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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/718,628	03/05/2010	Brant L. Candelore	SA100027-US-NP	5260
36738	7590	09/14/2018	EXAMINER	
ROGITZ & ASSOCIATES 4420 Hotel Circle Court SUITE 230 SAN DIEGO, CA 92108			SALCE, JASON P	
			ART UNIT	PAPER NUMBER
			2421	
			NOTIFICATION DATE	DELIVERY MODE
			09/14/2018	ELECTRONIC

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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* BRANT L. CANDELORE and FREDERICK J. ZUSTAK

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Appeal 2018-001802  
Application 12/718,628  
Technology Center 2400

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Before ELENI MANTIS-MERCADER, DENISE M. POTHIER, and  
BETH Z. SHAW, *Administrative Patent Judges*.

SHAW, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> seek our review under 35 U.S.C. § 134(a) of the Examiner’s Final Office Action rejecting claims 28–32, 34, 35 and 41–47, all of which are pending on appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.<sup>2</sup>

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<sup>1</sup> The real party in interest is Sony Corp. App. Br. 2.

<sup>2</sup> Our Decision refers to the Appeal Brief filed March 6, 2017 (“App. Br.”); Reply Brief filed November 30, 2011 (“Reply Br.”); Examiner’s Answer mailed July 10, 2017 (“Ans.”); Final Office Action mailed December 30, 2016 (“Final Act.”); and Specification filed March 5, 2010 (“Spec.”).

STATEMENT OF THE CASE

Appellants' invention relates to the selection and substitution of lesser, time intensive advertisements within incoming television signals for playback. Spec. ¶ 1.

Claim 28 is illustrative of Appellants' invention, as reproduced below:

28. Apparatus comprising:

at least one non-transitory computer memory with instructions executable by at least one processor which when executed by the at least one processor configure the at least one processor to:

receive control information identifying an advertisement replacement scheme to be implemented in response to detection of trick play command related to playback of an advertisement in video;

receive a trick play command related to playback of a first advertisement in video; and

in response to the command, responsive to the control information indicating (a) a first mode, prohibiting execution of the trick play command responsive to the trick play command being a fast-forwarding command, permitting execution of the trick play command responsive to the trick play command being a skip command, prohibiting execution of the trick play command responsive to the trick play command being a mute command, prohibiting execution of the trick play command responsive to the trick play command being a pause command;

(b) a second mode, prohibiting execution of the trick play command responsive to the trick play command being a fast-forwarding command, prohibiting execution of the trick play command responsive to the trick play command being a skip command, permitting execution of the trick play command responsive to the trick play command being a mute command, prohibiting execution of the trick play command responsive to the trick play command being a pause command.

## REJECTIONS

Claims 28–32, 34, 35 and 41–47 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to ineligible subject matter. Final Act. 2–3; Ans. 4–10.<sup>3</sup>

## CONTENTIONS AND ANALYSIS

The Examiner finds claims 28–32, 34, 35 and 41–47 are directed to ideas that have been identified as abstract by our reviewing court. Final Act. 2, 3; Ans. 5. In particular, the Examiner finds that the abstract idea underlying these claims is receiving information and receiving a request to play content. Ans. 5. The Examiner also finds additional elements recited in the claims do not amount to significantly more than the abstract idea itself. Final Act.3. According to the Examiner, the claims require no more than performing generic computer functions. *Id.*

Appellants present several arguments against the 35 U.S.C. § 101 rejection. App. Br. 3–8; Reply Br. 1–9. Arguing the claims as a group, Appellants contend the claims are not directed to an abstract idea because the claims are directed to an improvement to computer functionality. App. Br. 5. Appellants also contend the Examiner did not identify why the claims do not recite significantly more than an abstract idea. *Id.* at 7–8.

We do not find Appellants’ arguments persuasive. Instead, we find the Examiner has provided a comprehensive response to Appellants’ arguments supported by a preponderance of evidence. Ans. 4–10. As such, we adopt the Examiner’s findings and explanations provided therein. *Id.* At

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<sup>3</sup> The Examiner withdrew a § 112 rejection of claims 28, 30–32, 34, and 35 in the Answer. Ans. 3.

the outset, we note the Supreme Court has long held that “[l]aws 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 *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). “The ‘abstract ideas’ category embodies ‘the longstanding rule that ‘[a]n idea, of itself, is not patentable.’” *Id.* at 2355 (alteration in original) (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

In *Alice*, the Supreme Court set forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)). The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* (citing *Mayo*, 566 U.S. at 77–78).

If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “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). In other words, the second step is to “search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73). The prohibition against patenting an abstract idea “‘cannot be circumvented by attempting to limit the use of the formula to a particular

technological environment’ or adding ‘insignificant postsolution activity.’”  
*Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010) (citation omitted).

Turning to the first step of the *Alice* inquiry, we agree with the Examiner that Appellants’ claims are directed to an abstract idea of receiving information. Ans. 5. All the steps recited in Appellants’ claims, including, for example: (i) “receiving control information,” and (ii) “receive a trick play command,” are abstract processes of receiving information.

Our reviewing court finds an abstract idea in receiving data or information. *See Elec. Power Grp. LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (“collecting information, analyzing it, and displaying certain results of the collection and analysis” is abstract); *In re Salwan*, 681 F. App’x 938, 941 (Fed. Cir. 2017) (nonprecedential) (affirming the rejection under § 101 of claims directed to “storing, communicating, transferring, and reporting patient health information,” noting that “while these concepts may be directed to practical concepts, they are fundamental economic and conventional business practices”); *Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 F. App’x 988, 992 (Fed. Cir. 2014) (nonprecedential) (“using categories to organize, store, and transmit information is well-established”). Similarly, all the steps executed by the pending claims are abstract processes of receiving data.

Turning to the second step of the *Alice* inquiry, we find nothing in Appellants’ claims that adds anything “significantly more” to transform them into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2357. The claimed steps are ordinary steps in data analysis and are recited in an ordinary order.

We are not persuaded by Appellants’ unsupported attorney argument that the claims represent a specific solution to a technology based problem. App. Br. 14. Appellants do not persuade us why the claims or Specification provide specific, technical improvements. Rather, the Specification explains that the claimed systems include a generic programming and processing environment. *See* Spec. ¶ 26 (“The software may be stored in any type of machine readable medium . . .”). Thus, the Specification does not describe the apparatus as made up of special-purpose or specially configured computer components, but rather, as a general-purpose computer that includes generic components. As a result, nothing recited by the claims “offers a meaningful limitation beyond generally linking ‘the use of the [method] to a particular technological environment,’ that is, implementation via computers.” *Alice* 134 S. Ct. at 2360 (alteration in original) (quoting *CLS Bank Int’l v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1291 (Fed. Cir. 2013) (Lourie, J., concurring)).

As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 134 S. Ct. at 2358; *see id.* at 2359 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” are not patent eligible); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014) (claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet are not patent eligible); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (claims reciting “generalized software components arranged to implement an abstract concept [of

generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” are not patent eligible); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“[s]imply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible”); *Credit Acceptance Corp. v. Westlake Services*, 859 F.3d 1044, 1056 (Fed. Cir. 2017) (generic computer elements did not represent improvement in computer technology but rather were invoked merely as tools, and did not transform the claims into significantly more than claims to abstract idea itself); *Elec. Power Grp.*, 830 F.3d at 1351 (rejection affirmed for a method of performing real-time performance monitoring of an electric power grid because “the claims do not go beyond requiring the collection, analysis, and display of available information in a particular field . . . over conventional computer and network technology”).

Contrary to Appellants’ arguments (*see* App. Br. 5–9), the claims are neither rooted in computer technology as outlined in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), nor do they seek to improve any type of computer capabilities, such as a “self-referential table for a computer database” outlined in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016). “[M]erely ‘configur[ing]’ [a] generic computer[] in order to ‘supplant and enhance’ an otherwise abstract manual process is precisely the sort of invention that the *Alice* Court deemed ineligible for patenting.” *Credit Acceptance Corp.*, 859 F.3d at 1056.

Appellants overlook that “the focus of the claims is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools.” *Elec. Power Grp.*, 830 F.3d at 1354. In

this case, as in *Electric Power Group*, the claims do not even require a new source or type of information, or new techniques for analyzing it. *Id.* at 1355. Although Appellants argue the claims are distinguishable from *Electric Power Group* because the claims in *Electric Power Group* do not resemble “controlling trick play command according to advertising modes,” (Reply Br. 8, 9), the instant claims also do not require “controlling” a command. Rather, the claims merely recite receiving a command. The programming of a first and second mode by itself does not transform the otherwise-abstract processes of receiving data or information. And the claims’ invocation of computers does not transform the claimed subject matter into patent-eligible applications. *See Elec. Power Grp.* 830 F.3d at 1355.

Because Appellants’ claims are directed to a patent-ineligible abstract concept and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of these claims under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny.

Additionally, we note that the phrase “trick play” does not appear in the Specification. In the event of further prosecution of this application, the Examiner may wish to review the claims again for compliance with the written description requirement under 35 U.S.C. § 112 in light of the claimed “trick play.”

#### DECISION

We affirm the Examiner’s rejection of claims 28–32, 34, 35 and 41–47.

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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).

AFFIRMED