, 6, and 8–22 under 35 U.S.C. § 101.

We reverse the Examiner's rejection of claims 1–3, 5, 6, and 8–22 under 35 U.S.C. § 103.

REVERSED