

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SHANE R. DEWING, BRAXTON WOODHAM,  
WESLEY W. BIGGS, HARRY C. EVANS III, and SCOTT A. BENDAR

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Appeal 2008-0026  
Application 10/243,883  
Technology Center 2100

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Decided: July 9, 2008

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Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and  
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-63. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

#### A. INVENTION

The invention at issue on appeal provides media content for mobile communication devices. The Appellants provide the following description of related art.

A typical system for distributing media content, such as audio-based ringtones, to mobile communication devices over a communication network includes a library of media content stored in a file server and a means for sending the media content to a device. Each piece of media content is stored in a format compatible with one or more communication devices. For example, an audio file stored in a Nokia proprietary format is considered to be compatible with all models of Nokia telephones. Among the various models of Nokia telephones, however, there may be different types of media capabilities. For example, one telephone model may be capable of playing an audio file such as "ringtones" of a certain byte duration and note range while another model has different duration and range capabilities.

Existing media content distribution systems do not account for these differences in device capabilities. Thus, a piece of media content associated with Nokia telephones may be sent to any Nokia telephone regardless of the capabilities of the particular telephone model. If the particular model receiving the content does not have the proper capabilities, the content may not be able to be played or, if it can be played, will be limited by the model capabilities. For example, the duration of the ringtone may be truncated or the note range modified to accommodate the capability of the particular telephone. Thus, the user of the device is not able to hear the "true" ringtone.

(Spec. 1.) In contrast, the Appellants' invention takes into consideration the media content capabilities of a mobile telephone when providing content thereto. More specifically, a rules-based engine compares attributes of the content with constraints on those attributes for a device. It may also take

into account the distribution channel over which the telephone operates. (*Id.* 2.)

#### B. ILLUSTRATIVE CLAIMS

Claims 1 and 63, which further illustrate the invention, follow.

1. A system for making one or more pieces of media content available for delivery to an end-user device, said system comprising:

a file server having a plurality of media content files stored therein;

a database adapted to associate content type attributes with each of the media content files and attribute capability constraints with the end-user device, the attribute capability constraints prescribing a range of acceptable values for content type attributes;

a first rules engine adapted to create a relationship available library of media content excluding all media content that have content type attributes outside the range of acceptable values.

63. A method of delivering media content to an end-user device over an associated delivery channel, said method comprising:

storing a plurality of media content files in a file server;

providing to a user interface a catalog identifying a subset of the plurality of media content, the subset including only those media content supported by both the end-user device and the delivery channel;

receiving a media content request from the user interface; and

delivering the media content to the end-user device over the delivery channel.

### C. REJECTIONS

Claims 1-18 and 21-63 stand rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,606,744 B1 ("Mikurak").

Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as obvious over Mikurak and U.S. Patent Application Pub. No. 2004/0264402 ("Whitmore").

## II. ISSUE

"Rather than reiterate the positions of the parties *in toto*, we focus on an issue therebetween." *Ex parte Kuruoglu*, No. 2007-0666, 2007 WL 2745820, at \*2 (BPAI 2007). "[T]he Examiner has selected an extremely large issued patent," (App. Br. 21), Mikurak, "and has selected from the patent a large number of widely separated and logically unrelated passages, in cookie-cutter fashion, in order to attempt to cover various of the [sic] terms and isolated concepts recited" (*id.*) by claims 1-63. The Appellants make the following arguments *inter alia*.

For example, although Mikurak indeed mentions databases, rules, and other such well-known concepts, the Examiner has failed to identify any passage or figure that illustrates or describes the claimed database that associates content-type attributes with each of the media content files and that associates attribute capability constraints with end-user devices. Furthermore, the Examiner has failed to find any teaching, disclosure, or description of a rules engine that creates a "relationship available library of media content" that excludes

media content associated with content-type attributes outside a range of acceptable values.

(*Id.*) Therefore, the issue is whether the Examiner has presented a *prima facie* case of unpatentability.

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims . . . . The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

### III. CLAIM CONSTRUCTION

"The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (citing *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983)). Here, considering all their limitations, the independent claims require creating a library or catalog of a subset of a plurality of media content files stored on a file server, wherein the subset includes only those media content files compatible with the capabilities of an end-user device.

### IV. ANTICIPATION ANALYSIS

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). "[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must

be literally present, arranged as in the claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894 (Fed. Cir. 1984); *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72 (Fed. Cir. 1983)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

Here, as aforementioned, the Examiner has selected from Mikurak "a large number of widely separated and logically unrelated passages, in cookie-cutter fashion, in order to attempt to cover various of the terms and isolated concepts recited" (App. Br. 21) by the claims.

"The PTO Rules of Practice require the examiner to cite only what he considers the 'best references.'" *E.I. du Pont de Nemours & Co. v. Berkley & Co.*, 620 F.2d 1247, 1266-67 (8th Cir. 1980). "The examiner is not called upon to cite *all* references that may be available, but only the 'best.'" MPEP § 904.03 (8th ed. rev. 7 Sep. 2007) (quoting 37 C.F.R. § 1.104(c)). *See also* MPEP § 706.02 ("Prior art rejections should ordinarily be confined strictly to the best available art.") "Multiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution and should therefore be avoided." *Id.* at § 904.03.

Similar observations apply to citing parts of an individual reference. The Examiner is not called upon to cite all parts of a reference that may be available but only the best. Multiplying citations to parts or a reference, any

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one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution.

That said, the Examiner's most relevant selection from Mikurak is "col. 244, lines 9-65" (Ans. 5), and his explanation thereof follows.

(A piece of the actual rule would look like: age = young adult (20-40) and gender = M (Male). This rule would now be the age-gender rule. It evaluates the user's age classification and gender. If the users [sic] age classification is "young adult" and male, then statement evaluates to be true and action is taken or the specified content is delivered. Thus, according to the rule, the action is not taken or excluded if the user's age is < 20 or > 40).

(*Id.*)

The Examiner has not shown that the reference's rule addresses the capabilities of an end-user device. "Instead, the rule specifies characteristics of a user" (App. Br. 20), i.e., a human. Nor has the Examiner shown that Mikurak uses the rule to create a library or catalog of a subset of a plurality of media content files stored on a file server. Instead, the reference explains that if the "statement evaluates to be true [then] action is taken or the specified content is delivered." (Col. 244, ll. 18-20.)

The absence of creating a library or catalog of a subset of a plurality of media content files stored on a file server, wherein the subset includes only those media content files compatible with the capabilities of an end-user device negates anticipation. Therefore, we reverse the rejection of claims 1-18 and 21-63.

## V. OBVIOUSNESS ANALYSIS

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). Here, the Examiner does not allege, let alone show, that the addition of Whitmore cures the aforementioned deficiency of Mikurak. Absent a teaching or suggestion of creating a library or catalog of a subset of a plurality of media content files stored on a file server, wherein the subset includes only those media content files compatible with the capabilities of an end-user device, we are unpersuaded of a *prima facie* case of obviousness. Therefore, we reverse the rejection of claims 19 and 20.

## VI. ORDER

In summary, the rejection of claims 1-18 and 21-63 under § 102(e) is reversed. The rejection of claims 19 and 20 under § 103(a) is also reversed.

REVERSED

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