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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LEONARDO WILLIAM ESTEVEZ and BENZY GABAY

Appeal 2019-006553
Application 14/817,020
Technology Center 2100

Before ROBERT E. NAPPI, ST. JOHN COURTENAY III, and
CARL L. SILVERMAN, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 21, 24 through 33, 37, and 38. Claims 1–20, 22, 23, and 34–36 are canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm

¹ We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42(a). According to Appellant, Texas Instruments Incorporated is the real party-in-interest. Appeal Br. 2.

CLAIMED SUBJECT MATTER

The claims are directed to a computer device configured to download media from an external source through a secure network connection. The computer device also includes a memory configured to store the downloaded content, and a media profiling engine which queries the memory for the downloaded content and generates a media profile log comprising information relevant to the downloaded content. Specification ¶ 4. Claim 21 is reproduced below.

21. A computing device comprising

a network interface configured to invoke a secure network connection and to download media content via the secure network connection;

a memory that stores program instructions, a media profile log, and the downloaded media content; and

a processor configured to execute the program instructions stored in the memory to cause the computing device to:

detect the invocation of the secure network connection as a download condition to enable downloading of the media content via the secure network connection, the downloading of the media content being enabled as a result of the download condition being detected;

after downloading the media content, query the memory to identify the downloaded media content based on a query condition, the query condition being a condition upon which the querying is based;

after identifying the downloaded media content, analyze the downloaded media content to identify at least one property of the downloaded media content;

update the media profile log to include the at least one identified property of the downloaded media content, the at least one identified property including one or more

of an address of an external source from where the downloaded media content was downloaded, a file name of the downloaded media content, a file extension of the downloaded media content, a file size associated with the downloaded media content, an access time associated with the downloaded media content, and metadata of the downloaded media content;

send the media profile log from the computing device to an external device as a push request using the network interface; and

receive information from the external device in response to the push request, the received information being based upon the media profile log.

REJECTIONS²

The Examiner rejected claims 27, 32 and 38 under 35 U.S.C. § 112, ¶ 4, for failing to further limit the subject matter of the claim upon which it depends. Final Act. 6–8.

The Examiner rejected claims 21, 27, 29, 30 through 34, 37, and 38 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Lamkin (US 2006/0159109 A1; July 20, 2006)³ and Issa (US 2010/0015975 A1; Jan. 21, 2010). Final Act. 8–19.

The Examiner rejected claim 24 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Lamkin, Issa, and Starfield Technologies - Frequently Asked Questions (<https://web.archive.org/web/20040903011104/https://products.secureserver>).

² Throughout this Decision we refer to the Appeal Brief filed April 3, 2019 (“Appeal Br.”); Final Office Action mailed July 6, 2018 (“Final Act.”); and the Examiner’s Answer mailed May 31, 2019 (“Ans.”).

³ Lamkin (US 2006/0159109 A1; July 20, 2006) is a Continuation In Part (CIP) of Lamkin (US 2004/0220926 A1; Nov. 4, 2004)

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net/products/faq_secureturbo.htm) (hereinafter Starfield). Final Act. 19–20.

The Examiner rejected claims 25, 26, and 28 under 35 U.S.C. § 103 as unpatentable over the combined teachings of Lamkin, Issa, and Windows XP. Final Act. 20–22.

ANALYSIS

We have reviewed Appellant’s arguments in the Appeal Brief, the Examiner’s rejections, and the Examiner’s response to Appellant’s arguments. Appellant’s arguments have persuaded us of error in the Examiner’s rejection of claims 27, 32, and 38 under 35 U.S.C. § 112. However, Appellant’s arguments have not persuaded us of error in the Examiner’s rejections of all the claims under 35 U.S.C. § 103.

Rejection based upon 35 U.S.C. § 112, ¶ 4

The Examiner finds that claim 27, which depends upon claim 21, “contains a further limitation of ‘the at least one identified property’ followed by a list of properties” and that limitation is entirely directed to non-functional descriptive material and as such does not further limit the claim. Final Act. 7. With respect to claims 32 and 38 the Examiner finds the recitation that the downloaded media content comprises audio content, video content or executable software, is reciting non-functional descriptive material and as such does not further limit the independent claims from which they depend. Final Act. 7–8.

Appellant argues that the Examiner’s 35 U.S.C. § 112, ¶ 4 rejection is in error. Appeal Br. 8 through 12. Appellant argue:

Claim 21 recites identifying at least one property of the downloaded media content. Clearly, the scope of the quantity “at least one” includes all quantities greater than and including one. Claim 27, depends from claim 21 and further limits the at

least one property to requiring two or more such properties. Thus, the scope of claim 27 excludes the identification of only a single (e.g., one) property of the downloaded media content and, hence, is indeed further limiting.

Appeal Br. 8. Further, with respect to claims 32 and 38, Appellant asserts that they recite limitations directed to the downloaded media content being “one of audio content, video content, or software content” thus limiting “the scope of the downloaded media content to one of these three recited types.”

Appeal Br. 8.

Appellant’s arguments have persuaded us of error in the Examiner’s rejection under 35 U.S.C. § 112, ¶ 4. As an initial matter, we disagree with the Examiner’s statement that the Appellant did not argue and waived arguments directed to the rejection of claims 32 and 38. Ans. 4. As identified above, the Appellant did address claims 32 and 38. Further, we disagree with the Examiner that claim 27 does not further limit claim 21. Regardless of whether the properties recited in claim 27 are non-functional descriptive material (NFDM), as argued by Appellant, the broadest reasonable interpretation of claim 21 is that there is only one property of the downloaded media content that is discovered and included in the updated log. Claim 27 modifies claim 21 to recite that there are “two or more identified properties”, and thus claim 27 is narrower than claim 21. Accordingly, we do not sustain the Examiner’s rejection of claim 27 under 35 U.S.C. § 112, ¶ 4

With respect to claims 32 and 38 each of these claims recite “wherein the downloaded media content comprises audio content, video content, or executable software.” We consider this claim language to further limit the claimed “downloaded media content” to include at least one of these three types. The claim recitation of “comprises audio content, video content, or

executable software” merely means that the media content may also include other types of content. To the extent that audio and video content intended for human perception is NFD, we conclude at least “executable software” is intended to be functional descriptive material, i.e., consisting of code intended to be executed by a processor.⁴ Accordingly, we consider claims 32 and 38 to further limit the independent claims from which they depend for at least this reason (i.e., executable code that is intended to be functional descriptive material). As such we do not sustain the Examiner’s rejection of claims 32 and 38 under 35 U.S.C. § 112, ¶ 4.

Rejection of independent claim 21 under 35 U.S.C. § 103

Appellant argues that the combination of Lamkin, and Issa do not teach the claim 21 limitation directed to querying the memory of the electronic device to identify the downloaded media content. Appeal Br. 14–16. Specifically, Appellant argues that Lamkin, which the Examiner relies upon to teach this feature, teaches that “the query is not of memory of the computing device, but rather of memory of an external device (e.g., the server on which the files are located).” Appeal Br. 15–16. Further, Appellant’s argue that

Lamkin does indicate that in some instances, the client

⁴ See *Ex parte Nehls*, 88 USPQ2d 1883, 1889 (BPAI 2008) (precedential) (“[T]he nature of the information being manipulated does not lend patentability to an otherwise unpatentable computer-implemented product or process.”). Further guidance regarding NFD is found in the MPEP: “[W]here the claim as a whole is directed to conveying a message or meaning to a human reader independent of the intended computer system, and/or the computer-readable medium merely serves as a support for information or data, no functional relationship exists.” MPEP § 2111.05 (III.).

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device could download the listing contained in the CDS from the server, and then perform the query locally. However, in such a case, even if this is a query of memory of the computing device, the query is not for media content that was downloaded to the computing device prior to the query, as the media content was downloaded to an external device (e.g., the server).

Appeal Br. 16 (emphasis omitted).

The Examiner responds to Appellant's arguments by stating that while one embodiment of Lamkin teaches the client (equated to the claimed computing device) and the server are separate devices, Lamkin also teaches that one device may be both the server and client. Ans. 13 (citing Lamkin ¶ 49). Further, regarding the query the Examiner cites to Lamkin ¶¶ 103–104 as teaching a query when new content is added to a device and ¶ 95 as teaching that information can be added by downloading. Ans. 15.

Appellant's arguments have not persuaded us of error in the Examiner's rejection. Appellant's arguments in the Appeal Brief are premised upon Lamkin not teaching the claimed query in memory as the client and server are different devices, and not that they are on the same device as found by the Examiner. Appellant's arguments have not addressed the Examiner's specific findings, which rely upon Lamkin ¶¶ 49, 95, 103, 014, to show that when the client and server are on the same device the query is of the devices memory, and that content is downloaded to the device before the query, as claimed. Accordingly, Appellant's arguments have not persuaded us of error in the Examiner's obviousness rejection of claim 21.

Rejection of independent claim 33 under 35 U.S.C. § 103

With respect to independent claim 33 Appellant argues the Examiner's rejection is in error for the reasons discussed with respect to

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claim 21. Appeal Br. 16. Further, Appellant argues that the Examiner has not addressed the claim 33 limitation that the profile log is sent to an external source “to inform the external source whether the downloaded media content was purchased by a user of the computing device or illegally redistributed.” Appeal Br. 16–17 (emphasis omitted).

The Examiner, in response to Appellant’s argument, states that disputed limitation is directed to an intended function of the log once it is sent to the external device which the Examiner considers to be an intended use as it does not further limit the structure of the apparatus claim. Ans. 18–19 (citing *In re Gardiner*, 171 F.2d 313, 315–16 (CCPA 1948) and *Catalina Mktg. v. Coolsavings.com*, 289 F.2d 801, 804 (Fed. Cir. 2002)).⁵

As discussed above, Appellant’s arguments have not persuaded us of error regarding the rejection of claim 21. Additionally, Appellant’s arguments have not addressed the Examiner’s interpretation that the disputed limitation is reciting an intended use which is not afforded patentable weight. We concur with the Examiner’s analysis on page 18 and 19 of the Answer, that claim 33 is directed to a computing device which sends a media profile log to an external source and that the structure of the

⁵ “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). Although “[s]uch statements often . . . appear in the claim's preamble,” *In re Stencel*, 828 F.2d 751, 754 (Fed.Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*). The patentability of an apparatus claim “depends on the claimed structure, not on the use or purpose of that structure.” *Catalina Marketing*, 289 F.3d at 809.

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computing device is not changed based upon whether the external source is informed of purchase or illegal distribution by the log. Thus, in the absence of an argument to the contrary, we concur with the Examiner that this disputed limitation is reciting an intended use⁶ and we sustain the Examiner's rejection of claim 33.

Rejection of dependent claim 27 under 35 U.S.C. § 103

With respect to dependent claim 27 Appellant argues:

[The claim] recites that at least one property of the downloaded media content is two or more properties. The Examiner's only rationale in the Final Office Action for rejecting claim 27 is that he chose not to give these limitations patentable weight under the misguided notion that they are non-functional descriptive material. *See* Final Office Action, pages 16-17.

Appeal Br. 17.

These arguments have not persuaded us of error in the Examiner's rejection. As discussed above we reverse the Examiner's rejection under 35 U.S.C. § 112, ¶ 4, because dependent claim 27 further limits independent claim 21 such that to recite to two or more properties are identified and included in the log. Claim 27 recites the properties as including: the file name of the downloaded content, the file extension of the downloaded media content, and the metadata of the downloaded media content. The Examiner cites Lamkin, ¶ 77, as teaching querying the media file and updating a log. In this paragraph Lamkin identifies that the log file, is updated identifying the content (file name), where the content is stored (file extension) and metadata, thus Lamkin teaches two or more of the claimed properties.

⁶ We note this could also be interpreted as non-functional descriptive material as it is reciting the information communicated and is not functionally related to any medium or operation claimed.

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Lamkin, ¶ 77. As such, we find that the Examiner has cited sufficient evidence to demonstrate the disputed limitation of claim 27 is taught by Lamkin and we sustain the Examiner’s obviousness rejection of claim 27.

Remainder of claims rejected under 35 U.S.C. § 103

Appellant has not presented separate arguments with respect to the Examiner’s obviousness rejections of claims 24 through 26, 28 through 32, 37 and 38. Accordingly, we sustain the Examiner’s rejections of these claims for the same reasons as independent claims 21 and 33 from which they depend.

CONCLUSION

We reverse the Examiner’s rejection of claims 27, 32 and 38, under 35 U.S.C. § 112, fourth paragraph, and we affirm the Examiner’s rejections of claims 21, 24 through 34, 37 and 38 under 35 U.S.C. § 103.

In summary:

Claim Rejected	35 U.S.C. §	Basis/References	Affirmed	Reversed
27, 32, 38	112, fourth para.	Not Further Limiting		27, 32, 38
21, 27, 29, 30–34, 37, 38	103	Lamkin, Issa	21, 27, 29, 30–34, 37, 38	
24	103	Lamkin, Issa, Starfield	24	
25, 26, 28	103	Lamkin, Issa, Windows XP	25, 26, 28	
Overall Outcome			21, 24–33, 37, 38	

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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