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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte YANG-LIM CHOI and SU-HYUN NAM

Appeal 2018-003673
Application 14/924,380¹
Technology Center 2400

Before JOHN A. EVANS, JOHN D. HAMANN, and JASON M. REPKO,
Administrative Patent Judges.

EVANS, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–13. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.²

¹ Appellants identify Samsung Electronics Co., Ltd, as the real party in interest. App. Br. 2.

² Rather than reiterate the arguments of the Appellants and the Examiner, we refer to the Appeal Brief (filed August 7, 2017, “App. Br.”), the Reply Brief (filed February 20, 2018, “Reply Br.”), the Examiner’s Answer (mailed December 18, 2017, “Ans.”), the Final Action (mailed January 30, 2017, “Final Act),” and the Specification (filed October 27, 2015, “Spec.”)

STATEMENT OF THE CASE

The claims relate to a method for sharing content between a mobile terminal and a local server. *See* Abstract.

Invention

Claims 1, 7, and 13 are independent. An understanding of the invention can be derived from a reading of illustrative claim 1, which is reproduced below with some formatting added:

1. A method of communicating metadata of contents at an electronic device, the method comprising:
 - receiving the metadata of the contents from a first device;
 - receiving a contents share service request if the electronic device is determined to be located within a predetermined area;
 - transmitting a response to the contents share service request for an approval of contents share service; and
 - establishing a communication channel with a second device, wherein the communication channel is a traffic channel available to the second device;
 - receiving metadata from the second device; and
 - transmitting the metadata information of the contents to the second device based on a result of matching the metadata of the contents from the first device and the metadata from the second device.

References and Rejections

Hennessy et al.	US 2003/0028623 A1	Feb. 6, 2003
Battagin et al.	US 2005/0278307 A1	Dec. 15, 2005
Ohsumi	US 2006/0184648 A1	Aug. 17, 2006

for their respective details.

Moll et al. US 7,330,728 B1 Feb. 12, 2008
(Filed June 25, 2004)

1. Claims 1–13 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Final Act. 3–5.
2. Claims 1, 4–7, and 10–13 stand rejected under 35 U.S.C. §103 as being unpatentable over Hennessy³ and Moll. Final Act. 5–8.
3. Claims 2 and 8 stand rejected under 35 U.S.C. §103 as being unpatentable over Hennessy, Moll, and Battagin. Final Act. 8–9.
4. Claims 3 and 9 stand rejected under 35 U.S.C. §103 as being unpatentable over Hennessy, Moll, and Ohsumi. Final Act. 9–10.

ANALYSIS

We have reviewed the rejections of claims 1–13 in light of Appellants’ arguments that the Examiner erred. We consider Appellants’ arguments *seriatim*, as they are presented in the Appeal Brief.

CLAIMS 1–13: NON-STATUTORY SUBJECT MATTER.

Appellants argue all claims as a group without designating a representative claim. *See* App. Br. 14. Therefore, we decide the appeal of the § 101 rejection on the basis of independent Claim 1, and refer to the rejected claims collectively herein as “the claims.” *See* 37 C.F.R. § 41.37(c)(1)(iv); *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

³ The Examiner refers to Hennessy as “Henn.” Ans. 5.

The Examiner finds the claims are directed to concepts, such as obtaining and comparing intangible data and using categories to organize, store, and transmit information.⁴ Final Act. 4. Without a specific citation, the Examiner finds the courts have found such concepts to be ineligible as abstract ideas. *Id.*

Appellants analogize their claims to those of *Cellzdirect*⁵, and contend that the claims are not simply the observation or detection of a natural law. App. Br. 14. Appellants argue instead the claims are “directed to” improved sharing of contents via localized sharing of contents metadata between mobile terminals, thereby sharing contents desired by the user without the user’s intervention. *Id.* Thus, Appellants contend, their claims are “like thousands of others that recite processes to achieve a desired outcome, e.g., methods of producing things, or methods of treating disease.” *Id.* (quoting *Rapid Litig. Mgmt.* at 1048–9).

Mayo-Alice Step 1.

The Supreme Court has instructed us to use a two-step framework to “distinguish[] patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014). At the first step, we determine whether the claims at issue are “directed to” a patent-ineligible concept. *Id.*

⁴ Although the Examiner does not provide a citation, Appellants presume the Examiner relies upon *Cyberfone Sys. v. CNN Interactive Group, Inc.*, 558 Fed. Appx. 988 (Fed. Cir. 2014). *See* App. Br. 10. R. 38.

⁵ *See Rapid Litigation Management Ltd. v. Cellzdirect, Inc.*, 827 F.3d 1042 (Fed. Cir. 2016).

The Examiner finds the claims are directed to abstract ideas which are encompassed in the steps of “receiving the metadata,” “receiving a contents share service request,” “transmitting a response,” “establishing a communication channel,” “receiving metadata,” and “transmitting the metadata information.” Ans. 2. The Examiner finds the claimed concepts are similar to concepts, such as obtaining and comparing intangible data, found to be abstract in *CyberSource*⁶ and such as remotely accessing and retrieving user-specified data, found to be abstract in *Intellectual Ventures I*.⁷ *Id.* The Examiner finds the claims merely manipulate data, but with no inventive end. Ans. 3. The Examiner’s Answer maintains these findings, but without specific response to Appellants’ arguments presented in the Appeal Brief. *See* Ans. 2–3.

Appellants contend “the fundamental inquiry is to determine whether the scope of a patent claim is directed to a building block of human ingenuity or [to] something more that transforms the patent claim into a patent-eligible invention, which ‘pose[s] no comparable risk of pre-emption, and therefore remain[s] eligible for the monopoly granted under our patent laws’.” App. Br. 11 (quoting *Alice* at 2354–55).

Appellants argue the rejection oversimplifies the claims by distilling the limitations of claim 1 to: “obtaining and comparing intangible data, using categories to organize, store, and transmit information” and “receiving, establishing and transmitting.” *Id.* Appellants cite *McRO* for the proposition that that oversimplification of the limitations of the claims by

⁶ *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (2011).

⁷ *Intellectual Ventures I LLC v. Capital One Financial Corp.*, 850 F.3d 1332 (2017).

failing to account for the specific requirements is improper. App. Br. 12 (quoting *McRO, Inc. v. Bandai Namco Games Am.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016) (“We have previously cautioned that courts ‘must be careful to avoid oversimplifying the claims’ by looking at them generally and failing to account for the specific requirements of the claims.”)).

Appellants contend matching metadata of the contents of mobile terminals within a social network to enable the sharing of the contents of the mobile terminals is not an abstract idea similar to organizing human activity, an idea “of itself,” nor is it a mathematical relationship or formula. App. Br. 13–14 (citing *Alice Corp.*, 573 U.S. at 217–20). Appellants argue the claims do not merely observe or detect a natural law⁸, but are “directed to” an improvement in computer technology, i.e., an improved method of sharing contents of local terminals by localized sharing of metadata. *Id.*, 14.

The *Intellectual Venture I* Court found the claims were directed to an abstract idea because the claims recited remotely accessing and retrieving information, but without reciting any particular unique delivery through the user interface, and thus, merely provide a technological environment for the information exchange. Reply Br. 8. Appellants argue claim 1 recites, *inter alia*, “receiving the metadata of the contents from a first device; receiving a contents share service request if the electronic device is determined to be located within a predetermined area; transmitting a response to the contents share service request for an approval of contents share service; and establishing a communication channel with a second device, . . . receiving

⁸ Citing *Rapid Litigation Management Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042 (2016).

metadata from the second device; and transmitting the metadata information of the contents to the second device based on a result of matching the metadata of the contents from the first device and the metadata from the second device.” App. Br. 14; Reply Br. 8. According to Appellants, the claim recites “how the sharing of contents occurs.” Reply Br. 9.

We agree with Appellants that under Step 1 of the *Mayo/Alice* analysis, the claims are not “directed to” an abstract idea. In determining patent eligibility under § 101, the Federal Circuit reviews the specification disclosure. *See Ancora Techs., Inc. v. HTV Am., Inc.*, 2018-1404, slip op. 3 (Fed. Cir. Nov. 16, 2018) (“The ’941 patent describes an asserted improvement based on assigning certain functions to particular computer components and having them interact in specified ways”).

Appellants’ Specification discloses: the “present invention relate[s] to contents sharing between a mobile terminal and a local server, and more particularly to, sharing contents required by a user using a mobile terminal via another user’s local mobile terminal or a local server.” Spec., ¶ 2. Downloading content from a server through the use of a third party mobile terminal is a technological solution to a technological problem.

Where, as here, the claims are found not directed to an abstract idea, under *Alice* step 1, “the claims satisfy § 101 and we need not proceed to the second step.” *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356, 1361 (Fed. Cir. 2018) (citing *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1262 (Fed. Cir. 2017)).

CLAIMS 1, 4–7, AND 10–13: OBVIOUSNESS OVER HENNESSY AND MOLL.

Improper combination.

The Examiner finds Hennessey substantially teaches the claims except Hennessey fails to teach establishing a communications channel with a second device. Final Act. 5–6. The Examiner finds Moll teaches receiving a contents share service request if the electronic device is determined to be roaming within a predetermined area. Final Act. 6. The Examiner finds Moll further teaches transmitting a response to the contents share service request for an approval of contents share service, in order to locate a mobile-subscriber terminal. *Id.*

Appellants contend neither Hennessey, nor Moll, together or severally, teach sharing metadata relating to contents between remote terminals. App. Br. 20. With respect to Moll, Appellants argue Moll teaches communication between a mobile subscriber terminal (MST) and the serving and subscriber networks. *Id.* Appellants argue Hennessey does not describe a subscriber mobile terminal that could have been modified by the teachings of Moll because Hennessey discloses computer terminals which, as would be understood by the artisan of ordinary skill, do not roam through various cellular networks, and thus the negotiation between the serving network and subscribing network, described by Moll, could never be a required service of the systems in Hennessey. App. Br. 20–1.

The Examiner finds the motivation to combine the references is found in the Moll reference: “in order to for [*sic*] locating a mobile-subscriber terminal.” Ans. 4–5 (citing Moll, Abstr.). The Examiner fails to respond to Appellants’ contentions. Appellants allege Hennessey discloses static terminals in a computer network. In the absence of an Examiner’s finding to the contrary (and the Examiner makes none), we accept Appellants’ allegations as correct. We agree with Appellants that a network comprised

of static terminals has no need, or motivation, to incorporate methods for locating a mobile-subscriber terminal. “A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 401 (2007). Although it may “be necessary for a court to look to interrelated teachings of multiple patents,” in order to “facilitate review, this analysis should be made explicit.” *Id.* at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). In view of the forgoing, we decline to sustain the rejections of claims 1, 4–7, and 10–13.

CLAIMS 2, 3, 8, AND 9: OBVIOUSNESS OVER HENNESSY, MOLL, AND
VARIOUSLY BATTAGIN OR OHSUMI.

Appellants contend neither Battagin, nor Ohsumi, cure the deficiencies of Moll and Hennessey as discussed above. App. Br. 25.

The Examiner’s Answer does not make findings with respect to these secondary references.

In view of the forgoing, we decline to sustain the rejections of claims 2, 3, 8, and 9.

DECISION⁹

⁹ Because we do not sustain the Examiner’s rejection of claims 1–13 for the reasons discussed supra, we need not address Appellants’ additional arguments. *See Beloit Corp. v. Valmet Oy*, 742 F.2d 1421, 1423 (Fed. Cir. 1984) (Finding an administrative agency is at liberty to reach a decision

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The rejection of claims 1–13 under 35 U.S.C. § 101 is reversed.

The rejections of claims 1–13 under 35 U.S.C. § 103 are reversed.

REVERSED

based on “a single dispositive issue.”).