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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MADHAVI YEMMELA and VALENTIN PETRAN

Appeal 2018-005814
Application 14/885,849
Technology Center 2600

Before JEAN R. HOMERE, JASON V. MORGAN, and ADAM J. PYONIN, *Administrative Patent Judges*.

MORGAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Introduction

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the Examiner's decision to reject claims 1 and 2. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM.

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. Appellant identifies the real party-in-interest as one of the co-inventors, Valentin Petran. Appeal Br. 1. Appellant further identifies Valentin Petran as appealing the Examiner's rejections *pro se*. *Id.* We recognized that Appellant may be unfamiliar with patent prosecution procedure. While Appellant may prosecute the application (unless the

Summary of the disclosure

Appellant's claimed subject matter relates to software that "uses text to speech technology to perform electronic screenplays, including plays depicting debates, multi-lingual conversations, and scientific conference presentations, using one or more distinctly identifiable voices." Abstract.

Appellant's claims[2]

> 1. A method for creating, storing, editing, and consuming, a new kind of technical education media, (that can be passively enjoyed like an audio recording or movie, but that can be aimed at a larger and more diverse audience than a book, audio recording or movie, and that is less likely to bore, tire or confuse that broader audience, and is less likely to be misunderstood by the members of that broader audience, than a book, audio recording or movie, and) which is comprised of performing the below described steps in any order, including in parallel:
>
> creating a media authoring environment, comprised of a computer system and non-transitory computer readable media onto which have been recorded machine readable instructions, that provide that authoring environment with functionality that

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application is assigned to a juristic entity; *see* 37 C.F.R. § 1.31), lack of skill in the field of patent prosecution usually acts as a liability in affording maximum protection for the invention disclosed. If Appellant chooses to request continued prosecution of the application, Appellant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. More information is available in the Manual of Patent Examination Procedure (MPEP) section 401, available at https://www.uspto.gov/web/offices/pac/mpep/s401.html.

[2] Appellant also proposes revised claims. *See* Reply Br. 5–6. The Board does not, however, enter claim amendments in *ex parte* proceedings—this is a function for Examiners. Nor does the Board consider hypothetical claims in *ex parte* proceedings. Therefore, we will not consider the proposed revisions.

makes it possible for that authoring environment to provide a human subject matter expert with the means to create and configure a media repository, comprised of a collection of empty containers each of which is capable of housing a monologue represented in electronic form (either as a block of text, an audio clip or a video clip), and to document relationships between those monologue containers by, (as many times as is deemed necessary by that human subject matter expert, in order to create a repository of conversations that has a level of granularity that is deemed acceptable to that subject matter expert, and contains as many different wordings, levels of detail, and levels of terseness, that are deemed acceptable to that subject matter expert,) (where the term monolog[ue] container refers to any electronic repository for a fragment of text that is intended to be spoken by only one person and includes not only individual electronic files, but also any region in such a file whose beginning and end has been documented in electronic form, for example by specifying in machine readable form where a block of text that is expected to be spoken by one character begins and where it ends)[;]

designating a series of containers as intended to be used to house monologues which if presented in order constitute a grammatically correct and conceptually meaningful conversation between real or fictitious characters, that explain a technical concept that the afore mentioned human subject matter expert wishes to teach, by presenting a conversation about that concept;

designating two series of containers as intended to each house a conversation that depict the same technical concepts using the same level of technical detail, and level of terseness but to do so using different wordings, including wordings in different languages;

designating a series of containers as intended to house a less terse version of a conversation that is to be housed in a different series of containers, in the sense that the less terse version includes more banter designed to entertain the intended audience, and give that audience both more time to rest and more opportunities to absorb the technical concepts and

terminology being presented before additional more complex concepts which use them are presented;

designating two containers that each belong to different series of the aforementioned variety, as equivalent locations in different conversations, in the sense that they both are intended to house the beginning of an explanation of the same technical concept, and hence, are suitable entry points for jumping into the middle of one conversation, from the middle of another conversation;

populating the aforementioned repository with conversation fragments that have been created by a human author specifically to conform to the afore mentioned inter-container relationships and,

creating a specialized media player, comprised of a computer system equipped with specialized machine readable instructions, recorded on non-transitory computer readable media, that make it possible for that media player to understand all of the afore described relationships between monologue containers, and hence allow it to comply with requests on the part of the audience to not only present media repositories, but also to increase or decrease the level of detail that is being presented, increase or decrease the extent to which the information being presented is terse, repeat again using different wordings an explanation that have already been presented, or facilitate learning through repeated exposure while avoiding audience boredom by always presenting those renditions of an explanation, that are comprised of conversations that a user has heard least often, which, for repositories comprised of several hundred technically equivalent conversations, all but guarantees that no specific conversation ever needs to be listened to more than once, by any given audience member.

2. A method for creating, editing, storing, and consuming, a new kind of computer readable media, (which consumes less space than an audio or video recording, which is less time consuming to create or disseminate than an audio or video recording, whose intellectual content is less likely to be

rendered unreadable by technological changes including media file format changes that lead to media format obsolescence, and that is as immersive as a movie) comprised of:

storing the intellectual content component of media, separately from those of it's [sic] aspects that merely create a pleasant ambiance and help block out distractions, and that per unit of play time require at least one hundred times more storage than the intellectual content, and that are comprised of audio and video recordings;

creating a specialized media player, comprised of a computer system, and non-transitory computer readable media onto which have been recorded machine readable instructions, that allow the media player, to combine the afore cited media components at the time the media is consumed, to create a user experience that is not as rich as a traditional movie, but rather, equivalent to sitting each night in the same scenic environment (like for example a waterfront restaurant), and listening to friends talk about different topics, while looking at the scenic environment, rather than at the people who are talking, and thereby making possible for the afore mentioned ambiance focused audio or video recordings to be repeatedly used with different pieces of intellectual content in order to save space;

representing the intellectual content using mere text files, called electronic screenplays, that contain information which is both human and machine readable, and can in the worst case, be easily printed onto paper, to assure authors that it will not be rendered unreadable in the event of corporate bankruptcy or marketing strategy change induced media obsolescence, and that is comprised of conversations between real or fictitious characters, interspersed with commands that are understandable to the aforementioned media player, (which in turn has multi-voice text to speech capabilities that it uses to read the intellectual content out loud, using voices specified by the media authors, using the afore mentioned commands,) and that has been specifically designed to ignore requests to play still images, audio recordings and video files it can not find, (in order to facilitate dissemination of the more important and less space consuming intellectual content component of the media

> over the kinds of unreliable low bandwidth telecommunications networks that currently exist in developing countries and rural areas).

The Examiner's rejections[3] *and cited references*

The Examiner rejects claims 1 and 2 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 4–6.

The Examiner rejects claims 1 and 2 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement. Final Act. 6–7.

The Examiner rejects claims 1 and 2 under 35 U.S.C. § 112(b) as being indefinite. Final Act. 7–8.

The Examiner rejects claim 1 under 35 U.S.C. § 103 as being unpatentable over Crystal (US 2009/0144642 A1; published June 4, 2009) and Henning et al. (US 2016/0057181 A1; published Feb. 25, 2016) ("Henning"). Final Act. 9–12.

The Examiner rejects claim 2 under 35 U.S.C. § 103 as being unpatentable over Steele (US 2004/0110490 A1; published June 10, 2004). Final Act. 12–14.

35 U.S.C. § 101

Principles of law

To be statutorily patentable, the subject matter of an invention must be a "new and useful process, machine, manufacture, or composition of matter, or [a] new and useful improvement thereof." 35 U.S.C. § 101. There are implicit exceptions to the categories of patentable subject matter identified

[3] The Examiner also objects to claims 1 and 2. Appellant does not dispute the Examiner's objection (Appeal Br. 8) and the Examiner correctly notes that the objections, which would have been petitionable, are not appealable (Ans. 9).

in 35 U.S.C. § 101, including: (1) laws of nature; (2) natural phenomena; and (3) abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014). The Supreme Court has set forth a framework for distinguishing patents with claims directed to these implicit exceptions "from those that claim patent-eligible applications of those concepts." *Id.* at 217 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012)). The evaluation follows a two-part analysis: (1) determine whether the claim is *directed to* a patent-ineligible concept, e.g., an abstract idea; and (2) if so, then determine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to *significantly more* than the patent-ineligible concept itself. *See id.* at 217–18.

"[A]ll 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. We "'must be careful to avoid oversimplifying the claims' by looking at them generally and failing to account for the specific requirements of the claims." *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016) (quoting *In re TLI Commc'ns LLC Patent Litigation*, 823 F.3d 607, 611 (Fed. Cir. 2016)).

The U.S. Patent and Trademark Office (USPTO) recently published revised guidance on the application of the two-part analysis. USPTO, *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50 (January 7, 2019) ("Recent Guidance"); *see also* USPTO, *October 2019 Update: Subject Matter Eligibility*, available at https://www.uspto.gov/sites/default/files/documents/peg_oct_2019_update.pdf (Oct. 17, 2019). Under that guidance, we first look to whether the claim recites:

> (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes) (*see id.* at 54 (step 2A, prong one)); and
>
> (2) additional elements that integrate the judicial exception into a practical application (*see id.* at 54–55 (step 2A, prong two); MPEP §§ 2106.05(a)–(c), (e)–(h)).

See Recent Guidance, 84 Fed. Reg. at 52–55.

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

> (3) adds a specific limitation beyond the judicial exception that is not "well-understood, routine, conventional" in the field (*see* MPEP § 2106.05(d)); or
>
> (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See Recent Guidance, 84 Fed. Reg. at 56.

Recent Guidance step 2A, prong one – claim 1

In rejecting claim 1 as being directed to patent-ineligible subject matter, the Examiner determines that the claim is "directed to a patent-ineligible abstract concept that could be performed in the human mind, or by a human using a pen and paper." Final Act. 5. Specifically, the Examiner determines that the recitations of *creating a media authoring environment*, *designating a series of containers*, *populating the aforementioned*

repository, and *creating a specialized media player* "are operations by [a] human, even though computer, memory and instructions are mentioned, . . . they are just generic computer components." *Id.*; *see also* Ans. 5–6. Thus, the Examiner's determinations are directed to showing claim 1 recites either mental processes or certain methods of organizing human activity, both of which represent unpatentable abstract ideas. *See* Recent Guidance, 84 Fed. Reg. at 52.

The Examiner does not provide sufficient determinations to show that claim 1 recites an abstract idea. *See* Final Act. 5; Ans. 5–6. In particular, claim 1 recites both *creating a media authoring environment* and *creating a specialized media player*, where both the media authoring environment and specialized media player comprise a computer system and non-transitory computer readable media with specialized machine readable instructions to perform a number of claimed operations such as providing "provide a human subject matter expert with the means to create and configure a media repository, comprised of a collection of empty containers each of which is capable of housing a monologue represented in electronic form." Appellant argues these recitations represent "a specific technique that *computers* can use to solve [the disclosed] problem in a way that is different from the way that [the] problem is solved by humans." Reply Br. 2–3 (emphasis added); *see also* Appeal Br. 9–10. The Examiner's determinations, however, are largely limited to the broad characterization of the recitations of claim 1 representing "operations [that] can be performed by a human with sufficient . . . skill and knowledge in the associated field." Ans. 6. Such a sweeping determination, without analysis of whether the specific claim recitations are part of the purported abstract idea or whether they represent additional

recitations to be analyzed separately, fails to show that the claim 1 recites an abstract idea.

Therefore, based on the record before us, we do not sustain the Examiner's 35 U.S.C. § 101 rejection of claim 1.

Recent Guidance step 2A, prong one – claim 2

The Examiner's determinations with respect to claim 2 are similarly deficient. *See* Final Act. 5; Ans. 6. In particular, claim 2 recites "creating a specialized media player, comprised of a computer system, and non-transitory computer readable media onto which have been recorded machine readable instructions" such that the media player can perform operations such as "combin[ing] . . . media components at the time the media is consumed." The Examiner again broadly characterizes the recitations of claim 2 as representing "functions that would be performed by a skilled human in this field." Ans. 6. This broad characterization, however, lacks analysis regarding whether the specific claim recitations are part of the purported abstract idea or whether they represent additional recitations to be analyzed separately. Thus, the Examiner's determinations fail to show that claim 2 recites an abstract idea.

Therefore, based on the record before us, we do not sustain the Examiner's 35 U.S.C. § 101 rejection of claim 2.

35 U.S.C. § 112(A)—CLAIM 1

In rejecting claim 1 as failing to comply with the written description requirement, the Examiner finds the limitations of (1) ***creating a media authoring environment*** *that makes it possible to create and configure a* ***media repository*** *comprised of a collection of empty containers each of which is capable of housing a* ***monologue***; (2) ***designating a series of***

containers *as intended to be used to house monologues* constituting ***conversation between real or fictitious characters***; (3) ***designating two containers*** *that each belong to different series of the aforementioned variety, as equivalent locations in different conversations, in the sense that they both are intended to house the beginning of an explanation of the same technical concept, and hence, are suitable entry points for jumping into the middle of one conversation, from the middle of another conversation*; and (4) ***populating the aforementioned repository*** *with conversation fragments that have been created by a human author specifically to conform to the afore mentioned inter-container relationships* are not found in the Specification. Final Act. 7.

Appellant contends the Examiner erred because the recitations of claim 1 represent "an obvious way to attempt to describe in a way that is concise yet not indefinite[] that which is already described in" the Specification. Appeal Br. 19; *see also* Reply Br. 8. We are, however, unable to ascertain how the disputed recitations are supported by the Specification, even in light of Appellant's citations to the Specification. Appeal Br. 2.

We acknowledge certain portions of the Specification seem to superficially relate to some of the disputed recitations. For example, the Specification discloses authors being able to insert commands into a screenplay. Spec. 7, Fig. 4. The Specification discloses reading statements using different voices to facilitate presentation of debates and dialogues. *Id.* at 15. And the Specification discloses storing collections of text fragments in a hierarchical file system. *Id.* at 10. But none of these disclosures provide sufficient written descriptive support for all the limitations of the disputed recitations.

It is not enough that the Appellant actually possessed or reduced to practice the claimed invention outside the Specification, nor is it enough that the Specification render the claimed invention obvious. *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc). Rather, "the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Id.* at 1351 (citing, e.g., *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). Specifically, "the test requires an objective inquiry into the four corners of the [S]pecification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the [S]pecification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed." *Id.* Further, "general statements of the function to be performed . . . [are] not sufficient [to show written description support] because a description that merely renders the invention obvious does not satisfy the written description requirement." *Ex parte Smith*, Appeal 2012-007631, slip op. at 21 (PTAB Mar. 14, 2013), available at https://www.uspto.gov/sites/default/files/ip/boards/bpai/decisions/inform/ex_parte_smith_fd2012007631.pdf (informative) (citing *Ariad*, 598 F.3d at 1352).

Appellant's comments regarding "the term skilled in the art of software development" (Appeal Br. 19; *see also* Reply Br. 8) are unhelpful because "a person of ordinary skill in the art" is a theoretical construct, not a description of some particular individual (*cf. Endress + Hauser, Inc. v. Hawk Measurement Sys. Pty. Ltd.*, 122 F.3d 1040, 1042 (Fed. Cir. 1997)). Thus, for example, in viewing the Specification from the "the perspective of

one of skill, in some circumstances, [Appellant] may rely on information that is 'well-known in the art' for purposes of meeting the written description requirement." *Bos. Sci. Corp. v. Johnson & Johnson*, 647 F.3d 1353, 1366 (Fed. Cir. 2011) (citing *Falko-Gunter Falkner v. Inglis*, 448 F.3d 1357, 1366–68 (Fed. Cir. 2006)). But here the particular features claimed—but not supported by sufficient written description in the Specification—are not well-known in the art. Instead, they reflect particular features and uses specific to possible (but undisclosed) embodiments of Appellant's claimed invention. As such, even if an artisan of ordinary skill could, given a "high level design document, . . . be counted on to learn all relevant applications programming interfaces for any particular computing platform in order to singlehandedly implement fully functional bug free software that is described by that high level design document" (Appeal Br. 19), the Specification must still reasonably convey that Appellant, *at the time of filing*, had possession of the recited invention. The evidence here does not, however, show the Specification provides the requisite support. *Cf. In re Wilder*, 736 F.2d 1516, 1521 (Fed. Cir. 1984) (affirming a rejection for lack of written description because the specification does "little more than outlining goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate").

Accordingly, we sustain the Examiner's 35 U.S.C. § 112(a) rejection of claim 1.

35 U.S.C. § 112(A)—CLAIM 2

In rejecting claim 2 as failing to comply with the written description requirement, the Examiner finds the recitation of ***representing the intellectual content*** *using mere text files,* ***called electronic screenplays***, does

not have sufficient written description support in the Specification. Final Act. 8. Original claim 1, however, recited using "speech synthesizers to perform electronic screenplays . . . . stored by the software as collections of text fragments." Spec. 21. "[O]riginal claims are part of the original [S]pecification," and thus are relevant to the extent the "original claim language necessarily discloses the subject matter that it claims." *Ariad*, 598 F.3d at 1349 (citing *In re Gardner*, 480 F.2d 879, 879 (CCPA 1973)). Here, the Specification, through original claim 1, discloses text files (i.e., text fragments) called electronic screenplays. Moreover, the Specification discloses storing "intellectual content . . . in the form of screenplays that depict conversations." Spec. 5. Together, these disclosures reasonably convey to an artisan of ordinary skill that Appellant had possession of the disputed recitation.

Accordingly, we do not sustain the Examiner's 35 U.S.C. § 112(a) rejection of claim 2.

35 U.S.C. § 112(B)

In rejecting claims 1 as indefinite, the Examiner finds the claim includes indefinite features such as: (1) *machine readable instructions that provide that authoring environment with functionality that* ***makes it possible for that authoring environment*** *to provide a human subject matter expert with the means to create and configure a media repository*; (2) *machine readable instructions that* ***make it possible for that media player*** *to understand all of the afore described relationships between monologue containers*; and (3) *designating a series of containers as intended to house a less terse version of a conversation in the sense that the less terse version* ***includes more banter designed to entertain the intended audience*** *and give*

that audience both more time to rest *and more opportunities to absorb the technical concepts and terminology*. Final Act. 8; Ans. 11.

In rejecting claim 2 as indefinite, the Examiner finds the claim includes indefinite features such as: (1) *creating a user experience* ***that is not as rich as a traditional movie****, but rather, equivalent to sitting each night in the same scenic environment, and listening to friends talk about different topics*; (2) *storing the intellectual content component of media, separately from those of its aspects that* ***merely create a pleasant ambiance and help block out distractions***; (3) ***representing the intellectual content using mere text files****, interspersed with commands that are understandable to the aforementioned media player (which has* ***multi-voice text to speech capabilities*** *that it uses to read the intellectual content out loud, using voices specified by the media authors, using the afore mentioned commands) and that has been specifically designed to* ***ignore requests to play still images*** *it can not find (****in order to facilitate dissemination of the more important and less space consuming intellectual content component*** *of the media* ***over*** *the kinds of* ***unreliable low bandwidth telecommunications networks****)*. Final Act. 8; Ans. 11.

The Examiner does not, however, provide sufficient support to show that either claim 1 or claim 2 is indefinite. The Examiner states that "[t]hese description[s] of the feature limitations are indefinite" (Final Act. 8) without explaining why the features are indefinite. With respect to claim 2, in particular, the Examiner finds that the last element "of claim 2 is particularly confusing," without any explanation as to what is confusing (i.e., ambiguous). *See* MPEP § 2173.02.III.A (9th ed., rev. 08.2017 (Jan. 2018)) ("the examiner should clearly communicate in an Office action any findings

and reasons which support the rejection and avoid a mere conclusion that the claim term or phrase is indefinite."). The Examiner adds that "[t]t is not clear what limitations these description[s in claim 2] will add to the claim." *Id.* But recitations that do not limit a claimed invention (e.g., an intended use) do not necessarily render the claim indefinite.

Accordingly, we do not sustain the Examiner's 35 U.S.C. § 112(b) rejection of claims 1[4] and 2.

35 U.S.C. § 103—CLAIM 1

In rejecting claim 1 as obvious, the Examiner finds that Crystal's content zoom—which relates to organizing, accessing, and presenting different levels of detail—teaches or suggests most of the claim recitations. Final Act. 9–11 (citing Crystal ¶¶ 5, 29, and 52–57). The Examiner relies, however, on Henning's container objects—storing collaboration threads or conversations—to teach or suggest recitations related to designating

[4] Although we do not sustain the Examiner's 35 U.S.C. § 112(b) rejection based on the record before us, in the event of further prosecution, the Examiner should also ascertain whether the term "container" is unclear. Appellant acknowledges using "the word 'container' merely to refer concisely to either a text file that contains an explanation fragment, or a portion of a text file that contains an information fragment." Appeal Br. 23. But the Specification, which does not explicitly disclose the meaning of a "container," discloses a "hierarchical system [that] provides . . . means to store many versions of vast collections of text fragments." Spec. 10. This may evince that the term "container," given its broadest reasonable interpretation in light of the Specification, *alternatively* encompasses folders or directories that may contain text files. If *container*, as recited, "is amenable to two or more plausible claim constructions," then such ambiguity may support an additional basis for rejecting claim 1 under 35 U.S.C. § 112(b). *See Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential).

containers as being intended to be used to *house monologues that explain a technical concept* or as *equivalent locations in different conversations*. Final Act. 11–12 (citing Henning ¶ 13).

Appellant contends the Examiner erred because, although Crystal discusses "the concept of multiple levels of detail," Crystal does not discuss "providing authors of technical educational media with a way to provide their audiences with a way to adjusting the information density of an explanation in order to reduce the cognitive burden to which their audiences are subjected." Appeal Br. 22. That is, Appellant argues Crystal does not "discuss the concept of providing authors of technical educational media, with a way to provide their audiences with a way to request that information which has already been presented, be presented again using different words in order to reduce the probability that an explanation has been misunderstood." *Id.* Appellant also argues Crystal describes a solution to a problem that is "extremely different . . . from the problem on which [the claimed invention] is focused." *Id.*

Appellant's arguments are unpersuasive to the extent that they rely on preamble recitations. *See* Ans. 13. Preamble recitations are only given patentable weigh if they recite "essential structure or steps, or if [they are] 'necessary to give life, meaning, and vitality' to the claim." *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (citing *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). No such showing has been made here.

Appellant's arguments are also unpersuasive to the extent they rely on unclaimed features. *See* Ans. 14. Appellant critiques the Examiner for continuing "to focus on the language of [the] claims," and argues the

Examiner is "misrepresent[ing] the purposes and functions of the inventions." Reply Br. 9. The United States, however, "is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable." *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) (quoting Giles Sutherland Rich, *Extent of Protection and Interpretation of Claims—American Perspectives*, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990)). Therefore, the Examiner properly focused on the claim recitations in ascertaining whether claim 1 is obvious.

Furthermore, "[i]n examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification." *In re Bass*, 314 F.3d 575, 577 (Fed. Cir. 2002) (citing *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984)). Limitations, however, "are not to be read into the claims from the [S]pecification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Moreover, "a prior art reference is relevant for all that it teaches to those of ordinary skill in the art." *In re Fritch*, 972 F.2d 1260, 1264 (Fed. Cir. 1992) (citing *Beckman Instruments Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989)).

Given Crystal's broadly applicable disclosure that its content zoom teachings "can be applied to substantially any content stored and/or accessible by a computing device such as but not limited to video content, photographic content, textual content, word processor content, image content, products, and other such content" (Crystal ¶ 52), we are unable to

discern error in the Examiner's reliance on Crystal (*see, e.g.*, Final Act. 9–11).

Appellant further argues that Henning does not teach conversations as "discussions between people using words, but rather, histories of collaborations between people in an electronic collaboration environment." Appeal Br. 22. Appellant acknowledges, however, that Henning teaches conversations include "contributions, in the form of mail messages, text messages, document attachments, presentations, and other similar work products, that people have contributed to a project." *Id.*; *see also* Henning ¶ 13. Appellant argues that these contributions "are not spoken words." Appeal Br. 22. Claim 1 does not, however, recite "spoken word" conversations. Nor does Appellant otherwise persuasively distinguish the disputed claim recitations from Henning's storage of "the real-time communication history, shared content, and collaborative events associated with a given multi-modal conversation between a set of participants." Henning ¶ 13; *see also, e.g.*, Henning Figs. 4A–6B (cited in Ans. 15). Therefore, we do not find error in the Examiner's reliance on Henning, in combination with Crystal, to teach or suggest the disputed recitations of claim 1. *See, e.g.*, Final Act. 11–12.

Accordingly, we sustain the Examiner's 35 U.S.C. § 103 rejection of claim 1.

35 U.S.C. § 103—CLAIM 2

In rejecting claim 2 as obvious, the Examiner finds that Steele's storage of text content as extensible markup language (XML) and graphics as scalable vector graphics (SVG)—along with Steele's use of audio clips—teaches or suggests *storing the intellectual content component of media*

separately from those of its aspects that merely create a pleasant ambiance and help block out distractions. Final Act. 12–13 (citing Steele ¶¶ 47, 50, 52); *see also* Ans. 16–17 (further citing Steele ¶ 116, Fig. 16).

Appellant contends the Examiner erred because: (1) "Steele does not assert the benefit of creating rich media in which intellectual content [represented using text] has been separated from graphical and auditory content"; (2) "Steele is not at all focused on helping authors of technical educational materials protect their intellectual content from being made obsolete as file formats and media players become obsolete"; (3) "Steele is not focused on creating and presenting a specialized type of educational media"; (4) Steele does not "represent instructional materials in a decomposed form"; and (5) "Steele does not decompose media into intellectual content and ambiance focused content." Appeal Br. 24–25; *see also* Reply Br. 9. That is, Appellant argues the Steele's *content* does not represent "intellectual content," "technical educational materials," "educational media," "instructional materials," or "ambiance focused content."

Appellant's arguments are unpersuasive because claimed non-functional descriptive material (e.g., content) is not entitled patentable weight absent a new and unobvious functional relationship between the descriptive material and the underlying device or substrate. *See Ex parte Nehls*, 88 USPQ2d 1883, 1887–90 (BPAI 2008) (precedential); *see also In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004). Furthermore, an "[]intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention

operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003).

We further note that, in accordance with the Examiner's findings (Ans. 16), Steele teaches the concurrent rendering of multiple media components "image rendering, spring animation, rendering, filled and unfilled rectangle rendering, polygon, point, and polyline rendering, text rendering, and text font and style selection," with "advanced operation [such] as constant, linear and cubic animation paths, animation of sprites, objection positions and color, and audio clip rendering" (Steele ¶ 50). Moreover, as the Examiner's findings show (Ans. 16), Steele teaches separating, for example, textual XML content and graphic content such as SVG images (*see* Steele ¶¶ 47, 52). Thus, the Examiner's findings show that, in light of Steele, it would have been obvious to an artisan of ordinary skill to render multiple separately stored media sources, such as multiple audio clips, concurrently. Moreover, contrary to Appellant's arguments (Appeal Br. 25), it would have been obvious to an artisan that media sources could be reused or remixed with other media sources when stored separately (i.e., isolated).

Accordingly, we sustain the Examiner's 35 U.S.C. § 103 rejection of claim 2.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1, 2	101	Eligibility		1, 2
1, 2	112(a)	Written Description	1	2
1, 2	112(b)	Indefiniteness		1, 2
1	103	Crystal, Henning	1	
2	103	Steele	2	
Overall Outcome			1, 2	

TIME PERIOD FOR RESPONSE

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. § 1.136(a)(1)(iv).

AFFIRMED