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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DAVID STEIN

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Appeal 2018-001388  
Application 13/475,823  
Technology Center 3600

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Before CYNTHIA L. MURPHY, BRADLEY B. BAYAT, and  
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), the Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 19, 24, and 25. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> We use "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as "Dubset Media Holdings, Inc." (Appeal Br. 3.)

## BACKGROUND

The Appellant’s invention relates to “digital rights management” of media contents “having mixed, overlapping music tracks from distinct copyright owners.” (Spec.¶ 2.) An example of such a media content is a “DJ mix” that is “a sequence of musical tracks typically mixed together to appear as one continuous track.” (*Id.* ¶ 4.) If “there are multiple copyright owners of the different tracks or samples contained in the mix,” it must be determined “who the copyright owners are” in order for the DJ mix to be distributed in a manner “compliant with the applicable copyright laws and standards.” (*Id.* ¶ 5.)

“[F]ingerprinting” tools can be used to “generate a unique fingerprint for an audio snippet and return song information from their database which matches the fingerprint.” (Spec. ¶ 21.) In other words, fingerprinting tools can be used to produce “accurate song breakdown[s]” in media contents containing multiple song samples. (*Id.* ¶ 9.) This correct “breakdown” of samples (which each correlates to the breakdown of copyright ownership information) allows accurate monitoring and reporting to “the necessary digital music rights organizations.” (*Id.* ¶ 8.)

However, available fingerprinting tools “are not particularly suited to deal with a compilation such as a DJ mix” because “the blending of different distinct copyrighted works” can “confuse” fingerprinting “tool[s].” (Spec. ¶ 4.) In other words, with a DJ mix, the song samples are often “blended together in a manner” that renders them “unrecognizable” to a fingerprinting tools. (Appeal Br. 9.) As such, fingerprinting tools, alone, might not produce an accurate breakdown of song samples, which is necessary for an accurate breakdown of copyright ownership information.

The Appellant solves this problem by first “parsing” the DJ mix into a format that is recognizable to fingerprinting tools (e.g., a fingerprinting analytical algorithm), and thereafter analyzing this “parsed” media content using fingerprinting tools. (Appeal Br. 3–4.)

#### SOLE INDEPENDENT CLAIM ON APPEAL

19. A computer-implemented method of determining a breakdown and usage of samples of copyrighted music in a media content file containing a mixture of overlapping samples of copyrighted music, comprising:

[(a)] receiving by a controller a media content file containing the mixture of samples of copyrighted music, at least two or more of the samples being overlapping;

[(b)] parsing by the controller the media content file into a format recognizable by a fingerprinting analytical algorithm;

[(c)] analyzing the parsed media content file by a fingerprinting server using the fingerprinting analytical algorithm to determine a breakdown of the copyright ownership information of the samples in the parsed media content file;

[(d)] defining and storing a tracklist including the determined breakdown of the samples in a database;

[(e)] monitoring and reporting by a client reporting service in a player playing of each of the samples of the copyrighted music in the media content file by the player; and reporting by the controller to a system operated by a copyright licensing entity the copyright ownership information associated with the samples of the copyrighted music in the media content file played by the player.

#### REJECTIONS

I. The Examiner rejects claims 19, 24, and 25 under 35 U.S.C. § 101 as directed to a judicial exception without significantly more. (Final Action 6.)

II. The Examiner rejects claims 19 and 24 under 35 U.S.C. § 103(a) as unpatentable over Pitman,<sup>2</sup> Teegarden,<sup>3</sup> and Rabin.<sup>4</sup> (Final Action 12.)

III. The Examiner rejects claim 25 under 35 U.S.C. § 103(a) as unpatentable over Pitman, Teegarden, Rabin, and Carlson.<sup>5</sup> (Final Action 14.)

IV. The Examiner rejects claims 19, 24, and 25 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. (Final Action 10.)

V. The Examiner rejects claims 19, 24, and 25 under 35 U.S.C. § 112, second paragraph, as indefinite. (Final Action 11.)

#### ANALYSIS

Independent claim 19 sets forth a computer-implemented method of “determining a breakdown and usage of samples of copyright music in a media content file containing a mixture of overlapping samples of copyrighted music.” (Appeal Br., Claims App.) The rest of the claims on appeal (i.e., claims 24 and 25) depend directly from independent claim 19. (*See id.*)

#### *Rejection I—35 U.S.C. § 101*

The Examiner concludes that the claims on appeal do not pass the *Alice* test for patent eligibility. (*See* Final Action 6.) In *Alice Corp. v. CLS*

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<sup>2</sup> US 7,085,613 B2, issued August 1, 2006.

<sup>3</sup> US 2008/0114665 A1, published May 15, 2008.

<sup>4</sup> US 6,697,948 B1, issued February 24, 2004.

<sup>5</sup> US 2011/0015968 A1, published January 20, 2011.

*Bank Int’l*, 573 U.S. 208 (2014), the Supreme Court provided a two-step test to guard against an attempt to patent purely an abstract idea. (*Alice*, 573 U.S. at 217–18.) In *Alice* step one, a determination is made as to whether the claim at issue is “directed to” an abstract idea. (*Id.* at 218.) If not, it can be concluded that no attempt is being made to patent purely an abstract idea, and the *Alice* test is complete.<sup>6</sup>

Here, the Examiner determines that the claims on appeal satisfy step one of the *Alice* test for patent eligibility because they are “directed to” an abstract idea. (*See* Final Action 6). The Appellant argues that this determination is not sufficiently supported by the record. (*See* Appeal Br. 4–13.) We are persuaded by the Appellant’s position.

The 2019 Revised Patent Subject Matter Eligibility Guidance (“2019 Guidance”) sets forth a two-prong step (Step 2A) for determining whether a claim is “directed to” an abstract idea under the first step of the *Alice* test. (*See* Federal Register Vol. 84, No. 4, 50–57.)

In the first prong of Step 2A (Prong One), it must be established that the claim recites a judicial exception such as an “abstract idea.” (2019 Guidance, Federal Register Vol. 84, No. 4, 54.) In accordance with judicial precedent, the 2019 Guidance synthesizes abstract-idea subject matter into three groupings: “[m]ental processes,” “[m]athematical concepts,” and “[c]ertain methods of organizing human activity.” (*Id.* at 52.) If a claim does not contain limitations reciting a concept that falls within one of these

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<sup>6</sup> If the claim at issue is “directed to” an abstract idea, the second step of the *Alice* test must be performed. (*Alice*, 573 U.S. at 218.) In the second step of the *Alice* Test, attention is given to whether additional elements in the claim are “well-understood,” “routine,” or “conventional.” (*Id.* at 225.)

identified groupings, this is redolent of the claim not being “directed to” an abstract idea. (*Id.* at 54).

But even if a claim does contain limitations reciting an identified abstract idea, this, alone, is not sufficient to establish that the claim is “directed to” this abstract idea so as to satisfy *Alice* step one.<sup>7</sup> Rather, under the second prong of Step 2A (Prong Two) it must also be established that the claim does not contain additional elements (i.e., “claim features, limitations, and/or steps that are recited in the claim beyond the identified judicial exception”) that “integrate” the abstract idea “into a practical application.” (2019 Guidance, Federal Register Vol. 84, No. 4, 54, 55, n. 24.)

Insofar as the Examiner is saying that the claims on appeal recite an abstract idea, we agree. (*See e.g.*, Answer 12–13.)

Step (a) recites “receiving” a media content file “containing the mixture of samples of copyrighted music, at least two or more of the samples being overlapping.” (Appeal Br., Claims App.) This equates to a DJ creating a DJ mix having overlapping (copyrighted) music samples and knowing that its distribution must be “compliant with the applicable copyright laws and standards.” (Spec. ¶ 5.)

Step (c) recites “analyzing” media content file “to determine a breakdown of the copyright ownership information of the samples,” and step (d) recites “defining and storing a tracklist including the determined breakdown of the samples in a database.” (Appeal Br., Claims App.) These

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<sup>7</sup> During *Alice* step one, “it is not enough to merely identify a patent-ineligible concept underlying the claim; we must determine whether that patent-ineligible concept is what the claim is ‘directed to.’” (*Thales Visionix Inc. v. United States*, 850 F.3d 1343, 1349 (Fed. Cir. 2017).)

are steps that the DJ would do to get ready to distribute his/her DJ mix in a manner “compliant with the applicable copyright laws and standards.”

(Spec. ¶ 5.)

Step (e) recites “monitoring and reporting” the samples of the copyrighted music in the media content file that are “played by the player,” and then “reporting” the copyright information associated with these samples to “a client reporting service.” (Appeal Br., Claims App.) This is a step that the DJ would do to make sure that distribution of the DJ mix is “compliant with the applicable copyright laws and standards.” (Spec. ¶ 5.)

Consequently, under Prong One of Step 2A, the claims recite “legal interactions” involving “legal obligations” associated with copyrighted music, which is a “[c]ertain method[] of organizing human activity” and, therefore, an abstract idea. (2019 Guidance, Federal Register Vol. 84, No. 4, 52.)

Thus, we proceed to the second prong of Step 2A (Prong Two). In Prong Two, we evaluate whether the claim contains additional elements that “integrate” the abstract idea “into a practical application.” (2019 Guidance, Federal Register Vol. 84, No. 4, 54.)

Step (b) of independent claim 19 recites “parsing” the media content file “into a format recognizable by a fingerprinting analytical algorithm.” (Appeal Br., Claims App.) Also, in step (c) it is this “parsed media content file” that is analyzed. (*Id.*) These steps are beyond those performed by a DJ when he/she is trying to be “compliant with the applicable copyright laws and standards.” (Spec. ¶ 5.)

Thus, the record establishes that independent claim 19 includes additional elements which could possibly integrate the identified abstract

idea into a practical application. As such, the record must also establish that these additional elements do not integrate the identified abstract idea into a practical application. Here, the record does not do so.

The Examiner maintains that “[p]arsing and analyzing the media content file” are “generic computing function[s]” that “implement the abstract idea.” (Answer 4.) But the Examiner does not explain adequately why the conversion of a DJ mix into a “format recognizable” (by parsing or otherwise) must be implemented in order for a DJ to insure that distribution of his/her DJ mix is “compliant with the applicable copyright laws and standards.” (Spec. ¶ 5.)

Moreover, according to the Specification, parsing of the media content file is a solution to a computer-centric problem, unrelated to this compliance. Particularly, “fingerprinting tools” routinely used to identify music sample, are “not particularly suited to deal with a compilation such as a DJ mix in which the segment where the blending of different distinct copyrighted works occurs can confuse such tools.” (Spec. ¶ 4.)

Thus, the Examiner does not sufficiently show that claim 19’s additional elements fail to integrate the identified abstract idea into a practical application so as to satisfy the “directed to” inquiry under step one of the *Alice* test. As such, it has not been established, on the record before us, that independent claim 19 fails the *Alice* test for patent eligibility.

Thus, we do not sustain the Examiner’s rejection of independent claim 19 under 35 U.S.C. § 101.

*Rejections II and III – 35 U.S.C. § 103*

The Examiner determines that the claimed method would have been obvious over the combined teaching of Pitman, Teegarden, Rabin, and

Carlson. (*See* Final Action 12, 14.) The Appellant argues that this determination is not sufficiently supported by the record. (*See* Appeal Br. 18–23.) We are persuaded by the Appellant’s position.

Independent claim 19 recites “receiving by a controller a media content file,” “parsing by the controller the media content file into a format recognizable by a fingerprinting analytical algorithm,” and “analyzing the parsed media content file by a fingerprinting server.” (Appeal Br., Claims App.) Independent claim 19 further requires the media content file to be “a media content file containing a mixture of overlapping samples of copyrighted music.” (*Id.*)

Pitman discloses a computerized method for “monitoring audio content” in, for example, a television show in which “copyrighted song[s]” are “played before and after commercial breaks and in the background during the show.” (Pitman 1:18–19, 24–27.) The Examiner acknowledges that Pitman does not disclose that these copyrighted songs are overlapping samples of copyrighted music. (*See* Final Action 12.)

Pitman discloses that an audio datastream (derived from the video content) is “received” by a content-identifier “module.” (Pitman 4:32.) Pitman discloses that the content-identifier module “analyzes the audio datastream” by “using an algorithm that generates audio content identifying information.” (*Id.* at 4:33–35, *see also* Fig. 3.) And Pitman discloses that content identifying information can be an “audio fingerprint that is computed based on the audio data itself.” (*Id.* at 4:23–34.)

As such, the record supports the Examiner’s findings that Pitman discloses “receiving” media content, Pitman discloses that this media content is “recognizable by a fingerprinting analytical algorithm,” and

Pitman discloses “analyzing” this “media content file by a fingerprinting server using the fingerprinting analytical algorithm.” (Final Action 12.)

However, according to the Appellant, “Pitman does not teach or suggest parsing a media content file into a format that is recognizable by a fingerprinting analytical algorithm.” (Appeal Br. 19.) The Examiner does not point to anything in Pitman suggesting that the audio datastream received by the content-identifier module does not arrive ready to be analyzed by fingerprinting. (*See* Final Action 3–4; Answer 19–20.) Rather, Pitman seems to indicate that “the audio input datastream is already recognizable by the ‘content identifier module,’ and as such, needs no parsing.” (Appeal Br. 19.)

The Examiner does find that “Teegarden discloses that a mixture of music may include at least two or more music items that are overlapping.” (Final Action 13.) And, according to the Examiner, it would have been obvious to modify Pitman’s method with a simple substitution of “overlapping samples of copyrighted music” for its disclosed media content. (*Id.*) But the Examiner does not adequately address how this simple substitution would result in Pitman’s modified method having a parsing step that occurs prior to fingerprinting analytics.

Thus, we do not sustain the Examiner’s rejections of claims 19, 24, and 25 under 35 U.S.C. § 103(a).

*Rejection IV—35 U.S.C. § 112 (written description)*

The Examiner determines that the Specification does not adequately describe the determination of “a breakdown of the copyright ownership information” as required by step (c) of independent claim 19. (Final Action 10.) The Appellant argues that the Specification conveys possession

of this subject matter at the time the application was filed. (*See* Appeal Br. 16–17.) We are persuaded by the Appellant’s position.

The Specification conveys that the steps performed in the claimed method are done to facilitate “digital rights management,” and “copyright ownership information” is what steers “digital rights management.” (Spec. ¶ 9.) An accurate breakdown of copyright ownership information in a DJ mix cannot be determined without an accurate breakdown of the songs contained in the DJ mix. (*See id.*) Thus, obtaining an “accurate” breakdown of samples of a DJ mix via fingerprinting analysis is done to determine an accurate breakdown of copyright ownership information. And the Specification further conveys that “copyright ownership information” is determined “using the fingerprinting analytical algorithm.” (*Id.*, Abstract.)

Thus, we do not sustain the Examiner’s rejection of claims 19, 24, and 25 under 35 U.S.C. § 112, first paragraph.

*Rejection V—35 U.S.C. § 112 (indefiniteness)*

The Examiner determines that the phrase “the copyright ownership information” in claim 19, and the phrase “each of the predefined intervals” in claim 24, do not have sufficient “antecedent basis.” (Final Action 11.) The Appellant argues that, notwithstanding grammatical absences of antecedent basis, one of ordinary skill in the art would not consider the claims indefinite. (*See* Appeal Br. 17–18.) We are persuaded by the Appellant’s position.

The failure to provide explicit antecedent basis for terms does not render a claim indefinite if the scope of a claim would be reasonably ascertainable by those skilled in the art. (*See Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366, 1370–71 (Fed. Cir. 2006).) Here, one

of ordinary skill in the art would understand that “the copyright ownership information” pertains to information about the ownership of the copyrighted information, which is used by the copyright licensing entity. (*See Spec.* ¶¶ 2, 4, 7, Abstract.) Additionally, one of ordinary skill in the art would understand that the “parsing” step recited in independent claim 19 is done in predefined intervals, and that claim 24 is specifying that these intervals are each three seconds. (*See id.* ¶ 51.)

Thus, we do not sustain the Examiner’s rejection of claims 19, 24, and 25 under 35 U.S.C. § 112, second paragraph.

#### CONCLUSION

<b>Claims Rejected</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 24, 25	§ 101		1, 24, 25
1, 24,	§ 103(a)		1, 24
25	§ 103(a)		25
1, 24, 25	§ 112, first paragraph		1, 24, 25
1, 24, 25	§ 112, second paragraph		1, 24, 25

REVERSED