



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/109,272	12/17/2013	Jeffrey D. Zigler	312-DDG-09-2008	4824
86548	7590	09/10/2019	EXAMINER	
Garlick & Markison (IH) 100 Congress Avenue, Suite 2000 Austin, TX 78701			WILLIS, AMANDA LYNN	
			ART UNIT	PAPER NUMBER
			2158	
			NOTIFICATION DATE	DELIVERY MODE
			09/10/2019	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

MMurdock@TEXASPATENTS.COM
bpierotti@texaspatents.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEFFREY D. ZIEGLER, RICHARD D. WOODEN,
JACQUELINE J. LOCKHART, KEVIN R. LOCKHART,
THEODORE N. MYERS, and EVAN A. HILL¹

Appeal 2018–008308
Application 14/109,272
Technology Center 2100

Before BRADLEY W. BAUMEISTER, SHARON FENICK, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1, 2, 4–7, 9, 10, and 12–20, which constitute all the claims pending in this application. Appeal Br. 6, 16, 22.² We have jurisdiction under 35 U.S.C. § 6(b). We affirm the Examiner’s rejection under 35 U.S.C. § 101 and reverse the rejection under 35 U.S.C. § 103.

¹ Appellants list iHeartMedia Management Services, Inc. as the real party in interest. Appeal Brief filed March 15, 2018 (“Appeal Br.”) 3.

² Rather than repeat the Examiner’s positions and Appellants’ arguments in their entirety, we refer to the above-mentioned Appeal Brief, as well as the following documents for their respective details: the Final Action mailed October 18, 2017 (“Final Act.”); the Examiner’s Answer mailed June 25, 2018 (“Ans.”); and the Reply Brief filed August 22, 2018 (“Reply Br.”).

THE INVENTION

Appellants' invention is directed to the use of a dynamic media file that may be used with other media files on a user's device, such as songs in MP3 format. Spec. ¶¶ 4, 21. The dynamic media file may include perishable or time-sensitive content such as news, sports scores, DJ chatter, emergency information, or advertisements. *Id.* ¶ 22. The dynamic media files can be included in the playlist to include a more radio-like listening experience. *Id.* A user may download a dynamic audio file from the server, and include it in the playlist. *Id.* The user also may download updater software to allow the user to set dynamic audio file preferences, and may extract update instructions from a dynamic audio file. *Id.* ¶¶ 22, 28.

In one exemplary embodiment of the invention, update information distributed with dynamic audio files may include links to content sources that provide updated content. *Id.* ¶ 31. The links ensure that the dynamic audio files properly replace previous content to be displayed on the user's device with updated content. *Id.*

A user may provide settings as to various types of music, news, or radio talk shows that the user would prefer to be downloaded, which may be part of a the updater software. *Id.* ¶ 34. A user may elect to receive dynamic audio content from multiple content sources, such as music from one source, news from a second source, and traffic reports from a third source. *Id.* ¶ 35.

The dynamic audio file more specifically may include metadata attributes including the file's unique identifier, the date the file was created, a date when the file expires and audio content should be replaced with updated audio content from a specified uniform resource locator (URL) link,

and the type of audio content (*e.g.*, news, weather, traffic, music). *Id.* ¶¶ 37–40; Table 1. A user interface may be used to allow a content publisher or other user to create this dynamic audio file by setting various variables and preferences. *Id.* ¶ 59. These preferences may include a file path to a source file for the audio content used in the dynamic audio file, an indication that the dynamic audio file is a member of a set of files stored on a user’s computer, and indication of the position of the dynamic audio file within the set of files. *Id.* ¶¶ 20, 60, 62.

Claim 1 illustrates the claims at issue, with limitations numbered for reference:

1. A method of providing advertisements, the method comprising:

[i] receiving user profile information associated with a plurality of different users at a server computer via a communications network;

[ii] generating a dynamic media file including a plurality of user-selected metadata attributes which include a source link address to link with content via a universal resource locator file path, wherein the generating the dynamic media file further including:

[a] indicating that the dynamic media file is a member of a set of media files via a SetMember attribute of the plurality of user-selected metadata attributes; and

[b] specifying a position of the dynamic media file within the set of media files via a SetPosition attribute of the plurality of user-selected metadata attributes;

[iii] providing, for inclusion with the set of media files, the dynamic media file to each computing device associated with the plurality of different users via the communications network;

[iv] receiving, from the each computing device a request for the content directed to the source link address; and

[v] in response to the requests for the content directed to the source link address, transmitting different content to the each computing device associated with the plurality of different users, based on the user profile information associated with the plurality of different users.

Appeal Br. 24 (Claims Appendix).

I. THE SECTION 101 REJECTION

Principles of Law

SECTION 101:

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101.

However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012), and *Alice*. *Alice*, 573 U.S. at 217–18 (citing *Mayo*, 566 U.S. at 75–77). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental

economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’” sufficient to ‘transform’ the claimed abstract idea into a patent-

eligible application.” *Alice*, 573 U.S. at 221 (citation omitted). “A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

USPTO SECTION 101 GUIDANCE:

The United States Patent and Trademark Office (“USPTO” or “the Office”) recently published revised guidance on the application of § 101. USPTO’s Memorandum, 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Guidance”). Under the 2019 Guidance, we first look to whether the claim recites the following:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activities such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

2019 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.

2019 Guidance, 84 Fed. Reg. at 56.

The Examiner’s Rejection and Appellants’ Contentions

The Examiner rejects claims 1, 2, 4–7, 9, 10, and 12–20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. According to the Examiner, “the claimed invention is directed to an abstract idea without significantly more.” Final Act. 2. More specifically, the Examiner determines that the claims “are directed to the court[-]identified idea of ‘customizing information and presenting it to users based on particular characteristics,” citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363 (Fed. Cir. 2015). *Id.* The Examiner states that the claims “recite transmitting different content to each computing device associated to the plurality of different users, based on the user profile information associated with the plurality of different users” which, according to the Examiner, “appears substantially similar to the court[-] identified abstract idea” in *Capital One Bank*. *Id.* at 2–3.

The Examiner determines that “the claims recite additional elements in the form of transmitting content in response to a request for content,” but that “[t]his claim limitation appears to amount to a well-understood, routine, and conventional activity previously known to the industry, specified at a high level of generality.” *Id.* at 3. The Examiner determines that the “act of receiving or providing information appears to be insignificant extra[-] solution activity in the form of data gathering and presentation” and “appear[s] to be executed by generic computers performing well-understood,

routine, and conventional activities previously known to the industry.” *Id.* The Examiner further determines that the “act of generating a dynamic media file including metadata and attributes appear to amount to a well-understood, routine, and conventional activity previously known to the industry, specified at a high level of generality.” *Id.* at 4.

Appellants respond that they are “not claiming to have invented ‘customizing information and presenting it to users based on particular characteristics,’ or even a new way of customizing information and presenting it to users based on particular characteristics.” Appeal Br. 10. To the contrary, Appellants argue, their claims “are directed to an improvement in currently existing methods for facilitating advertising in multi-user networks,” which improvement is achieved by “receiving user profile information associated with a plurality of different users at a server computer via a communications network; generating a dynamic media file including a plurality of user-selected metadata attributes, which include a source link address to link with content via a universal resource locator file path . . .; and in response to the requests for content directed to the source link address, transmitting different content . . . based on the user profile information . . .” *Id.* at 10–11.

Appellants assert that this method “improves the performance of advertising provisioning by allowing the system to collect user profile information and generate a single ‘dynamic’ file that can be packaged with media files to provide content matched to each of a plurality of user computing devices.” *Id.* at 11. Thus, Appellants contend, “when all elements are considered in combination, the [] claims recite a technological solution (generating a single dynamic media file with user-selected attributes

for inclusion with media files) to a technological problem (matching media selections with targeted content to each user in a multi-user system).” *Id.* at 12.

Appellants further argue that their claims are distinguishable from those in *Capital One Bank* because Appellants’ claims “are not simply customizing information and presenting it to users based on particular characteristics,” but, instead, “recite a particular technique that can be used to improve the performance of automated advertisement insertion systems.” *Id.* at 13. Appellants argue that contrary to the claims of *Capital One Bank*, their claims are patent eligible like those in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014) because Appellants’ claims “recite a specific technical implementation of efficiently providing user specific content to multiple users” including, for example, “generating a dynamic file from (multiple) user profile information, including it with desired media files and thereby providing unique content for each user,” which “improves operation of existing user targeted content systems.” *Id.* at 15.

Analysis under Step 2A, Prong 1, of the 2019 Guidance

Under Step 2A, Prong 1, of the 2019 Guidance, we first must determine whether claim 1 recites any judicial exception to patent eligibility. The 2019 Guidance identifies three judicially excepted categories of abstract ideas: (1) mathematical concepts, (2) certain methods of organizing human behavior such as fundamental economic practices, and (3) mental processes. 2019 Guidance, 84 Fed. Reg. at 52–53. The Examiner determines that the claims recite “customizing information and presenting it to users based on

particular characteristics.” Final Act. 2. We agree that the claims’ method steps reasonably can be characterized as reciting one or more abstract ideas.

Claim 1 recites a “method of providing advertisements” including the limitations of “receiving user profile information associated with a plurality of different users,” “receiving . . . a request for the content,” and “in response to the requests for the content . . . , transmitting different content to the each computing device associated with the plurality of different users, based on the user profile information associated with the plurality of different users.” These limitations reasonably can be interpreted as reciting a method of “customizing information based on [] information known about the user,” which the Federal Circuit held to be “a fundamental . . . practice long prevalent in our system” in *Capital One Bank*. 792 F.3d 1369-70. Furthermore, these limitations reasonably can be characterized as methods involving commercial interactions including advertising, marketing, or sales behaviors. *See, e.g.*, Spec. 22 (stating that a dynamic audio file may provide advertisements and station jingles).

For example, the provision of advertising using a dynamic media file with a link to content is analogous to the pre-Internet activity of providing advertising in a magazine that includes advertisements interspersed among other content, such as articles. Such a magazine advertisement could include a telephone number that a user could call to receive content, such as literature or information about a product or service or the ability to participate in a contest or sweepstakes. This telephone number acts as a link to the content.

Such a magazine advertisement also could be characterized reasonably as being “dynamic” in the sense that the information that the user

receives when calling the telephone number could be changed over time based on a variety of factors. The information also could be altered based on information about the user, such as the user's location (as indicated, for example, by the area code that the user calls from), or information that the user may provide to the advertiser.

Such an advertisement might further include a page number, reference code, or similar indicator indicating (1) that the advertisement is part of a set (a particular magazine) of media files or entities (the articles and other advertisements in the magazine), as well as indicating (2) where in the set (which page of the magazine) the advertisement is located. The position of the advertisement in the magazine also could be customized based on information about the user (for example, the user's area of residence) by altering the contents of editions of the magazine to target articles or advertising to different regions in which readers live. Customizable designations of (1) in which magazine and (2) on what page of the magazine the advertisement appears are analogous to the `SetMember` and `SetPosition` attributes in claim 1.

Such methods of advertising reasonably may be characterized as certain methods of organizing human activity that the 2019 Guidance expressly recognizes as constituting patent-ineligible abstract ideas. 2019 Guidance, 84 Fed. Reg. at 52.

The method step of providing a file with metadata such as `SetMember` and `SetPosition` attributes additionally is analogous to the pre-Internet activity of a librarian providing books and other media with classification metadata, such as Dewey decimal system call numbers. These call numbers indicate the collection to which the particular media belongs (e.g., science

fiction) and indicate the order within the specified collection the particular media is to be placed.

Assigning such classification metadata to media reasonably can be characterized as cataloguing or recordkeeping—a method that can be performed in the human mind with the aid of pencil and paper. Mental processes that can be performed in the human mind, including observation, evaluation, judgment, and opinion, constitute another category of patent-ineligible abstract ideas that the 2019 Guidance expressly recognizes. *Id.*

Furthermore, the fact that claim 1 recites multiple abstract ideas does not make the claim patent eligible. A claim need not be addressed to a single abstract idea to be patent ineligible and, as our reviewing court has held, combining several abstract ideas does not render a combination any less abstract. *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea . . . to another abstract idea . . . does not render the claim non-abstract.”); see also *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (patent-ineligible claims were directed to a combination of abstract ideas).

For these reasons, we are persuaded that claim 1 recites one or more abstract ideas.

Analysis under Step 2A, Prong 2, of the 2019 Guidance

Having determined that the claims recite a judicial exception, we next inquire whether the claims recite “additional elements that integrate the judicial exception into a practical application.” *See* 2019 Guidance, 84 Fed. Reg. at 54; MPEP § 2106.05(a)–(c), (e)–(h). We determine that the claims do not recite such additional elements.

First, the claims do not recite an improvement to the function of a computer or to any other technology or technical field. MPEP § 2106.06(a). Appellants argue that their invention “improves the performance of advertising provisioning by allowing the system to collect user profile information and generate a single ‘dynamic’ file that can be packaged with media files to provide content matched to each of a plurality of user computing devices.” App. Br. 11. But, as discussed above, this aspect of the claim is analogous to earlier methods of providing advertising, such as including an advertisement in a magazine along with other content, and placing in the advertisement a telephone number that links to changing content that can be matched to the characteristics or desires of different users. As such, the argued improvement relates to the automation of an underlying abstract idea. It is well settled that “mere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology.” *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017).

Appellants have not established that the claimed invention provides an improvement in the functioning of the computer itself, such as the self-referential table of *Enfish*, which “functions differently than conventional database structures” and was designed “to improve the way a computer stores and retrieves data in memory” compared to “conventional data structures.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337, 1339 (Fed. Cir. 2016). Rather, it appears that the use of a file, along with a universal resource locator file path, and metadata indicating the position of the file, are all uses of conventional computer components utilized in their intended manner to improve the claimed advertising method. Thus,

receiving user profile information and, in response, providing a file that specifies a link or path to the desired media content does not constitute an improvement to computers, but, rather, merely constitutes an improvement to the underlying abstract idea—customizing advertisements.

Appellants’ Specification reinforces our conclusion that the claimed invention merely constitutes an improvement to the abstract idea of customizing advertisements, as discussed above. Appellants expressly characterize their invention as producing a customized listening experience that more closely resembles pre-Internet radio listening, not as an improvement to computer technology:

The user may desire [to] listen to more than an unbroken series of songs or similar audio elements. Thus, a dynamic audio file may be included in the user’s playlist to allow the user to listen to perishable, or relatively time-sensitive, content or other types of content. Examples of perishable content include daily news, sports scores, DJ chatter, traffic reports, emergency information, public service announcements (PSAs), talk show programs, personal messages and weather reports. A dynamic audio file may also be included in the user’s playlist to provide new songs, e.g., updatable incorporation of Top-10 songs into the playlist, or other content, such as advertisements and station jingles. *By including one or more dynamic audio files, a playlist may provide, for example, a more radio-like listening experience.*

Spec. ¶ 22 (emphasis added).

Appellants also indicate that their invention is not tied to any particular technology, much less assert that their invention improves any particular technology:

Accordingly, the user may download from server 1 a dynamic audio file, and include the dynamic audio file in the playlist. The user may also download updater software provided to allow the user to set dynamic audio file preferences. *Those having skill in*

the art will recognize that the user may obtain a dynamic audio file and updater software in other ways, such as on CD or by RSS feed.

Id.

Appellants, therefore, have failed to establish that the claims are directed to improving the functioning of a computer or do more than simply improve upon an abstract idea. For similar reasons, we see insufficient evidence that the claim recites a particular machine, produces a particular transformation, or adds any other meaningful limitations. *See* MPEP § 2106.05(a), (b), (e). As such, Appellants do not persuade us that the Examiner erred in determining that claim 1 fails to integrate the recited abstract ideas into a practical application.

Analysis under Step 2B of the 2019 Guidance

Consistent with step 2B of the 2019 Guidance, the Examiner has determined that the additionally recited claim elements that go beyond the abstract idea, when considered individually and as part of an ordered combination, are “well-understood, routine and conventional activities previously known to the industry, [and] specified at a high level of generality.” Final Act. 3. For example, the Examiner notes that the claim recites generating a dynamic media file that includes user-selected metadata attributes by providing the file with a URL, but that “[t]he claims do not recite any detail regarding how the dynamic media file is generated beyond that it includes metadata and URLs, which [was] standard in the art.” *Id.*

The Examiner also notes that “[c]omputer networks are generally use[d] to transmit information,” and she determines that receiving and providing information constitutes extra-solution activity in the form of data gathering and presentation. *Id.*

Appellants’ Specification supports the Examiner’s conclusion that the additionally recited elements, when considered individually and as part of an ordered combination, merely constitute well-understood, routine, and conventional activities. For example, Appellants Specification states that “[a] dynamic audio file may be created either manually or automatically by use of assembly software.” Spec. ¶ 56. Appellants provide insufficient evidence that there was anything technologically challenging or new about creating *manually* a file that includes a URL link. *See generally* App. Br.

Furthermore, even if the claims were limited to creating the dynamic audio file automatically, it also is doubtful whether there is anything technologically challenging or new about creating the dynamic file automatically through the use of assembly software. Appellants’ Specification, instead, indicates that this task is performed with XML assembly software (*id.*)—a conventional computing language.

Conclusion

For the reasons set forth above, Appellants have not persuaded us that the Examiner erred in concluding that claim 1 is directed to patent-ineligible subject matter. As a result, we sustain the rejection of Claim 1 as being directed to patent-ineligible subject matter. We likewise sustain this rejection of claims 2, 4–7, 9, 10, and 12–20, which Appellants do not argue separately. *See* App. Br. 16; *see also* 37 C.F.R. § 41.37(c)(1)(iv).

II. THE SECTION 103 REJECTIONS

The Examiner rejects claims 1, 2, 4–6, 9, 10, 12, 14 and 16–20 as unpatentable over Bodin (US 2003/0135608 A1; published July 17, 2003) in

view of Berkson (US 2004/0148424 A1; published July 29, 2004) and Fedorovsky (US 2002/0099798 A1; published July 25, 2002).

The Examiner rejected claims 7 and 15 as unpatentable over Bodin in view of Berkson, Fedorovsky, and Weintraub (2008/0141328 A1; published June 12, 2008).

Claims 1, 2, 4–7, 9, 10, 12, 14, and 15

REJECTIONS AND CONTENTIONS

Claim 1 illustrates the subject matter of claims 1, 2, 4–7, 9, 10, 12, 14, and 15. The Examiner relies on the combination of Bodin and Berkson for teaching or suggesting all of the limitations of claim 1 with two exceptions. Final Act. 6–10.³

More specifically, the Examiner finds that the combination of Bodin and Berkson “does not explicitly teach setting a SetMember attribute of the plurality of user-selected metadata attributes indicating that the dynamic media file is a member of a set of media files,” or “setting a SetPosition attribute of the plurality of user-selected metadata attributes specifying a position of the dynamic media file within the set of media files.” *Id.* at 7. The Examiner finds that these limitations are taught by Fedorovsky, though, and the Examiner determines that motivation existed for combining Fedorovsky’s teachings with those of Bodin and Berkson. *Id.* at 7–8.

Appellants argue, *inter alia*, that the prior art lacks multiple limitations of claim 1, including: (1) generating a single dynamic media file for use by multiple users; (2) the SetMember and SetPosition attributes of the dynamic media file; and (3) a source link address to content via a

³ The Examiner’s rationale for combining Bodin and Berkson is addressed in more detail below in relation to the analysis of the rejection of claims 16–20.

universal resource locator file path. Appeal Br. 18–21. Of particular relevance, Appellants argue that “while Federovsky refers to an ‘offset[,]’ it is wholly different from the SetMember attribute required in appellant’s claim 1. *Id.* at 19.

Appellants contend that “Federovsky is directed at a method for making file transfers when files are made up of multiple data segments.” *Id.* (citing Federovsky, Abstract). Appellants argue that

in context, an “offset” as used by Federovsky, is used by a dynamic file database record to indicate what portion of a file (where a portion is one or more data segments) has been downloaded by a client. (the dynamic file database record may indicate the position within the virtual file to which a client download has progressed.

Id. (citing Federovsky ¶ 0032).

Appellants argue the claimed SetMember attribute differs from Federovsky’s offset because

a SetMember attribute is used for “specifying a position of the dynamic media file within the set of media files.” Accordingly, there are a number of discrete media files [on the user’s computing device], and the SetMember attribute is used to place the dynamic media file in a particular position within those media files.

App. Br. 19.

Appellants also argue that the claimed SetPosition attribute is not taught by Federovsky:

the SetPosition is used to provide “for inclusion with the set of media files, the dynamic media file to each computing device associated with the plurality of different users”. Federovsky, being directed at a transfer of data segments of a file, would not have relevance for placing a (dynamic media) file in a particular position for each of a plurality of users. (i.e. an offset could/would not be the same for each of a plurality of clients).

App. Br. 19.

ANALYSIS

We agree with Appellants. Claim 1 requires that the SetMember attribute indicate the particular set of media files of which the dynamic media file will be a member. Claim 1, limitation ii(a). Claim 1 also requires that the SetPosition attribute specify the particular position within the set of media files that the dynamic media file will be located. Claim 1, limitation ii(b). Furthermore, claim 1 requires that both the SetMember attribute and the SetPosition attribute are user-selected meta-data attributes. Claim 1, limitations ii(a), (b). As such, it is the user’s computing device that provides the server computer with the computer-specific meta-data attributes that enables the user’s computing device to receive the dynamic media file at a file location that is unique to each computing device.

The Examiner relies on paragraph 93 of Federovsky for teaching this functionality. Final Act. 7–8. But this passage of Federovsky does not teach or suggest that the offset is selected by the user. Federovsky ¶ 93, *cited in* Final Act. 7–8. This passage, instead, deals with the procedure for performing a seek operation within a dynamic file, as set forth in the flowchart of Figure 7. Federovsky ¶ 93. Federovsky alternatively teaches that “[t]he dynamic file database [located on the central file transfer server] may contain a record for each request, the record identifying the data segments to be sent to the client in order to meet the request.” Federovsky ¶ 32.

For these reasons, the Examiner has not established the obviousness of independent claim 1, of independent claims 9, which recites similar limitations, or of claims 2, 4–6, 10, 12, and 14, which depend from claims 1

and 9. We therefore do not sustain the obviousness rejection of claims 1–2, 4–6, 9, 10, 12–14.

We, likewise, do not sustain the obviousness rejection of claims 7 and 15. The Examiner does not rely on the additionally cited reference, Weintraub, to cure the deficiencies of claims 1 and 9, noted above.

Claims 16–20

Independent claim 16 reads as follows:

16. A method of providing advertisements, the method comprising:

receiving user profile information associated with a plurality of different users at a server computer via a communications network;

generating a dynamic media file based on the user profile information that includes a plurality of user-selected metadata attributes, wherein the generating the dynamic media file includes specifying a network location from which to retrieve an advertisement to be presented to a user of the plurality of different users prior to presenting other media content to the user via setting a PreRoll attribute of the plurality of user-selected metadata attributes;

providing, for inclusion with the other media content, the dynamic media file to computing devices associated with the plurality of different users via a communications network;

receiving, from the computing devices, requests to retrieve the advertisement from the network location specified via the PreRoll attribute; and

in response to the requests to retrieve the advertisement from the network location, transmitting different advertisements to the plurality of different users, based on the user profile information associated with the plurality of different users.

CONTENTIONS AND ANALYSIS

Appellants argue claims 16–20 on the same basis as claim 1. App. Br. 21. Independent claim 16, though, does not include claim language regarding the SetMember attribute or the SetPosition attribute. Accordingly, we review the rejection of claims 16–20 based upon the remaining arguments that Appellants present in relation to claim 1—arguments regarding the combination of Bodin and Berkson. More specifically, we address Appellants’ remaining argument that the prior art does not teach or suggest a dynamic media file, much less a dynamic media file that is transmitted to a plurality of users. App. Br. 17.

In support of this general argument, Appellants first argue more specifically that contrary to the Examiner’s findings, Bodin does not disclose generating and downloading to individual users, dynamic media files that are used for transmitting different content to each user’s computing devices. *Id.* at 17–18. Appellants argue that the cited portions of Bodin instead disclose transmitting personalized, but final content that Bodin calls “preferred location specific content records” (“PLSC”):

[A]ppellant’s claim 1 includes generating a dynamic media file that is used for “transmitting different content to the each computing device associated with the plurality of different users”. Bodin, on the other hand, creates a unique PLSC for each client that is then distributed individually to client(s). The location specific nature of the “location specific content” underscores that each receiver of a PLSC will, by definition, be in a different location, therefore a single PLSC would not be useful for more than one individual client, unless multiple users with identical user records and locations were somehow possible.

Id. at 18 (citing Bodin ¶¶ 51, 53, 60).

This argument is unpersuasive because it does not correspond to the Examiner’s theory of the rejection. To be sure, the Examiner initially states that Bodin, itself, teaches generating a dynamic media file. *E.g.*, Final Act. 6. But the Examiner later states that the combination of Bodin and Federovsky “does not teach receiving, from each computing device, a request for content directed to the source link address.” *Id.* at 8. And the Examiner further relies on Berkson for teaching this limitation, as well as for teaching subsequently “transmitting different content to each computing device associated with the plurality of different users as automatically downloading an updated file from the central server.” *Id.* at 8–9 (emphasis omitted). Thus, reading the rejection as a whole, it reasonably is clear that the Examiner is, in fact, relying on Bodin, *as modified by Berkson*, for teaching a “dynamic media file,” as that claim term is being used by Appellants.

Appellants next argue that “Berkson does not teach ‘a source link address to link with content via a universal resource locator file path,’” and one of ordinary skill would not have combined Bodin and Berkson to produce the dynamic media file, as claimed. App. Br. 21.

Berkson . . . is concerned with enforcing advertising with free media content. . . . Given that the motivation of the teachings of Berkson is to provide otherwise restricted media in exchange for exposure to advertising, it would be antithetical to direct a Berkson user to an unrestricted source to retrieve the same media. Indeed, the Berkson user, (*Ibid.*) is “directed to central server . . . version of same media content . . . to automatically download that file from central server with the updated ad”, whereas in appellant’s claim 1 it is the content link that is included in the dynamic media file. In other words, the Berkson advertising content is part of the media file, (it all comes together with or without the restrictions) whereas the appellant’s claim 1

is dynamically providing linkage to content to add to advertising content for unique treatment for each of a plurality of users.

Id.

Contrary to Appellants’ assertion, we do not understand the rejection to be premised upon combining the references to produce a protocol that directs a user to an unrestricted source to retrieve otherwise restricted material. *See* Final Act. 6–10. We understand the Examiner’s theory of the rejection, instead, to be that it would have been obvious to modify Bodin’s preferred location specific content records to include Berkson’s source address and, thereby, produce a dynamic media file, as claimed. *See id.*

That is, we understand the Examiner’s position to be that as opposed to transmitting personalized final content to a user’s computing device (1) in the form of Bodin’s preferred location specific content records and (2) for inclusion within a collection of other content, as disclosed by Bodin, it, instead, would have been obvious to have transmitted personalized links to a central server so that updated advertisements or information could be transmitted periodically to the user’s computing device. *See* Ans. 8–9.

Appellants do not persuasively explain why it would have been a concern to provide unrestricted access only to updated advertisements—as opposed to unrestricted access to the other restricted content, as well. *See generally* App. Br. Furthermore, Berkson teaches that advertising content “can be replaced or updated” by automatically downloading the updated advertisement from a central server. Berkson ¶ 60.

As such, Appellants do not persuade us that the Examiner erred in combining Bodin and Berkson to produce a dynamic media file, as recited in independent claim 16. We therefore sustain the obviousness rejection of

Appeal 2018–008308
Application 14/109,272

independent claim 16 and also dependent claims 17–20, which Appellants do not argue separately. *See* App. Br. 21.

CONCLUSIONS

We sustain the Examiner’s decision rejecting claims 1–2, 4–7, 9, 10, and 12–20 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

We do not sustain the Examiner’s decision rejecting claims 1–2, 4–7, 9, 10, 12–15 as unpatentable under 35 U.S.C. § 103.

We do sustain the Examiner’s decision rejecting claims 16–20 as unpatentable under 35 U.S.C. § 103.

DECISION

The Examiner’s decision rejecting claims 1–2, 4–7, 9, 10, 12–20 is affirmed.

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