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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GARY M. ZALEWSKI

Appeal 2019-000386
Application 11/844,148
Technology Center 2100

Before SHARON FENICK, MICHAEL M. BARRY, and
RUSSELL E. CASS, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 29–36, 49–53, and 55–61, which are all the pending claims. *See* Final Act. 1; *see also* Appeal. Br. 11–51. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ We use “Appellant” to refer to the “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Sony Interactive Entertainment America LLC as the real party in interest. Appeal Br. 4.

Introduction

The invention relates generally to providing an approach for dynamic interaction with a media presentation and, more particularly, to providing an approach for linking time-based metadata to media content so that as the metadata changes in synchronicity with media content during media play or rendering, information associated with the media content can be outreached in the context of the media presentation.

Spec. ¶ 2.

Claim 29 is illustrative of the claims on appeal:

1. A computer-implemented method for presenting supplemental content on one or more ancillary devices, comprising:
 - establishing, by a computing system, a wireless connection between the one or more ancillary devices and a main display, the computing system is local to the one or more ancillary devices and the main display;
 - detecting, by the computing system, presentation of content of a media source on the main display while the one or more ancillary devices and the main display are connected, wherein certain images or parts of images within the content are associated with respective metadata information, that is time-based and identifies supplemental content that is in addition to the content of the media source, and the respective metadata information is not subtitle data;
 - receiving at the computing system respective preference settings for the one or more ancillary devices, the respective preference settings are defined for descriptive content categories via a user interface by a user while interfacing with one of the one or more ancillary devices, the respective preference settings is used for identifying which of the respective metadata information is to be processed for retrieving respective supplemental content for each of the one or more ancillary devices, wherein respective supplemental content related to the processed metadata information is displayed on the one or more ancillary devices during the

presentation of the content on the main display, and the respective metadata information available for processing during presentation of the content changes in synchronicity as the content changes during presentation of the content on the main display;

retrieving, by the computing system, the respective supplemental content from one or more online sources, the respective supplemental content are not obtained via the media source; and

sending, by the computing system during presentation of the content of the media source on the main display, the respective supplemental content to each of the one or more ancillary devices for display, the respective supplemental content identified by the processed metadata information based on the respective preference settings for the user during presentation of the content, the respectively sent supplemental content information being for display at the one or more ancillary devices, and wherein at least one sent supplemental content includes one or more internet links for accessing additional information regarding the supplemental content, and at least one sent supplemental content includes one or more comments from an on-line community, the one or more ancillary devices providing a navigation interface for enabling viewing of the supplemental content and access to the one or more internet links and the one or more comments from the online community, wherein each of the one or more ancillary devices is sent respective supplemental content that is customized based on respective preference settings;

the method being executed by a processor, wherein the respective supplemental content sent for viewing on the one or more ancillary devices automatically changes in synchronicity with a change of presentation of the content on the main display.

Appeal Br. 45–46 (Claims App'x).

Rejections and References

The Examiner rejected claims 29–36, 49–53, and 55–61 under 35 U.S.C. § 101 as directed to a judicial exception (i.e., an abstract idea) without reciting significantly more. Final Act. 2–8.

The Examiner rejected claims 29, 32–36, 55, 56, 58, and 59 under 35 U.S.C. § 103(a) as unpatentable over Goto (US 2006/0053472 A1; pub. Mar. 9, 2006), O’Neil (US 2007/0136773 A1; pub. June 14, 2007), and Logan (US 2003/0093790 A1; pub. May 15, 2003). Final Act. 10–25.

The Examiner rejected claims 49, 50, 52, 53 under § 103(a) over Goto, O’Neil, Logan, and Carton (US 2005/0220439 A1; pub Oct. 6, 2005). Final Act. 25–34.

The Examiner rejected claims 30, 31, and 57 under § 103(a) over Goto, O’Neil, Logan, and Brierre (US 2005/0108026 A1; pub. May 19, 2005). Final Act. 35–36.

The Examiner rejected claims 51 and 61 under § 103(a) over Goto, O’Neil, Logan, Carton, and Brierre. Final Act. 37–38.

The 35 U.S.C. § 101 Rejection

For the § 101 rejection, Appellant argues Examiner error based on the independent claims as a group.² *See* Appeal Br. 11–19. We select claim 29 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

§ 101 Law and the USPTO 2019 Guidance

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

² There are two other independent claims (49 and 55), both of which include limitations analogous to claim 29’s limitations that provide the basis for our decision regarding the § 101 rejection. *See* App. Br. 47–50 (Claims App’x).

Supreme Court, however, has long interpreted § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. Pty. Ltd. 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* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71–73 (2012)). 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 concepts (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). In *Diamond v. Diehr*, the claim at issue recited a judicial exception in the category of mathematical concepts, 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.” 450 U.S. 175, 187 (1981).

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 (internal 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.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requiring generic computer implementation fails to transform that abstract idea into a patent-eligible invention.” *Id.* at 212.

In early 2019, the USPTO recently published revised guidance on the application of § 101. *2019 Revised Patent Subject Matter Eligibility Guidance*, 84 Fed. Reg. 50–57 (Jan. 7, 2019) (“Revised Guidance”). Under the Revised 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); and
 - (2) additional elements that integrate the judicial exception into a practical application (*see* Manual of Patent Examining Procedure (MPEP) § 2106.05(a)–(c), (e)–(h)).³
- See* 84 Fed. Reg. at 52, 54–55. 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 are 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.

³ All references to the MPEP are to Rev. 08.2017 (Jan. 2018).

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

*The Examiner’s Determinations and Appellant’s Contention*⁴

The Examiner determines claim 29 recites an abstract idea because it recites limitations that “describe techniques for obtaining information about the user that is used to tailor content to the user.” Final Act. 2–3 (quoting *id.* at 3); *see also* Ans. 5 (similarly determining claim 29 is “directed towards the abstract idea of ‘tailoring content based on information about the user’”). The Examiner further determines that the additional claim elements recited in claim 29, beyond those that describe the abstract idea, “[w]hen taken individually or as part of an ordered combination these additional claim element[s] do not appear to amount to significantly more than the abstract idea itself.” Final Act. 7. Appellant contends claim 29 is *not* directed to an abstract idea because it “recite[s] a practical application of using dynamic metadata to retrieve and automatically present supplemental content to ancillary devices.” Reply Br. 5. Appellant’s contention is persuasive.

Our Analysis

Alice/Mayo Step One, 2019 Guidance Step 2A Prong One

Under the first prong of step 2A of the Revised Guidance, under which we determine whether a claim *recites* an abstract idea (and then, if it does, we determine at prong two whether the claim is *directed to* that abstract idea). *See Revised Guidance*, 84 Fed. Reg. at 53–55. Here, as its preamble explains, claim 29 recites a “method for presenting supplemental content.” The body of claim 29 recites that “content of a media source” is presented to a user (on a “main display”). “Preference settings” that are

⁴ Because we reverse the Examiner based on a dispositive issue, we do not address all of Appellant’s contentions.

defined “by a user” are used for identifying “metadata information” that is used for retrieving the supplemental content. The supplemental content, which “is customized based on respective preference settings,” is provided for display (on “one or more ancillary devices”). Collectively, the foregoing limitations describe (recite) an idea of presenting (a) content on a display and (b) related information that is selected based on user preferences on an ancillary display.

As the Revised Guidance explains, certain methods of organizing human activity constitute abstract ideas. 84 Fed. Reg. at 52; *see also id.* at n.13. Here, the idea of presenting content on a display along with related information that is selected based on user preferences on another display can be carried out among humans, for example, by having one person manually give a display presentation using two “overhead slide” projectors, e.g., with pictures displayed on one screen and the related text “selected based on user preferences” displayed on another screen. The claimed activities therefore recite managing interactions between people, which is one of the methods of organizing human activity that the Revised Guidance enumerates as having been identified by the courts as an abstract idea. *Id.* at 52.

Thus, we discern no reversible error in the Examiner’s determination that claim 29 recites an abstract idea “for obtaining information about the user that is used to tailor content to the user.” Final Act. 2–3 (quoting *id.* at 3); *see also* Ans. 5.

Accordingly, we proceed to Step 2A, prong two, to determine whether claim 29 is directed to the abstract idea that it recites.

Alice/Mayo Step One, 2019 Guidance Step 2A Prong Two

We next consider whether claim 1 recites any additional elements that, individually or in combination, integrate the recited abstract idea into a practical application. *See* Revised Guidance, 84 Fed. Reg. at 54–55. We determine that it does.

Claim 29 requires detection of content presentation, “wherein certain images or parts of images within the content are associated with respective metadata information that is time-based and identifies supplemental content that is in addition to the content of the media source.” The “receiving” step of claim 29 requires processing of content changes for metadata and main content display data “in synchronicity as the content changes during presentation.” There are also multiple limitations related to “preference settings” that are used to customize “supplemental content,” with related requirements for a “navigation interface” for accessing “internet links” and “comments from an online community.”

We find this combination of limitations constitutes a particular arrangement of hardware (i.e., a main display, an ancillary display, a wireless connection between the displays over which the preference settings are received, etc.) and software-based (i.e., the functionality for implementing the abstract idea in combination with the functionality that integrates the idea into as discussed above) limitations. Appellant persuades us that this combination of limitations provides a particular and meaningful technological benefit, viz., in Appellant’s words, an improvement for “an interactive media experience using dynamic and flexible time-based metadata that can be associated with portions of a resource and can adapt as the portions of the resource it describes changes during media play or presentation” (Spec. ¶ 4). We are also persuaded that in achieving this

technological benefit, Appellant does more than generally link the use of a judicial exception to a particular technological environment or merely use generic computers as a tool to perform an abstract idea. Thus, we conclude claim 29 is directed to a practical application. *See* Guidance, 84 Fed. Reg. at 55 (explaining that a practical application can be a combination of elements that “use[] the judicial exception in [a] meaningful way beyond generally linking the use of the judicial exception to a particular environment, such that the claim as a whole is more than a drafting effort to monopolize the exception”).

Accordingly, we agree with Appellant the Examiner erred the § 101 rejection of claim 29. For the same reasons, we agree that the Examiner erred in rejecting claims 30–36, 49–53, and 55–61 under § 101. Accordingly, we do not sustain the Examiner’s § 101 rejection.

The § 103 Rejections

In rejecting claim 29, the Examiner relied on Goto for teaching the disputed limitation of “receiving at the computing system respective preference settings for the one or more ancillary devices,” as recited. Final Act. 11 (citing Goto ¶ 58). Appellant contends the Examiner erred in this finding because Goto does not teach that preference settings for ancillary devices “should be received by the computing device.” Appeal Br. 19–20.

The Examiner responds by finding that it is the combination of Goto, O’Neil, and Logan that teaches the disputed limitation:

Goto teaches obtaining the favor of the user (Goto ¶ 58), O’Neal [sic] teaches obtaining information relating to products and services that may be of interest to the viewer (O’Neal [sic] ¶ 30), [and] Logan teaches gathering indications of preferences from the user (¶ 209). This information from the user must be obtained somehow. Goto

teaches the use of a GUI that is quite capable of gathering information (§ 58). Within the proposed combination it would have been obvious to one of ordinary skill in the art to have used the GUI to gather the required information, as the recited devices must obtain this information from the users somehow, and the GUI is recited as a means capable of gathering information.

Ans. 6–7.

Appellant replies with further argument that Goto, O’Neil, and Logan, collectively, do not “suggest that preference settings for the one or more ancillary devices should be received at the computing system,” as recited. Reply Br. 7 (emphasis omitted); *see also id.* at 7–8. Appellant’s argument is persuasive.

Goto, the principal reference that the Examiner relies on in the Final Action for teaching the disputed limitation, discloses providing a remote control GUI on a secondary display. Goto § 58. A user can download a preferred (“according to the favor of the user”) GUI to be used on the secondary screen. *Id.*; *see also* Goto Fig. 6 (showing an exemplary user-favored GUI for a touch-sensitive remote controller for display on the secondary or ancillary device). Thus, Goto teaches the device for the ancillary display receiving “preference settings.” However, we agree with Appellant that the Examiner’s findings and reasoning did not sufficiently demonstrate how Goto teaches or suggests receiving such preference settings *from* ancillary devices, as claimed.

Appellant further persuades us that the combination of Goto, O’Neil, and Logan does not teach or suggest the disputed limitation. “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Here, the

Examiner insufficiently points to Logan’s “teach[ing of] gathering indications of preferences *from* the user (¶ 209)” in combination with the teachings of Goto and O’Neal as rendering obvious the disputed limitation. Ans. 7 (emphasis added) (explaining that the combination teaches the specific requirement because “information from the user must be obtained somehow” and Goto’s GUI “is recited as a means capable of gathering information”).

Although we discern no reversible error in the Examiner’s findings that “O’Neil teaches obtaining information relating to products and services that may be of interest to the viewer” and “Logan teaches gathering indications of preferences from the user” (Ans. 6 (citing O’Neil ¶ 30; Logan ¶ 209)), Appellant persuades us the articulated reasoning that “the recited devices must obtain [the required] information from the users somehow” (Ans. 7) and “it would have been obvious to one of ordinary skill in the art to have used the GUI to gather the required information, as the recited devices must obtain this information from the users somehow” (*id.*) is effectively conclusory. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006); *see also KSR*, 550 U.S. at 418 (quoting *Kahn*); *In re Chaganti*, 554 F. App’x 917, 922 (Fed. Cir. 2014) (“It is not enough to say that there would have been a reason to combine two references because to do so would ‘have been obvious to one of ordinary skill’” because “[s]uch circular reasoning is not sufficient—more is needed to sustain an obviousness rejection.”).

Thus, we do not sustain the § 103 rejection of claim 29. We likewise do not sustain the § 103 rejections of independent claims 49 and 55, both of which include limitations commensurate with the disputed limitation of claim 29 discussed above, and for which the rejections rely upon the same prior art findings. We also, accordingly, do not sustain the § 103 rejections of the dependent claims. Because we agree with at least one of the arguments advanced by Appellant that effects a reversal of all the § 103 rejections, we need not reach the merits of Appellant’s other arguments.

CONCLUSION

In summary:

Claims Rejected	Basis	Affirmed	Reversed
29–36, 49–53, and 55–61	§ 101		29–36, 49–53, and 55–61
29, 32–36, 55, 56, 58, and 59	§ 103(a) Goto, O’Neil, and Logan		29, 32–36, 55, 56, 58, and 59
49, 50, 52, 53	§ 103(a) Goto, O’Neil, Logan, and Carton		49, 50, 52, 53
30, 31, and 57	§ 103(a) Goto, O’Neil, Logan, and Brierre		30, 31, and 57
51 and 61	§ 103(a) Goto, O’Neil, Logan, Carton, and Brierre		51 ad 61
Overall Outcome			29–36, 49–53, and 55–61

REVERSED