UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Ex parte EDWARD P. FLINCHEM and WILLIAM L. VALENTI

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Appeal 2019-003354
Application 12/862,992
Technology Center 3600

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BEFORE JOSEPH A. FISCHETTI, MEREDITH C. PETRAVICK, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant[1] appeals from the
Examiner's decision to reject claims 1, 2, and 4–20. Appellant canceled
claim 3. We have jurisdiction under 35 U.S.C. § 6(b).

This application was first before us in Appeal No. 2013-011050.
Appellant has significantly amended all claims since we entered a decision
in that appeal.

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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 INTEGIC
TECHNOLOGIES LLC. Appeal Br. 2.

We reverse *pro forma* and enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

Claims 1 and 11, reproduced below, are independent. Claims 2 and 4–10 depend directly or indirectly from claim 1. Claims 12–20 depend directly or indirectly from claim 11. Claims 1 and 11 are illustrative of the claimed subject matter and are reproduced below.

1. A peer-to-peer file sharing system comprising:

a mobile computing device capable of peer-to-peer file sharing;

a second mobile computing device capable of peer-to-peer file sharing; and

a server comprising:

a processor; and

a memory having instructions stored thereon that, if executed by the processor, cause the server to perform operations comprising:

receiving, from the mobile computing device, a request for content;

transmitting, in response to the request, the content to the mobile computing device, wherein the content includes an advertisement, and wherein the content including the advertisement was previously forwarded to the mobile computing device from the second mobile computing device;

monitoring an exposure of the advertisement based on an identifier;

wherein the server is configured to transmit a digital content key to the mobile computing device, wherein the digital content key

unlocks protected content for use on the mobile computing device; and

wherein the mobile computing device is configured to determine if the content received by the mobile computing device from the server is presented for a first time on the mobile computing device and to provide an indication whether the content has been previously presented on the mobile computing device;

only in response to the content being presented for the first time on the mobile computing device, receiving a communication signal to update the identifier at the server in response to a presentation of the content by the mobile computing device, wherein the updated identifier indicates the content is presented on the mobile computing device for the first time.

11. A computer-readable storage device having instructions stored thereon that, if executed by a computing device, cause the computing device to perform operations comprising:

receiving, from a mobile computing device capable of peer-to-peer file sharing, a request for content;

transmitting, in response to the request, the content to the mobile computing device, wherein the content includes an advertisement and the mobile computing device is configured to store an indication in a memory of the mobile computing device indicating whether the content has been previously presented on the mobile computing device, and wherein the content including the advertisement was previously forwarded to the mobile computing device from a second mobile device capable of peer-to-peer file sharing;

only in response to the content being presented for the first time on the mobile computing device, receiving an identifier from the mobile computing device in response to a presentation of the content by the mobile computing device, wherein the identifier

indicates whether the content is presented on the mobile computing device for the first time; and

monitoring an exposure of the advertisement based on the identifier.

REJECTION

The Examiner rejected claims 1, 2, and 4–20 under 35 U.S.C. § 101 for claiming patent-ineligible subject matter. Final Act.[2] 3–4.

OPINION

Claims 1, 2, and 4–20 are indefinite for the reasons discussed below. The rejection of claims 1, 2, and 4–20 under 35 U.S.C. § 101 for claiming patent-ineligible subject matter must fall, *pro forma*, because it necessarily is based on speculative assumptions as to the meaning of the claims. *See In re Steele,* 305 F.2d 859, 862–63 (CCPA 1962). We make no comment on the merits of the Examiners position regarding the eligibility of the claimed subject matter.

NEW GROUNDS OF REJECITON

"The Specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention." 35 U.S.C. § 112(b). "[W]e apply the approach for assessing indefiniteness approved by the Federal Circuit in *Packard*, i.e., '[a] claim is indefinite when it contains words or phrases whose meaning is unclear.'" *Ex parte McAward*, Appeal

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[2] We refer to the Final Action mailed on June 1, 2018.

No. 2015-006416, at 11 (PTAB Aug. 25, 2017) (precedential) (quoting *In re Packard*, 751 F.3d 1307, 1310, 1314 (Fed. Cir. 2014)). "Put differently, 'claims are required to be cast in clear-as opposed to ambiguous, vague, indefinite-terms.'" *Id.* (quoting *Packard*, 751 F.3d at 1313). "At the same time, this requirement is not a demand for unreasonable precision." *Packard*, 751 F.3d at 1313.

Claims 1, 2, and 4–10

Claims 1, 2, and 4–10 are rejected under 35 U.S.C. § 112(b) as indefinite for failing to particularly point out and distinctly claim the subject matter that Appellant regards as the invention.

First, claim 1 lacks clarity because it is unclear which limitations are included or not included in the recited list of operations caused by execution of the instructions stored on the server's memory. Claim 1 recites that the server comprises a processor and

> a memory having instructions stored thereon that, if executed by the processor, cause the server to perform **operations** comprising:
>
> > **receiving**, from the mobile computing device, a request for content;
> >
> > **transmitting,** in response to the request, the content to the mobile computing device, wherein the content includes an advertisement, and wherein the content including the advertisement was previously forwarded to the mobile computing device from the second mobile computing device;
> >
> > **monitoring** an exposure of the advertisement based on an identifier;.

Appellant indented the limitations starting with receiving, transmitting, and monitoring from all other limitations of the claim, thus, indicating that these

limitations recite the start of the list of operations. Notably, however, the word "and" does not appear between the transmitting and monitoring limitation, thus, indicating that the list continues.

Claim 1 then recites a first wherein clause limitation:

wherein the server is configured to transmit a digital content key to the mobile computing device, wherein the digital content key unlocks protected content for use on the mobile computing device; and

The lack of the word "and" between the transmitting and monitoring limitation and the context of the first wherein clause limitation indicates that Appellant intended the first wherein clause limitation to be part of the list of operations.

To the contrary, the lack of indentation and use of the wherein clause format indicates that Appellant did not intend the first wherein clause limitation to be part of the claimed list of operations. Appellant did not indent the first wherein clause limitation, unlike the previous receiving, transmitting, and monitoring limitations. Appellant's use of the wherein clause format is also unlike the previous receiving, transmitting, and monitoring limitations and inconsistent with the first wherein clause limitation being part of the list of operations.

This causes the language of claim 1 to be unclear as to whether Appellant intended the first wherein clause limitation to be or not to be part of the claimed list of operations. The Specification provides no help to clarify claim 1 because the Specification only briefly and broadly states that server complex 231, 431 enables the download of digital content keys. Spec. ¶¶ 19, 26. The Specification does not explicitly describe any details of

how server complex 231, 431 enables the download of digital content keys.
See id.

      The first wherein clause limitation ends with the word "and." The use of the word "and" indicates that Appellant intended the next recited limitation to be the last limitation of the list of claimed operations. After the word "and," claim 1 recites a second wherein clause limitation:

> wherein the mobile computing device is configured to determine if the content received by the mobile computing device from the server is presented for a first time on the mobile computing device and to provide an indication whether the content has been previously presented on the mobile computing device;.

Similar to the first wherein clause limitation, the lack of indentation and the use of the wherein clause format indicate that Appellant did not intend the second wherein clause limitation to be a part of the claimed list of operations. The context of the second wherein clause limitation also indicates that Appellant did not intend it to be part of the claimed list of operations, as the context of the second wherein clause limitation does not recite an operation of the server. This is in contradiction to the placement of the word "and" at the end of the first wherein clause limitation and causes the language of claim 1 to be unclear as to whether Appellant intended the second wherein clause limitation to be or not to be part of the claimed list of operations.

      The next limitation is the last recited limitation of claim 1 and the word "and" does not appear between it and the second wherein clause limitation. Claim 1 lastly recites:

> only in response to the content being presented for the first time on the mobile computing device, receiving a communication

signal to update the identifier at the server in response to a presentation of the content by the mobile computing device, wherein the updated identifier indicates the content is presented on the mobile computing device for the first time.

The lack of the word "and" before this last limitation and the lack of indentation indicate that Appellant did not intend this last limitation to be part of the list of operations. To the contrary, the context of this last limitation indicates that Appellant intended this last limitation to be part of the list of operations, as the context of the last limitation recites an operation of the server. *See* Spec. ¶¶ 28, 29 (describing the server updating a count of impression in response to receiving the identity of a file that was played on the mobile computing device). This causes the language of claim 1 to be unclear as to whether Appellant intended the last limitation to be or not to be part of the claimed list of operations.

In sum, it is unclear which of claims 1's limitations are included or not included in the recited list of operations caused by execution of the instructions stored on the server's memory because of the placement of the word "and" in the claimed list, the inconsistent use of indentations, and the inconsistent use of the wherein clause format.

Second, claim 1 lacks clarity because the limitation that defines the content as having been previously forwarded to the mobile computing device is inconsistent with the limitation requiring the receiving of a communication signal "only in response to the content being presented for the first time on the mobile computing device." Claim 1 requires "transmitting, in response to the request, the content to the mobile computing device." Claim 1 defines the transmitted content as "content [that] **was previously forwarded to the mobile computing device from**

the second mobile computing device." Claim 1, thus, requires the server to transmit the same content that was previously forwarded to the mobile computing device from the second mobile computing device. With respect to that same content, claim 1 also recites:

> **only in response to the content being presented for the first time on the mobile computing device**, receiving a communication signal to update the identifier at the server in response to a presentation of the content by the mobile computing device, wherein the updated identifier indicates the content is presented on the mobile computing device for the first time.

It is unclear how the receiving of the communication signal can be "only in response to the content being presented for the first time on the mobile computing device" if the content transmitted by the server is by definition "content [that] was previously forwarded to the mobile computing device from the second mobile computing device." We note that claim 2, which depends from claim 1, recites "wherein the stored indication indicates the content was previously forwarded from the second mobile computing device." The Specification provides no help to clarify claim 1 because the Specification does not describe the server transmitting content that is defined as having been previously forwarded to the mobile computing device from the second mobile computing device. The Specification only describes the server transmitting content in response to a request from a mobile computing device or another mobile computing device transmitting content it received from the server. *See* Spec. ¶ 26, Abstract, Fig. 3.

Claim 2, which depends from claim 1, lacks clarity because it is unclear what element of claim 1 provides antecedent basis for "the stored indication." Claim 2 recites, "wherein **the stored indication** indicates the

content was previously forwarded from the second mobile computing device." Claim 1, however, does not recite an indication that is stored. Claim 1 recites the mobile computing device "provid[ing] **an indication** whether the content has been previously presented on the mobile computing device" and the server "receiving a communication signal to update the **identifier at the server**." But, claim 1 does not recite that the indication is stored on either the server or the mobile computing device. Claim 1 does recite that the identifier is at the server, implying it is stored at the server. It is, thus, unclear whether "the stored indication" refers to the indication or identifier recited in claim 1. The Specification provides no help to clarify claim 2 because the Specification does not describe storing an indicator that indicates the content was previously forwarded from the second mobile computing device.[3] *See e.g.*, Spec. ¶¶ 28–29.

Claim 4, which depends from claim 1, lacks clarity because the use of the word "identifier" is inconsistent with claim 1. Claim 4 depends from claim 1 and recites, "wherein monitoring the exposure of the advertisement based on the identifier comprises updating an advertisement impression count **in response to receipt of the identifier**." Claim 1, however, does not recite the mobile computing device sending the identifier to the server. Claim 1 recites the mobile computing device "provid[ing] **an indication** whether the content has been previously presented on the mobile computing device" and the server "receiving **a communication signal** to update the identifier at the server." But, claim 1 only recites the identifier being "at the

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[3] During any further prosecution, the Examiner may want to consider whether the Specification provides written description support as required by 35 U.S.C. § 112(a).

server." Claims 1 and 4, thus, use the words indication, communication signal, and identifier inconsistently.

For the foregoing reasons, claims 1, 2, and 4–10 are rejected under 35 U.S.C. § 112(b) as indefinite for failing to particularly point out and distinctly claim the subject matter that Appellant regards as the invention.

Claims 11–20

Claims 11–20 are rejected under 35 U.S.C. § 112(b) as indefinite for failing to particularly point out and distinctly claim the subject matter that Appellant regards as the invention.

First, independent claim 11 lacks clarity because it is unclear how a limitation directed to the configuration of the mobile computing device further defines the transmitting operation, which defines the instructions stored on the computer-readable storage device of the server (i.e., the server software). The preamble of independent claim 11 recites "[a] computer-readable storage device having instructions stored thereon that, if executed by a computing device, cause the computing device to perform operations comprising," and the body of claim 11 recites the operations of receiving a request, transmitting content, and receiving an identifier, and monitoring an exposure. These recitations correspond to the Specification's description of the software on server. *See* Spec. ¶¶ 28–29, Abstract.

With respect to the transmitting operation, claim 11 recites

transmitting, in response to the request, the content to the mobile computing device, **wherein** the content includes an advertisement **and the mobile computing device is configured to store an indication in a memory of the mobile computing device indicating whether the content has been previously presented on the mobile computing device**, and wherein the

11

content including the advertisement was previously forwarded to the mobile computing device from a second mobile device capable of peer-to-peer file sharing;.

The use of the word "wherein" indicates that the clauses that follow further define the transmitting. One clause, however, is directed to the configuration of the mobile computing device. It is unclear how a limitation directed to the configuration of the mobile computing device further defines the transmitting operation, which defines the instructions stored on the computer-readable storage device of the server (i.e., the server software).

Claims 19 and 20, which depend from claim 11, similarly lack clarity. The preamble of dependent claim 19 recites "the computer-readable storage device of claim 11" and the body of claim 19 beings with "wherein," which indicates that the body of claim 19 is directed to further defining the structure of the computer-readable device. The remaining body of dependent claim 19, however, does not recite any further structure of the computer-readable device. The body of dependent claim 19 recites: "wherein the mobile computing device communicates content received from the server to the second mobile computing device." This limitation recites a function of the mobile computing device, which is a separate device from the computer-readable device or server.

Likewise, the preamble of dependent claim 20 recites "the computer-readable storage device of claim 11" and the body of claim 20 begins with "wherein," which indicates that the body of claim 20 should be directed to further defining the structure of the computer-readable device. The body of claim 20, however, does not recite any further structure of the computer-readable device. Instead, the body of dependent claim 20 recites: "wherein the mobile computing device includes flash memory, a display, and a

speaker." This limitation recites components of the mobile computing device, which is separate from the computer-readable device.

In addition, claim 11 lacks clarity because the limitation that defines the content as having been previously forwarded to the mobile computing device is inconsistent with the limitation requiring the receiving of an identifier "only in response to the content being presented for the first time on the mobile computing device."

Claim 11 requires the server to "transmit[], in response to the request, the content to the mobile computing device." Claim 11 defines the transmitted content as "content [that] **was previously forwarded to the mobile computing device from the second mobile computing device capable of peer-to-peer file sharing**." Claim 11, thus, requires the server to transmit the same content that was previously forwarded to the mobile computing device from the second mobile computing device capable of peer-to-peer file sharing. With respect to that same content, claim 11 also recites:

> **only in response to the content being presented for the first time on the mobile computing device**, receiving an identifier from the mobile computing device in response to a presentation of the content by the mobile computing device, wherein the identifier indicates whether the content is presented on the mobile computing device for the first time.

Similar to claim 1, it is unclear how the server can receive the identifier "only in response to the content being presented for the first time on the mobile computing device" if the content transmitted by the server is by definition content that was previously forwarded to the mobile computing device from a second mobile computing device capable for peer-to-peer file sharing. The Specification provides no help to clarify claim 11 because the

13

Specification does not describe the server transmitting content that is defined as having been previously forwarded to the mobile computing device from a second mobile computing device capable of peer-to-peer file sharing. The Specification only describes the server transmitting content in response to a request from a mobile computing device or another mobile computing device transmitting content it received from the server. *See* Spec. Abstract, ¶ 26, Fig. 3.

For the foregoing reasons, claims 11–20 are rejected under 35 U.S.C. § 112(b) as indefinite for failing to particularly point out and distinctly claim the subject matter that Appellant regards as the invention.

CONCLUSION

The Examiner's rejection of claims 1, 2, and 4–20 under 35 U.S.C. § 101 is reversed. We enter a new ground of rejection of claims 1, 2, and 4–20 under 35 U.S.C. § 112(b) for being indefinite.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Ground
1, 2, 4–20	101	Eligibility		1, 2, 4–20	
1, 2, 4–20	112(b)	Indefiniteness			1, 2, 4–20
Overall Outcome				1, 2, 4–20	1, 2, 4–20

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, <u>WITHIN TWO MONTHS FROM THE DATE OF THE DECISION</u>, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

<u>REVERSED; 37 C.F.R. 41.50(b)</u>