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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GARY D. CUDAK, LYDIA M. DO,
CHRISTOPHER J. HARDEE, and ADAM ROBERTS

Appeal 2018-004516
Application 14/057,259¹
Technology Center 2100

Before HUNG H. BUI, JOSEPH P. LENTIVECH, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1, 3–7, and 11, which are all of the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Technology

The application relates to searching for media files pertaining to a specified topic, extracting portions related to a selected subtopic, and compositing the portions into a single media file. *See* Spec. ¶ 7, claim 1.

¹ According to Appellants, the real party in interest is International Business Machines Corp. App. Br. 2.

Illustrative Claim

Claim 1 is illustrative and reproduced below with certain limitations at issue emphasized:

1. A method for the automated composition of topical media, the method comprising:

receiving a topic query in a user interface in a display of a computer;

building a media file list based upon a topic specified in the topic query;

searching one or more media stores over a computer communications network for media files pertaining to the specified topic;

retrieving multiple different media files including portions corresponding to the topic of interest;

inspecting **tags** for each of the media files *to identify one or more sub-topics* of the specified topic;

identifying one or more sub-topics of the specified topic and *displaying the identified sub-topics in a list* in the user interface;

selecting one or more of the sub-topics in the list;

extracting portions of the files corresponding to *the selected one or more sub-topics*;

compositing the extracted portions corresponding both to the topic of interest and *the identified one or more sub-topics* into a single media file; and,

storing into fixed storage the single media file.

Examiner's Rejections & References

Claims 1, 3–7, and 11 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter without significantly more. Final Act. 4.

Claims 1, 3, 4, 7, and 11 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Houh et al. (US 2007/0106693 A1; May

10, 2007), Smyros (US 2010/0042588 A1; Feb. 18, 2010), and Bolls (US 2009/0192985 A1; July 30, 2009). Final Act. 6.

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Houh, Smyros, Boll, and Rao et al. (US 2008/0222106 A1; Sept. 11, 2008). Final Act. 11.

Claims 1, 3–7, and 11 stand rejected under 35 U.S.C. § 112(b) as indefinite. Final Act. 2.

Claims 1, 3–7, and 11 stand rejected on the grounds of non-statutory obviousness-type double patenting over claims 1, 3, 5–7, 10, and 12–16 of co-pending Application No. 14/053820. Final Act. 13.

Related Application & Appeal

Appellants identify co-pending Application No. 14/053,820 (Appeal No. 2018-004513) as a related appeal. App. Br. 2.

ISSUES

1. Did the Examiner err in concluding that claim 1 was directed to an abstract idea without significantly more?
2. Did the Examiner err in finding Smyros or Bolls teaches or suggests inspecting “tags” to identify sub-topics, as recited in claim 1?
3. Did the Examiner err in concluding that the multiple recitations of “topics” or “sub-topics” render independent claims 1 or 10 indefinite?

ANALYSIS

§ 101

The Supreme Court has “long held that [35 U.S.C. § 101] contains an important implicit exception” that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Mayo Collaborative Servs. v. Prometheus*

Labs., Inc., 566 U.S. 66, 70 (2012) (quotation omitted). To determine patentable subject matter, the Supreme Court has set forth a two part test.

In the first step, “we determine whether the claims at issue are directed to one of those patent-ineligible concepts” of “laws of nature, natural phenomena, and abstract ideas.” *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). “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.” *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1326 (Fed. Cir. 2017). The Supreme Court and Federal Circuit have cautioned, however, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas” (*Mayo*, 566 U.S. at 71), and “describing the claims at . . . a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). Instead, “the claims are considered in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015). “If the claims are not directed to an abstract idea [or other patent-ineligible concept], the inquiry ends.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016).

Here, the Examiner determines that “[t]he claims are directed to the . . . abstract idea of obtaining and comparing intangible data.” Final Act. 4.

We hold that the Examiner’s abstract idea of “obtaining and comparing intangible data” is too high a level of abstraction. The Federal Circuit has “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. Here, the claims are limited to rules with specific characteristics.” *McRO*, 837 F.3d at 1313 (quotation and citation omitted). When viewed in entirety, claim 1 is instead directed to searching media files based on a specified topic, extracting portions of those files related to a selected sub-topic, and compositing the extracted portions into a single media file. To accomplish this, claim 1 requires sending a query specifying a topic to a media file search engine, inspecting the tags of the media file search results for sub-topics, selecting one or more sub-topics, extracting portions of the files corresponding to the selected sub-topics, and compositing the extracted portions into a single media file. These steps set forth concrete actions, not merely a desired end result. *See RecogniCorp*, 855 F.3d at 1326 (“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.”). Therefore, the claims are sufficient under the first step of the *Alice/Mayo* framework.

The Examiner further determines that the claimed “rules” were “well known” and “the mere automation of a manual human practice.” Ans. 4, 6. Such an analysis may be relevant to anticipation, obviousness, or the second step of the *Alice/Mayo* framework. For example, the claims may be rendered obvious by evidence of prior human activity such as (A) a music lover making a Valentine’s mix tape (a single collated file) of country songs (a topic) about love (a sub-topic) or (B) a researcher gathering books on a certain topic, photocopying pages relating to the specific sub-topic being researched, and collating the photocopies into a single pile. *See* Ans. 5

(introducing a similar example). However, for the first step in the *Alice/Mayo* framework, such rules being “well known” does not address whether the claim as a whole is directed to an abstract idea.

Accordingly, we do not sustain the Examiner’s rejection under § 101 of claim 1, and its dependent claims 3–7 and 11.

§ 103

Claim 1 recites “inspecting *tags* for each of the media files to identify one or more sub-topics.”

Appellants argue that the Examiner’s reliance on Bolls and Smyros is misplaced because those references merely teach inspecting the words in a document, not any *tags* for the document. *See* App. Br. 11–12.

The Examiner, however, determines that the broadest reasonable interpretation of “tags” includes words in a document. Ans. 7–9. The Examiner explains that “[t]he instant specification gives no explicit definition for the term tag.” *Id.* at 8. According the Examiner:

The claims recite that the tags are ‘for each of the media files’ indicating they are part of the media files, and are used ‘to identify one or more sub-topics of the specified topic’. Words in a document are clearly part of the document, and can be used to identify one or more sub-topics of the specified topic of the document. Thus, one of ordinary skill in the art would have identified terms within a document as being a reasonable interpretation of the claimed ‘tags’.

Ans. 8.

We agree with Appellants. The Specification discloses that tags are an example of “meta data.” Spec. ¶ 20 (“meta data such as tags”). A person of ordinary skill in the art would have understood that words in a document

were data, not meta data. Thus, without more, words in a document do not teach or suggest “tags,” as claimed.

Accordingly, we do not sustain the Examiner’s rejection under § 103 of claim 1, and its dependent claims 3–7 and 11.

§ 112(b)

A) “topic”

The Examiner states that claim 1 recites multiple limitations with the word “topic,” including (1) “a topic query”; (2) “a topic specified in the query”; (3) “the specified topic”; and (4) “the topic of interest.” Final Act. 2. The Examiner concludes that “[t]he repeated use of the term topic renders the meaning of the claim confusing” and “[t]he distinction between the specified topic, the topic query, . . . the topic specified in the topic query, and the specified topic is unclear.” *Id.* at 3.

However, we agree with Appellants about the distinction between a “topic” and a “topic query.” “On its face, a topic query is a query about a topic, whereas a topic alone is not a query.” Reply Br. 3. Thus, a person of ordinary skill in the art would have understood that “the specified topic” refers to “a topic specified in the query,” not the “topic query” itself.

We also do not agree with the Examiner that “‘the topic of interest’ lacks antecedent basis since there has not previously been a defined ‘topic of interest’.” Final Act. 3. The failure to provide explicit antecedent basis does not necessarily render a claim indefinite if the context provides reasonable certainty. *Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366, 1370–71 (Fed. Cir. 2006). Here, in the context of the claims, it would have been reasonably certain that “the topic of interest” refers to the same topic as “the specified topic.”

B) “*sub-topics*”

Claim 1 recites (1) “to identify *one or more sub-topics*”; (2) “identifying *one or more sub-topics*”; (3) “displaying *the identified sub-topics* in a list”; (4) “selecting one or more of *the sub-topics in the list*”; (5) “extracting portions of the files corresponding to *the selected one or more sub-topics*”; and (6) “compositing the extracted portions corresponding both to the topic of interest and *the identified one or more sub-topics* into a single media file.” (Emphasis added).

The Examiner determines that “[t]he claim appears to define the term ‘one or more sub-topics’ multiple times.” Final Act. 3. In particular, “the claim explicitly recites to ‘identify one or more sub-topics of the specified topic’ repeatedly, back to back.” *Id.* at 4.

We agree with the Examiner. In particular, a person of ordinary skill in the art would not have been reasonably certain as to whether “the *identified sub-topics*” and “the *identified one or more sub-topics*” refer to (A) “inspecting tags for each of the media files *to identify one or more sub-topics*” or (B) “*identifying one or more sub-topics.*” (Emphasis added). During prosecution, “if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.” *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential); *see also Ex parte McAward*, Appeal No. 2015-006416, 2017 WL 3669566, at *2 n.3, *4 (PTAB Aug. 25, 2017) (precedential) (reaffirming *Miyazaki*). Thus, claim 1 is indefinite.

Accordingly, we sustain the Examiner's rejection under § 112(b) of independent claim 1, and its dependent claims 3–7 and 11, which Appellants argue are patentable for similar reasons. *See* App. Br. 9; 37 C.F.R. § 41.37(c)(1)(iv).

Double Patenting

Appellants have not presented any arguments addressing the double patenting rejection. Accordingly, we affirm the Examiner's double patenting rejections of claims 1, 3–7, and 11.

DECISION

For the reasons above, we affirm the Examiner's decision rejecting claims 1, 3–7, and 11 under § 112(b) and double patenting, but reverse the Examiner's decision rejecting those claims under §§ 101 and 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED