



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/315,105	12/08/2011	Philip Marcella	26141.0011U1	7003
16000	7590	08/23/2018	EXAMINER	
Comcast c/o Ballard Spahr LLP 999 Peachtree Street, Suite 1000 Atlanta, GA 30309			ENGLAND, SARA M	
			ART UNIT	PAPER NUMBER
			2172	
			NOTIFICATION DATE	DELIVERY MODE
			08/23/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USpatentmail@ballardspahr.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PHILIP MARCELLA, CHRISTOPHER MCKENNA,
and JOHN RIVIELLO

Appeal 2018-001166¹
Application 13/315,105
Technology Center 2100

Before ERIC B. CHEN, ADAM J. PYONIN, and PHILLIP A. BENNETT,
Administrative Patent Judges.

PYONIN, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 2, 4–10, 12, 14, 16, 17, 19, and 24–26, which are all of the pending claims.

We AFFIRM.

¹ Comcast Cable Communications, LLC is identified as the real party in interest. App. Br. 1.

STATEMENT OF THE CASE

Introduction

The Application is directed to “distinguish[ing] a classification of user in order to deliver a unique experience for each class of user without utilizing conventional ‘cookies.’” Spec. ¶ 2. Claims 1, 9, and 16 are independent. Claim 1 is reproduced below for reference:

1. A method comprising:
 - providing, by a computing device, an address element and a class identifier;
 - receiving, by the computing device, a request for a file, wherein the request comprises the address element and the class identifier, wherein the class identifier comprises a time element, and wherein the time element represents a date that the class identifier was initially provisioned;
 - comparing, by the computing device, the class identifier to a comparator element comprising a time period;
 - providing, by the computing device, a first file if the time element is within the time period; and
 - providing, by the computing device, a second file if the time element is outside the time period, wherein the first file is different from the second file.

References and Rejections

Claims 1, 2, 4–10, 12, 14, 16, 17, 19, and 24–26 stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception to patent eligibility. Final Act. 2.

Claims 1, 2, 4–10, 12, 14, 16, 17, 19, and 24–26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gordon (US 2004/0181490 A1; Sept. 16, 2004) and Steele (US 7,016,875 B1; Mar. 21, 2006). Final Act. 3.

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments. We have considered in this Decision only those arguments Appellants actually raised in the Briefs. Any other arguments Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv) (2012).

A. Patent Eligibility

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The statute, however, includes an implicit exception: laws 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 Labs., Inc.*, 566 U.S. 66, 82–83 (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,” e.g., to an abstract idea. *Id.* If the claims are directed to a patent-ineligible concept, 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.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

The Examiner finds the claims are patent ineligible under 35 U.S.C. § 101. *See* Ans. 10–11. Specifically, the Examiner’s analysis (quotations omitted) is the following:

In regards to 101, the examiner noted an abstract idea comparing new and stored information and using rules to identify options. For clarification, The examiner notes the “comparing by the computing device the class identifier to a comparator element comprising a time period” constitutes comparing new and stored information (Classen). The “providing by the computing device a first file if the class identifier is within the comparator element and providing by the computing device a second file if the class identifier is outside the comparator element, wherein the first file is different from the second file.” Constitutes rules that identify options (SmartGene). The first two steps of the claim providing ... and receiving ... could be construed as collecting known and stored information (Classen). Even if they were not construed that way, they do not provide anything constituting “significantly more”.

Furthermore, the decision from FairWarning illustrates how a process that has been done for decades incorporating a computer does not improve the existing technological process.

Id.; *see also* Final Act. 10–11.

Appellants argue the Examiner’s rejection “mischaracterizes the claims and ignores the functional limitations of the claims” (Reply Br. 2) and “[s]uch reasoning . . . is not sufficient to establish a *prima facie* rejection under section 101” (App. Br. 9). Appellants further contend the claimed steps “provide improvement over conventional approaches by providing more efficient data retrieval from a content host,” and “it cannot be said that this functionality is a ‘well-known business practice[]’ to which ‘conventional computer components’ were applied.” App. Br. 11.

We are persuaded by Appellants’ arguments. “The second step of the *Alice* test is satisfied when the claim limitations involve more than

performance of well-understood, routine, [and] conventional activities previously known to the industry,” and “[w]hether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1367, 1369 (Fed. Cir. 2018) (quotations omitted). On this record, we do not sustain the Examiner’s determination that the claims are directed to patent ineligible subject matter. Even if we were to agree with the Examiner that the claims are directed to an abstract idea, we cannot sustain the rejection because the Examiner provides no support for the conclusion that the “claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception because there are no elements that constitute more than general purpose hardware.” Final Act. 2.

Accordingly, we do not sustain the Examiner’s 35 U.S.C. § 101 rejection of claim 1, or the remaining claims which are rejected under the same reasoning.

B. Obviousness

Appellants argue the Examiner fails to demonstrate claim 1 is obvious over Gordon and Steele. App. Br. 4. We are not persuaded the Examiner errs, however. We adopt the Examiner’s findings and conclusions with respect to the obviousness rejection as our own, and we add the following primarily for emphasis.

i. Every Element

Appellants argue the “combined references fail to disclose every element of claim 1.” Reply Br. 3 (emphasis omitted). Appellants contend

Gordon does not teach the recited “class identifier,” because Gordon’s request count is a value calculated by a host system, and is neither “provided” nor “received [in a] request [comprising] the address element and the class identifier (request count).” App. Br. 13. Appellants further argue Steele provides only a “mere mention of [a] date comparison,” and thus “a mere combination of the two references would not necessarily show or suggest using a time element and a time period as a basis of comparison for determining which file is to be sent to a requesting client.” App. Br. 15.

We are not persuaded the Examiner errs in finding the limitations of claim 1 “would have been obvious to one of ordinary skill in the art, having the teachings of Gordon and Steele before [them] at the time the invention was made.” *See* Final Act. 4–5; *see also In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“The test for obviousness is not . . . that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”).

Here, the Examiner finds, and Appellants do not challenge, that “the claims do not define a secondary device or host system, only mere mention of ‘a computing device’” and “[t]he Computing device provides this information, although, it is not clear to whom it is provided to, or whether it is internally provided within the system.” Ans. 14. Thus, we agree with the Examiner that “[i]f the Host system of Gordon is interpreted as the computing device, it provides the address element and class id, it receives a request for a file with a URL as the address element and a Username as the Class ID.” *Id.*; *see also* Gordon Fig. 3. Gordon teaches a “URL (address element) and a username associated with a Request count for that particular

username (a class identifier),” and a “count for particular username is compared.” Ans. 12 (citing Gordon ¶¶ 15, 28). We agree, and note Gordon further teaches these techniques are used for controlling access to files, and such control may “allows a content owner to keep control of the number of times content decryption may occur, the time period during which content decryption is available.” Gordon ¶ 3; *see also* Final Act. 4.

Steele, as relied on by the Examiner, teaches “partial access to content, where when the time expires for the period of validity, the content may no longer be available in the way it was before.” Ans. 13; Steele 9:58–67 (“the term ‘ticket’ refers to a temporary authorization—for at least partial access to a consumer’s information account . . . [correlated with] any period of validity associated with the ticket”). Steele’s ticket can include the “time and date,” and may be used in a web page request “including the ticket as a parameter in the URL.” Steele 10:10–23. We find the references teach or suggest the claim limitations, as understood by an artisan of ordinary skill in light of the Specification. *See* Final Act. 11–12; *see also* Spec. ¶ 48 (“when the address element **110** is typed into a web address bar of the web browser **106** of a particular user device **102**, the class identifier **112** for the particular user device **102** is automatically appended to the address element **110** in order to return a particular file.”).²

² Separately, we note claim 1 is a method claim that contains conditional limitations: the providing steps are conditional based on the comparison step results. *See Ex parte Schulhauser*, No. 2013-007847, 2016 WL 6277792, at *4 (PTAB Apr. 28, 2016) (precedential) (discussing construction of conditional limitations in method claims).

ii. Motivation to Combine

Appellants argue “the motivation relied upon by the Office Action is not rationally supported.” Reply Br. 4. Appellants contend the “user-defined permissions captured by the ‘ticket’ in *Steele* would necessarily change the fundamental operation of *Gordon* as it would circumvent the ‘username/password’ accessibility model of *Gordon* by granting access to data to services having access to a ticket.” App. Br. 16. Further, Appellants contend the Examiner’s reasoning, such as “‘to obtain a time based identifier to determine which file to deliver to the user[,]’ is insufficient rationale to support a *prima facie* case of obviousness as it is a mere restatement of the claim elements at issue.” App. Br. 17.

We are not persuaded the Examiner errs. We agree with the Examiner that, rather than changing the fundamental operation of the references, “*Steele* and *Gordon* can be combined” as claimed. Ans. 15. The Examiner finds one of ordinary skill would be motivated to “track user access and regulate usage as a commonly preferred method, even suggested by *Gordon* (Par. 3), also suggesting motivation for generating this current time stamp in order to assess the current settings as known in the prior art to be a real time representation of media rights settings.” Ans. 16; *see also* *Gordon* ¶ 7 (describing various paradigms for authentication may be used); *Steele* 10:8–9 (describing the use of standard authentication techniques). We find the Examiner’s analysis to be reasonable and sufficient to support the determination of obviousness. From the record before us, we do not find that combining the prior art was “uniquely challenging or difficult for one of ordinary skill in the art” or “represented an unobvious step over the prior

art.” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

Accordingly, we are not persuaded the Examiner errs in finding the cited references teach or suggest the limitations of claim 1. We sustain the Examiner’s obviousness rejection of claim 1, and claims 2, 4–10, 12, 14, 16, 17, 19, and 24–26, which are not separately argued. *See* App. Br. 18.

DECISION

The Examiner’s decision rejecting claims 1, 2, 4–10, 12, 14, 16, 17, 19, and 24–26 under 35 U.S.C. § 101 is reversed.

The Examiner’s decision rejecting claims 1, 2, 4–10, 12, 14, 16, 17, 19, and 24–26 under 35 U.S.C. § 103(a) is affirmed.

Because we have affirmed at least ground of rejection for each claim on appeal, we affirm the Examiner’s decision to reject claims 1, 2, 4–10, 12, 14, 16, 17, 19, and 24–26. 37 C.F.R. § 41.50(a)(1).

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