

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOUIS ROBERT LITWIN JR.

Appeal No. 2007-0635
Application No. 10/176,598
Technology Center 3600

Decided: June 22, 2007

Before HUBERT C. LORIN, LINDA E. HORNER, and ANTON W. FETTING,
Administrative Patent Judges.

LORIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

The appeal is from a decision of the Examiner rejecting claims 2 and 4-23. 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Claims 2 and 4-23 are rejected under 35 U.S.C. 103(a) (2002) as being unpatentable over Ward (U.S. 6,526,411 B1).

We AFFIRM-IN-PART.

The claimed invention (i.e., claim 2) involves a method for ranking media files found on media playback devices according to how long a user listens to or watches a media file. Specification 4: [0008]. The user's usage of a media file is monitored and assigned a popularity metric and popularity metrics for the media files on the media playback device are created and updated. Specification 12: [0031]. The claimed invention includes the use of timestamps for indicating a last playback time (claim 10), a step of reducing a value for a popularity metric based on the timestamp and how long ago the media file was last played (claim 11), a step of relating the metric to the total duration of time the media file is played back (claim 17), and an updating step that removes a media file from the memory resource when the media file falls below a metric threshold value (claim 20).

Appellant, in the Appeal Brief¹, argues the claims in accordance with the following groups:

- Claims 2, 4-9, 12-16 (Appeal Br. 3-5);
- Claim 10 (Appeal Br. 5-6);
- Claim 11 (Appeal Br. 6-7)
- Claims 17-19 and 21-23 (Appeal Br. 7-9); and,
- Claim 20 (Appeal Br. 9).

¹ In making our decision, we consider Appellant's Appeal Brief ("Appeal Br.," filed Apr. 17, 2006), the Examiner's Answer ("Answer," mailed Jul. 12, 2006) and the Reply Brief ("Reply Br.," filed Sep. 21, 2006).

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I. CLAIMS 2, 4-9, and 12-16.

Pursuant to the rules, the Board selects representative claim 2 to decide the appeal with respect to this group of claims, and claims 4-9 and 12-16 stand or fall with claim 2. 37 C.F.R. § 41.37(c)(1)(vii) (2006). It reads as follows:

2. A method for using media files on a media playback device, comprising the step of at least one of creating and updating popularity metrics for the media files that are stored on the media playback device, wherein the popularity metrics are related to the playback of the media files by a user of the media playback device with each of the popularity metrics being proportional to an total amount of playback time that the user plays back a corresponding one of the media files.

A. ISSUE

The claimed invention involves a method for ranking media files found on media playback devices according to how long a user has played a media file. Ward does not explicitly disclose ranking media files by how long a user has played a media file. Ward discloses ranking media files according to how often the files have been played. The issue is whether the claimed method, giving claim 2 the broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art, would have been obvious to one of ordinary skill in the art in light of the disclosure in Ward.

B. FACTS

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Claim construction

1. Claim 2 is drawn to a method comprising the step of creating and updating popularity metrics for media files stored on a media playback device.
2. Claim 2 describes the popularity metrics involved in the step of creating and updating popularity metrics for media files stored on a media playback device as follows:

the popularity metrics are related to the playback of the media files by a user of the media playback device with each of the popularity metrics being proportional to an total amount of playback time that the user plays back a corresponding one of the media files.

3. In other words, the popularity metrics are *related* to the playback of the media files and *proportional* “to an total amount of playback time that the user plays back a corresponding one of the media files.”
4. The Specification does not give the terms “related” and “proportional” a meaning different from their ordinary and customary meanings.

The scope and content of the prior art.

Ward

5. The Examiner found that:

Ward discloses a method for using media files on a media playback device, comprising the step of at least one of creating and updating popularity metrics for the media files that are stored on the media playback device, wherein the popularity metrics are related to the playback of the media files by a user of the media playback device (col. 2, lines 61-67; col. 5, lines 6-24; The system orders media files based on their popularity, the popularity being based on how many times the user played the media file.).

Ward further discloses using user play patterns of media files as indications of the user's preferences for the media files (col. 2, lines 24 and 46-51),

including manual intervention detected during playing of media files such as skipping, or opting to not listen to, media files (col. 8, lines 28-31) and listening to the media files (col. 7, lines 40-47).

Answer 3.

6. There appears to be a dispute over the scope of Ward; i.e., whether Ward suggests ranking media files found on media playback devices according to how long a user has played a media file, notwithstanding that it indisputably discloses ranking media files according to the number of times a file has been played. This comes through in the debate over the difference between the claimed method and Ward. See below.

Differences between the prior art and the claims at issue.

7. The Examiner characterizes the difference between Ward and the claimed method as follows:

Ward does not expressly disclose the popularity metrics being proportional to a total amount of playback time that the user plays back a corresponding one of the media files. However, since Ward does teach monitoring user play patterns of media files, particularly, whether or not a user listens to a media file, Ward does teach the popularity metrics being proportional to a total amount of times a user plays back a media file. Therefore, Ward already has the means with which to measure a total amount of playback time.

Answer 3-4. Emphasis added.

8. Appellant argues that

Ward is directed towards an operation of modifying play lists (for the playback of audio and video files) in view of how popular such files are. The reference discloses that the system reports to a user, "that a user has listened to an item," (Ward, col. 7, lines 40-42), which such an item is on the play list. The specifics of what is reported to is determined by, "when the user

expresses a dislike for a particular content item, either by skipping the item or through a rating system, the system records such instances in the meta-data associated with the user," (Ward, col. 8, lines 27-31). *Hence, the system of Ward keeps track of media files in a generalized manner where a metric is developed in view of whether a song or video was played back or not.*

...

... a user may play back an entire song (1 minute and 20 seconds long) and "then rewind it to replay the last 20 seconds" whereby the developed popularity metric is proportional to the total amount of time the media file was played (1 minute and 40 seconds, see specification, Background of the Invention and page 10, line 20 to page 11, line 2). When considering the variability of how a media file may be played back on modern media devices (see above), keeping track of the "total amount of times a user plays back a media file" in the manner suggested by the Examiner, does not account for such operations where a user repeats a portion of a song or fast forwards to other parts of the song. The Examiner, in the reasoning of the Final Rejection, could not come to such a conclusion to arrive at the elements of Claim 2, without applying hindsight analysis in view of Ward as to develop the Examiner's cited combination.

By applying the invention of Claim 2 where "each of the popularity metrics being proportional to an total amount of playback time that the user plays back a corresponding one of the media files", a media device provides a more accurate way of monitoring the playback of media files than disclosed or suggested in Ward in combination with the Examiner's stated rationale.

Applicant asserts that there is appreciable difference between keeping track of the "total amount of time" a media file is played, as claimed in Claim 2, versus the whether a media file was played back or not (see Ward, col. 7, lines 40-47, and col. 8, lines 28-40) for the reasons listed above.

Appeal Br. 4-5. Emphasis added.

9. Appellant further argues that another difference between the claimed method and Ward is that the claimed method keeps track of the total time a media file has been played back.

[T]here is no disclosure or suggestion that Ward could keep track of the "total amount of time" a user plays back a file, as stated by the Examiner in the Final Rejection, because "the total amount of times a user plays back a media file" is not the same thing as in Claim 2 of keeping track of the "total amount of time" a media file is played back. Keeping track of whether a media file was played back or not (see Ward, col. 8, lines 28-40) where playback of media files in [sic, is] performed serially in view of a play list, does not disclose or suggest that such media files can be played back multiple times, or such multiple plays are capable of being tracked, without resetting a play list.

Appeal Br. 5.

The level of ordinary skill in the pertinent art.

10. Neither the Examiner nor Appellant has addressed the level of ordinary skill in the pertinent art of electronic commerce. We will consider Ward as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown.’”).

Secondary considerations.

11. Appellants presented no evidence of secondary considerations of non-obviousness for our consideration.

C. PRINCIPLES OF LAW

Claim construction

1. Claims define that which Appellants regard to be their invention. *In re*

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Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

2. Claims are given their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004).

3. “The problem is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims.” *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003).

Obviousness

4. Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Court set out a framework for applying the statutory language of §103, language itself based on the logic of the earlier decision in *Hotchkiss v. Greenwood*, 11 How. 248 (1851), and its progeny. *See* 383 U.S., at 15-17. The analysis is objective:

Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Id.*, at 17-18.

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“While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls. If a court, or patent examiner, conducts this analysis and concludes the claimed subject matter was obvious, the claim is invalid under §103.” *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

D. ANALYSIS

The question is whether claim 2 encompasses obvious subject matter. We find that it does.

There is no dispute that Appellant is seeking to apply a popularity metric to the ranking of media files on a media playback device which would involve the consideration of how long a media file has been played. The Examiner correctly conceded that Ward does not explicitly teach such a method.

However, the Examiner was on the right track in implying that Ward could accomplish the same result. Although the Examiner did not expound on the point, in response to Appellant’s argument the Examiner did emphasize that “[c]laim 2 recites that the popularity metrics *are proportional to* a total amount of playback time that a user plays back a media file.” Answer 9. Emphasis original. We find the inclusion of the term “proportional” in the claim to be the dispositive reason for concluding that claim 2 encompasses obvious subject matter given the teaching in Ward.

Giving claim 2 the broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art, the claim

is not limited to using a popularity metric which ranks media files according to how long they have been played. The claim calls for using popularity metrics that *are proportional to* a total amount of playback time. In other words, the claim does not limit ranking the media files by “a total amount of playback time.” The claim only limits the ranking to one that is *proportional to* a total amount of playback time. That means the claim encompasses instances of ranking media files which, though a calculation of “a total amount of playback time” may not in fact have been made or used to rank the media files, the result is nevertheless the same. That is, claim 2 encompasses ranking the media files as *though* they had been based on the total time they were played. Ward broadly covers just such instances.

There is no dispute that Ward ranks files by the number of times a media has been played. For example, take four media files, A, B, C, and D where media files A and D have each been played once to completion and media files B and C have not been played. In accordance with Ward’s popularity metric, media files A and D would be ranked in one group with media files B and C in another. In this instance, the application of the Ward popularity metric amounts to an application of a popularity metric that is based on how long a media file has been played. That is to say, applying Ward’s popularity metric to a set of media files consisting of media files that have played to completion or not played at all is *proportional to* a popularity metric that is based on how long the media files have been played. In this example, the resulting order of the media files from using either algorithm would be the same.

To repeat, the Ward method applies a popularity metric which is

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proportional to a popularity metric based on how long a media file has been played because the Ward popularity metric operates in a way similar to that claimed in those instances where a set of media files consists of some media files having not been played at all and the rest having been played to completion. Claim 2 does not limit applying the metric to any particular set of media files, and thus covers the aforementioned situation where some media files in a set of media files have not been played at all while the rest have been played to completion. Accordingly, the subject matter claim of 2 overlaps that which Ward discloses, thus encompassing obvious subject matter.

Regarding the argument that Ward does not teach the “a total amount of playback time”, again, the claim calls for popularity metrics *proportional to* a total amount of playback time that a user plays back a media file. It is not essential in meeting the claim that the prior art teach “a total amount of playback time”. All that is necessary to meet the claim is that the prior art shows using a popularity metric which performs relatively the same way. And, in that regard, we find Ward does precisely that in some instances.

E. CONCLUSION OF LAW

On the record before us, Appellants have failed to show that the Examiner erred in rejecting claims 2, 4-9, and 12-16 over the prior art.

II. CLAIM 10

Claim 10 reads as follows:

10. The method of claim 2, further comprising the step of associating a timestamp with each of the popularity metrics, the timestamp for indicating a last playback time of a corresponding media file.

A. ISSUE

The issue is whether it would have been obvious to one of ordinary skill to modify the Ward method so as to include a step of associating a timestamp with each of the popularity metrics, the timestamp for indicating a last playback time of a corresponding media file.

B. FACTS

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Claim construction

We incorporate herein the facts under *Claim construction* of the Facts section for 2, 4-9, and 12-16 above and add the following:

1. The claim does not define the term “timestamp.”
2. The specification indicates that the “timestamp” may be based on the quantity of time the media is played back.

Step 505 may include the step of associating a timestamp with the popularity metric (step 505a). ...

The computing/updating of the popularity metric at step 505 may be based upon the actual time and/or multiple of some quantity of time (e.g., seconds, minutes, etc.) that the media file is played back.

Specification 10: 11-22.

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The scope and content of the prior art

We incorporate herein the facts under *The scope and content of the prior art* of the Facts section for claims 2, 4-9, and 12-16 above and add the following:

3. Media playback devices generally show the duration (e.g., seconds, minutes, etc.) of a media file.

Differences between the prior art and the claims at issue.

We incorporate herein the facts under *Differences between the prior art and the claims at issue* of the Facts section for claims 2, 4-9, and 12-16 above.

The level of ordinary skill in the pertinent art.

We incorporate herein the fact under *The level of ordinary skill in the pertinent art* of the Facts section for claims 2, 4-9, and 12-16 above.

Secondary considerations.

We incorporate herein the fact under *Secondary considerations* of the Facts section for claims 2, 4-9, and 12-16 above.

C. PRINCIPLES OF LAW

We incorporate herein the Principles of Law set forth in the Principles of Law section for claims 2, 4-9, and 12-16 above.

D. ANALYSIS

Appellant argues that “there is no disclosure or suggestion that one of the ordinary skill in the art would modify Ward to include timestamps, as because the system only keeps track of whether a media file was played or not, as listed on a

play list (see Ward, col. 8, lines 20-40). This calculation does not consider ‘popularity metrics based on time-related criteria’ as stated by the Examiner. The disclosed operations of Ward only identifies whether a media file was played (not when the media file was played as indicated by a timestamp as in Claim 10) and modifies a play list in view of such information.” Appeal Br. 6. Emphasis in original.

The difficulty with this argument is that it does not take into account the fact that giving claim 2 the broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art, the claim is not limited to using a popularity metric which ranks media files according to how long they have been played. The claim calls for using popularity metrics that *are proportional to* a total amount of playback time. In other words, the claim does not limit ranking the media files by “a total amount of playback time,” associated with a timestamp or not. The claim encompasses the Ward method in those instances where some of the media files being ranked are played to their entirety while the rest are not played at all. The timestamp for indicating a last playback time of a corresponding media file would have been obvious to one of ordinary skill in the art.

Furthermore, given that associating duration with a media file on a media playback device is generally well known and that a media file’s duration may be considered a timestamp, associating a timestamp with each of the popularity metrics such that the timestamp for indicating a last playback time of a corresponding media file would have been obvious to one of ordinary skill in the

art.

E. CONCLUSION OF LAW

On the record before us, Appellants have failed to show that the Examiner erred in rejecting claim 10 over the prior art.

III. CLAIM 11

Claim 11 reads as follows:

11. The method of claim 10, further comprising the step of adjusting a value of each of the popularity metrics based on the timestamp such that the value is reduced in relation to how long ago a corresponding media file was last played back.

A. ISSUE

The issue is whether it would have been obvious to one of ordinary skill to modify the Ward method so as to include a step of associating a timestamp with each of the popularity metrics, the timestamp for indicating a last playback time of a corresponding media file, and adjusting a value of each of the popularity metrics based on the timestamp such that the value is reduced in relation to how long ago a corresponding media file was last played back.

B. FACTS

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Claim construction

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We incorporate herein the facts under *Claim construction* of the Facts section for 2, 4-10, and 12-16 above.

The scope and content of the prior art

We incorporate herein the facts under *The scope and content of the prior art* of the Facts section for claims 2, 4-10, and 12-16 above and add the following:

1. The Examiner points to col. 7, ll. 41-48 and col. 48, ll. 20-40, in Ward as evidence that Ward shows a step of adjusting a value of each of the popularity metrics based on the timestamp such that the value is reduced in relation to how long ago a corresponding media file was last played back. Answer 5.

2. Col. 7, ll. 41-48 and col. 48, ll. 20-40 of Ward disclose re-submitting a playlist to a sort server and, based on selected sorting criteria, generating a new playlist but does not mention generating the new playlist based on how long ago a corresponding media file was last played back.

3. Accordingly, col. 7, ll. 41-48 and col. 48, ll. 20-40 of Ward do not appear to teach or suggest a step of adjusting a value of each of the popularity metrics based on the timestamp such that the value is reduced in relation to how long ago a corresponding media file was last played back.

Differences between the prior art and the claims at issue.

We incorporate herein the facts under *Differences between the prior art and the claims at issue* of the Facts section for claims 2, 4-10, and 12-16 above.

The level of ordinary skill in the pertinent art.

We incorporate herein the fact under *The level of ordinary skill in the pertinent art* of the Facts section for claims 2, 4-10, and 12-16 above.

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Secondary considerations.

We incorporate herein the fact under *Secondary considerations* of the Facts section for claims 2, 4-10, and 12-16 above.

C. PRINCIPLES OF LAW

We incorporate herein the Principles of Law set forth in the Principles of Law section for claims 2, 4-9, and 12-16 above.

D. ANALYSIS

The Examiner's position that Ward shows a step of adjusting a value of each of the popularity metrics based on the timestamp such that the value is reduced in relation to how long ago a corresponding media file was last played back does not appear to be supported by the facts. Accordingly, as to claim 11, a prima facie case of obviousness has not been established.

E. CONCLUSION OF LAW

On the record before us, a prima facie case of obviousness of claim 11 over Ward has not been established.

IV. CLAIMS 17-19 and 21-23

Pursuant to the rules, the Board selects representative claim 17 to decide the appeal with respect to this group of claims, and claims 18-19 and 21-23 stand or fall with claim 17. 37 C.F.R. § 41.37(c)(1)(vii) (2006). It reads as follows:

17. A method of organizing a plurality of media files stored in a

memory resource comprising the steps of:

attributing a metric to a media file from the plurality of data files, wherein said metric is related to a total duration of time the media file is played back;

ranking the media file in comparison to information comprising a metric attributed to an other [sic] media file from a second memory resource;

updating the memory resource in accordance with the rankings established in said ranking step.

A. ISSUE

The claimed invention involves a method for ranking media files found on media playback devices according to how long a user has played a media file. Ward does not explicitly disclose ranking media files by how long a user has played a media file. Ward discloses ranking media files according to how often the files have been played. The issue is whether the claimed method, giving claim 17 the broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art, would have been obvious to one of ordinary skill in the art in light of the disclosure in Ward.

B. FACTS

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Claim construction

1. Claim 17 is drawn to a method comprising the step of “attributing a metric to a media file from the plurality of data files, wherein said metric is related to a total duration of time the media file is played back.”

2. The metric is described in the claim as *related* to “a total duration of time the media file is played back.”

3. The Specification does not give the term “related” a meaning different from its ordinary and customary meanings.

The scope and content of the prior art.

Ward

4. The Examiner found that:

As per claim 17, Ward discloses a method of organizing a plurality of media files stored in a memory resource comprising the steps of:

attributing a metric to a media file from the plurality of data files, wherein said metric is related to playback of the media file (col. 2, lines 61-67; col. 5, lines 6-24; The system orders media files based on their popularity, the popularity being based on how many times the user played the media file.);

ranking the media file in comparison to information comprising a metric attributed to another media file from a second memory resource (col. 3, lines 31-42; The system compares media file metrics and ranks the media files accordingly.);

updating the memory resource in accordance with the rankings established in said ranking step (col. 3, lines 31-42; col. 8, lines 20-40; The rankings are updated for each media file as they are performed.).

Ward further discloses using play patterns of media files as indications of the user’s preferences for the media files (col. 2, lines 24 and 46-51), including manual intervention detected during playing of media files such as skipping, or opting to not listen to, media files (col. 8, lines 28-31) and listening to the media files (col. 7, lines 40-47).

Answer 7.

5. There appears to be a dispute over the scope of Ward; i.e., whether Ward

suggests ranking media files found on media playback devices according to how long a user has played a media file, notwithstanding that it indisputably discloses ranking media files according to the number of times a file has been played. This comes through in the debate over the difference between the claimed method and Ward. See below.

Differences between the prior art and the claims at issue.

6. The Examiner characterizes the difference between Ward and the claimed method as follows:

Ward does not expressly disclose the popularity metric being proportional to a total duration of time the media file is played back. However, since Ward does teach monitoring user play patterns of media files, particularly, whether or not a user listens to a media file, Ward does teach the popularity metrics being proportional to a total amount of times a user plays back a media file. Therefore, Ward already has the means with which to measure a total amount of playback time.

Answer 7-8. Emphasis added.

7. Appellant argues that

Ward is directed towards an operation of modifying play lists (for the playback of audio and video files) in view of how popular such files are. The reference discloses that the system reports to a user, "that a user has listened to an item," (Ward, col. 7, lines 40-42), which such an item is on the play list. The specifics of what is reported to is determined by, "when the user expresses a dislike for a particular content item, either by skipping the item or through a rating system, the system records such instances in the meta-data associated with the user," (Ward, col. 8, lines 27-31). *Hence, the system of Ward keeps track of media files in a generalized manner where a metric is developed in view of whether a song or video was played back or not.*

...

... a user may play back an entire song (1 minute and 20 seconds long) and

"then rewound it to replay the last 20 seconds" whereby the developed popularity metric is proportional to the total amount of time the media file was played (1 minute and 40 seconds, see specification, Background of the Invention and page 10, line 20 to page 11, line 2). When considering the variability of how a media file may be played back on modern media devices (see above), keeping track of the "total amount of times a user plays back a media file" in the manner suggested by the Examiner, does not account for such operations where a user repeats a portion of a song or fast forwards to other parts of the song.

The Examiner, in the reasoning of the Final Rejection, could not come to such a conclusion to arrive at the elements of Claim 17, without applying hindsight analysis in view of Ward as to develop the Examiner's cited combination.

By applying the invention of Claim 17 where "said metric is related to a total duration of time the media file is played back," a media device provides a more accurate way of monitoring the playback of media files than disclosed or suggested in Ward in combination with the Examiner's stated rationale.

Applicant asserts that there is appreciable difference between keeping track of the "total amount of time" a media file is played, as claimed in Claim 17, versus the whether a media file was played back or not (see Ward, col. 7, lines 40-47, and col. 8, lines 28-40) for the reasons listed above.

Appeal Br. 7-9. Emphasis added.

8. Appellant further argues that another difference between the claimed method and Ward is that the claimed method keeps track of the total time a media file has been played back.

[T]here is no disclosure or suggestion that Ward could keep track of the "total amount of time" a user plays back a file, as stated by the Examiner in the Final Rejection, because "the total amount of times a user plays back a media file" is not the same thing as in Claim 17 of keeping track of the "total duration of time" a media file is played back. Keeping track of whether a media file was played back or not (see Ward, col. 8, lines 28-40) where playback of media files in [sic] performed serially in view of a play list, does not disclose or suggest that such media files can be played back multiple times, or such multiple plays are capable of being tracked, without resetting a play list.

Appeal Br. 9.

The level of ordinary skill in the pertinent art.

9. Neither the Examiner nor Appellants have addressed the level of ordinary skill in the pertinent art of electronic commerce. We will consider Ward as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown.’”).

Secondary considerations.

10. Appellants presented no evidence of secondary considerations of non-obviousness for our consideration.

C. PRINCIPLES OF LAW

We incorporate herein the Principles of Law set forth in the Principles of Law section for claims 2, 4-9, and 12-16 above.

D. ANALYSIS

The question is whether claim 17 encompasses obvious subject matter. We find that it does.

There is no dispute that Appellant is seeking to apply a metric to the ranking of media files on a media playback device which would involve the consideration of how long a media file has been played. The Examiner correctly conceded that Ward does not explicitly teach such a method.

However, the Examiner was on the right track in implying that Ward could accomplish the same result. We find the inclusion of the term “related” in the claim to be the dispositive reason for concluding that claim 17 encompasses obvious subject matter given the teaching in Ward.

Giving claim 17 the broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art, the claim calls for using a metric that is *related to* “a total duration of time the media file is played back.” The claim only limits the ranking to one that is *related to* a total amount of playback time. That means the claim encompasses instances of ranking media files which, though “a total duration of time the media file is played back” may not in fact have been made determined or used to rank the media files, the result is nevertheless the same. That is, claim 17 encompasses ranking the media files as *though* they had been based on the total time they were played. Ward broadly covers just such instances.

There is no dispute that Ward ranks files by the number of times a media has

been played. For example, take two media files, A and B where media file A has been played once to completion and media file B has not been played at all. In accordance with Ward's popularity metric, media files A and B would be ranked in an ascending or descending order, depending on order preference. In this instance, the application of the Ward metric amounts to an application of a metric that is based on how long a media file has been played. That is to say, applying Ward's metric to a set of media files consisting of a media file played to completion and a media file not played at all is *related* to a metric that is based on how long the media files have been played. In this example, the resulting order of the media files from using either algorithm would be the same.

To repeat, the Ward method applies a metric which is *related* to a popularity metric based on how long a media file has been played because the Ward metric operates in a way similar to that claimed in those instances where a set of media files consists of a media file having not been played at all and another having been played to completion. Claim 17 does not limit applying the metric to any particular set of media files, and thus covers the aforementioned situation. Accordingly, the subject matter claim of 17 overlaps that which Ward discloses, thus encompassing obvious subject matter.

Regarding the argument that Ward does not teach the "a total duration of time the media file is played back," again, the claim calls for popularity metrics *related to* a total amount of playback time that a user plays back a media file. It is not essential in meeting the claim that the prior art teach "a total duration of time the media file is played back." All that is necessary to meet the claim is that the

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prior art show using a metric which performs relatively the same way. And, in that regard, we find Ward does precisely that in some instances.

E. CONCLUSION OF LAW

On the record before us, Appellants have failed to show that the Examiner erred in rejecting claims 17-19 and 21-23 over the prior art.

V. CLAIM 20

Claim 20 reads as follows:

20. The method of claim 17, wherein said updating step removes the media file from said memory resource when the media file has a metric below a threshold value.

A. ISSUE

The issue is whether it would have been obvious to one of ordinary skill to modify the Ward method so as to include an updating step that removes the media file from said memory resource when the media file has a metric below a threshold value.

B. FACTS

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Claim construction

We incorporate herein the facts under *Claim construction* of the Facts

section for claims 17-19 and 21-23 above.

The scope and content of the prior art

We incorporate herein the facts under *The scope and content of the prior art* of the Facts section for claims 17-19 and 21-23 above and add the following:

1. The Examiner argues that Ward discloses the claimed updating step at “col. 3 [sic, 7], lines 31-42; col. 8, lines 20-40” (Answer 8).

2. Col. 7, lines 31-42 of Ward states the following:

At that point the process is repeated, using the results currently in the play queue to seed a collaborative filtering request after each list of available content pieces is returned from the content providers. Upon seeding the play queue with all meta-categories, a final ranking and culling pass can be performed, using any of the common playlist manipulation algorithms, and optionally, a pairing sort of algorithm, to be described in FIGS. 6 and 7.

3. Col. 8, lines 20-40 of Ward states the following:

When the user plays the playlist, the playlist is submitted to the sort server system 130, which performs the algorithm described in connection with FIG. 2 to expand all meta-categories into specific content items, by drawing upon the content available from the user’s locally stored pool and from streaming content providers. The system the [sic, then] returns the expanded playlist to the jukebox program, which then uses the playlist like a standard static playlist. Optionally, when the user expresses dislike for a particular content item, either by skipping the item or through a rating system, the system records such instances in the meta-data associated with the user, i.e., the user profile. Upon resubmission of the playlist to the sort server, a new playlist now adapted to the expressed tastes of the playlist listener is generated and the rejected content items are not selected based on the updated user profile. After the user stops or plays completely through the playlist, the list is submitted to the sort server to execute a pairing algorithm, described in connection with in FIGS. 6 and 7, to allow the pairing sort engine shown in FIG. 6 to further adapt to how the user ordered the playlist.

4. Appellant does not dispute that Ward teaches a “culling” operation but disagrees that Ward’s culling operation involves deleting a media file from the memory source.

Applicant notes that although Ward discloses an operation of “culling” a content list or the results used to form a play list (see Ward, col. 6, lines 61-64, and col. 8, lines 20-35), there is no disclosure or suggestion that such a culling operation will delete a media file (not results as in Ward) from a memory resource. Moreover, culling a play list is not the same thing as removing a media file from a memory resource.

5. Col. 6, lines 61-64 of Ward states the following:

At step S3, optionally, it then applies ranking or culling algorithms to the results, such as randomly removing elements, or only keeping the top N most popular result items.

6. When users lose interest in a media file on a media playback device, users will often delete that media file not only from the playlist but from the memory resource storing it.

Differences between the prior art and the claims at issue.

We incorporate herein the facts under *Differences between the prior art and the claims at issue* of the Facts section for claims 17-19 and 21-23 above and add the following.

7. The difference centers on the term “culling” as used in Ward. If in culling the playlist Ward deletes a media file from the memory resource, then no difference exists between the claimed subject matter and Ward. If not, then the difference would be that Ward does not disclose deleting a media file from the memory resource.

The level of ordinary skill in the pertinent art.

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We incorporate herein the fact under *The level of ordinary skill in the pertinent art* of the Facts section for claims 17-19 and 21-23 above.

Secondary considerations.

We incorporate herein the fact under *Secondary considerations* of the Facts section for claims 17-19 and 21-23 above.

C. PRINCIPLES OF LAW

We incorporate herein the Principles of Law set forth in the Principles of Law section for claims 17-19 and 21-23 above.

D. ANALYSIS

The dispute is over the scope of the term “culling” as used in Ward. There is no dispute that Ward “culls” a playlist and that that at least entails rejecting media files from a playlist which a user no longer would be interested in listening to. The question is whether in addition to rejecting media files, Ward also deletes the media files from the memory resource.

It is not entirely clear from Ward whether the “culling” operation includes deleting the media files. However, assuming Ward’s “culling” operation only involves rejecting media files, one of ordinary skill in the art reading Ward’s “culling” operation would nevertheless foresee going one step and deleting the media files altogether. This is so because when users lose interest in a media file on a media playback device, users will often delete that media file not only from the playlist but from the memory resource storing it (see Specification, p. 7, l. 25:

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“The memory 210 stores media files.”). Users will do this for a number of reasons, most commonly to increase the free space in the memory resource to make room for media files that they would be more interested in hearing. Whether or not Ward means to include a deleting step in describing the “culling” operation, which is arguable, a step of deleting culled and rejected media files would have been obvious to one of ordinary skill in the art given the expected benefits the user would obtain from doing so, namely increasing the free space on the memory resource.

E. CONCLUSION OF LAW

On the record before us, Appellants have failed to show that the Examiner erred in rejecting claim 20 over the prior art.

DECISION

The decision of the Examiner to reject claims 2, 4-10, and 12-23 is affirmed. The decision of the Examiner to reject claim 11 is reversed.

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)(iv).

AFFIRMED-IN-PART

vsh

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JOSEPH S. TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
TWO INDEPENDENCE WAY
P.O. BOX 5312
PRINCETON NJ 08543-5312