

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Third Party Requester

v.

AFFINITY LABS OF TEXAS, LLC,
Patent Owner

Appeal 2014-003542
Reexamination 95/001,266
United States Patent 7,440,772 B2¹
Technology Center 3900

Before STEPHEN C. SIU, JEREMY J. CURCURI, and
IRVIN E. BRANCH, *Administrative Patent Judges*.

BRANCH, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ This patent (hereinafter “’772 patent”) issued to Russell W. White, et al., on October 21, 2008 based on Application 10/947,754, filed on September 23, 2004. The ’772 patent is the second in a chain of U.S. applications beginning with Application 09/537,812 (now Patent 7,187,947), filed on March 28, 2000. ’772 patent p. 1.

² Throughout this decision, we refer to: Request for *Inter Partes* Reexamination (control no. 95/001,266 “Request”), filed November 13, 2009; Right of Appeal Notice (“RAN”), mailed October 1, 2012; Patent Owners’ Appeal Brief (“PO App. Br.”) filed, December 31, 2012; Examiner’s Answer (“Ans.”), mailed May 14, 2013; and Patent Owner (Continued on next page.)

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Patent Owner appeals the Examiner's decision to reject claims 2–42, all pending claims, of which claims 4, 22, 32, and 36 are the independent claims.³ PO App. Br. 4.

We have jurisdiction under 35 U.S.C. §§ 134, and 315.

We affirm the Examiner's decision that claims 2–42 are unpatentable over the prior art.

I. STATEMENT OF THE CASE

A. Related Proceedings

We are informed by Patent Owner of the related proceedings listed in Patent Owner's Appeal Brief. PO App. Br. 3 and 24 (Appendix XI).

B. The Rejections Entered by the Examiner

Patent Owner appeals the Examiner rejecting the claims as follows (PO App. Br. 8–14; *accord* RAN 14, 19):

Claims 4, 5, 6, 11–16, 18, 20, 22, 23, 26, 32, 36, and 40–42 under 35 U.S.C. § 103(a) as unpatentable over Brooks, US Patent

Rebuttal Brief (“PO Reb. Br.”), filed June 13, 2013.

³ Patent Owner informs us that claim 1 was canceled and claims 2–7, 10, 11, 13, 14, and 17–21 were amended in response to the Action Closing Prosecution (ACP). The Examiner entered the amendments in the RAN. Claim 4 was amended to include the language recited in independent claim 1 (now canceled) and claims 2, 3, and 5–21 were amended to change their dependency from claim 1 to claim 4. No new claims have been added. PO App. Br. 4; *accord* RAN 1.

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7,339,993 B1 issued March 4, 2008 and Rolf, US Patent

7,065,342 B1 issued June 20, 2006 (Ground C);

Claims 19, 24, 25, and 37–39 under 35 U.S.C. § 103(a) as unpatentable over Brooks, Rolf, and RealJukeBox, RealJukebox Plus Manual, Real Networks, Inc. (1999) (Ground D);

Claims 40–42 under 35 U.S.C § 103(a) as unpatentable over Brooks, Rolf, and Mansour, US Patent 6,353,637 B1 issued March 5, 2002(Ground E);

Claims 2–16, 18, 19, 21–29, and 32–36 under 35 U.S.C. § 103(a) as unpatentable over Rolf and Van Zoest, US Patent 6,609,105 B2 issued August 19, 2003 (Ground Z);

Claims 17, 30, 31, and 37–39 under 35 U.S.C. § 103(a) as unpatentable over Rolf and Van Zoest (Ground AA);

Claims 37–39 under 35 U.S.C. § 103(a) as unpatentable over Rolf, Van Zoest, and RealJukeBox (Ground BB);

Claims 17, 30, and 31 under 35 U.S.C. § 103(a) as unpatentable over Rolf, Van Zoest, and Ozluturk, US Patent 6,157,619 issued December 5, 2000 (Ground CC);

Claim 20 is under 35 U.S.C. § 103(a) as unpatentable over Rolf, Van Zoest, and Leeke, US Patent 6,587,127 B1, issued July 1, 2003 (Ground DD);

Claims 40–42 under 35 U.S.C. § 103(a) as unpatentable over Rolf in view of Van Zoest, and Mansour (Ground EE).

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C. The Subject Matter Described in the '772 Patent

The '772 patent relates to an audio download system and method, including a user interface, wherein the same content is made available to different user devices in different formats. Abstract.

D. The Claims on Appeal

Claim 4, which is representative of the independent claims, reads as follows:

4. A content delivery method comprising:
 - maintaining a user interface page that is accessible to a wireless user device that has a player configured to execute a specific format of content file, the user interface page configured to present a user with a first graphical element associated with a piece of selectable content;
 - recognizing receipt of a request for the piece of selectable content from the wireless user device;
 - in response to receiving the request, making a first version of the piece of selectable content available for downloading to the wireless user device and a second version of the piece of selectable content available for downloading to a personal computer of the user, wherein the first version has the specific format and the second version has a different format playable by the personal computer;
 - sending the first version of the piece of selectable content to the wireless user device; and
 - sending the second version of the piece of selectable content to the personal computer [the last three elements collectively “the dual download feature”].

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II. ISSUES

Patent Owner's arguments (PO App. Br. 9–14; PO Reb. Br. 2–5) raise the following issues:

1. Under 35 U.S.C. § 103, are the Examiner's proposed rejections over Brooks and Rolf supported by some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness?
2. Under 35 U.S.C. § 103, has the Examiner established that Brooks and Rolf collectively would have taught or suggested the dual download feature?
3. Under 35 U.S.C. § 103, has the Examiner established that Rolf and Van Zoest collectively would have taught or suggested the dual download feature?
4. Does Patent Owner's evidence of commercial success overcome the Examiner's *prima facie* case that the claims are obvious?

III. ANALYSIS

A. *The Dual Download Feature*

Patent Owner argues that the dual download feature is not obvious over either Brooks and Rolf (rejection C) or Rolf and Van Zoest (rejection Z) for essentially the same reasons. PO App. Br. 9–13; PO Reb. 3–5. Namely, Patent Owner asserts that Rolf does not teach or suggest that content is simultaneously made available to two different devices in response to a single request. PO App. Br. 9–13. We disagree with Patent Owner for at least the reasons stated by the Examiner. Ans. 9–14.

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We note specifically the Examiner's finding that Rolf discloses "the purchased recording or album may be downloaded to the wireless communications device 12 (if memory space suffices) or, alternatively, may be downloaded to the user's personal storage unit 16." Ans. 10 (citing Rolf 7:12–16 (underlining omitted)). We agree with the Examiner that, according to Rolf, "*before* the user selects a destination device, the recording is made available for downloading to both devices inasmuch as the user is allowed to select either device as a destination for sending the content." *Id.* at 11.

To the extent Patent Owner argues that the dual download feature requires both the first and second versions actually to be downloaded in response to the same request (PO Reb. 3–4), we disagree with Patent Owner and agree with the Examiner that one of the downloads may be made following a subsequent request and meet the limitation (Ans. 11–12). Patent Owner's argument that the subsequent request would result in different versions, which are necessarily not the same versions made available in response to the prior request (PO Reb. Br. 3–4), is unavailing because it is premised on "making available" meaning preparing, as if the first and second versions would not, for example, pre-exist the initial request and are only prepared in response to a request. We do not find such a narrow construction warranted, but in any case, Patent Owner's arguments do not persuade us of error in the Examiner's proposed scenario (Ans. 11–12). Nor are we persuaded that such a modification, even if Patent Owner's construction were the correct construction, would have been beyond the skill of an ordinarily skilled artisan in view of the combined teachings of either Brooks and Rolf

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or Rolf and Van Zoest and therefore obvious. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (“if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”).

Accordingly, we are unpersuaded of error in the Examiner’s determination that both the combined teachings of Brooks and Rolf (rejections C) and the combined teachings of Rolf and Van Zoest (rejections Z) would have taught or suggested the dual download feature. We therefore find no error in rejections C–E or Z–EE based on the foregoing.

B. The Combination of Brooks and Rolf

Patent Owner argues that the Examiner’s proposed combination of Brooks and Rolf (rejections C–E) is not supported by some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. PO App. Br. 9–10; PO Reb. Br. 2–3. We disagree for at least the reasons stated by the Examiner. Ans. 7–9. We note the following for emphasis.

Patent Owner notes the Examiner’s observation that “[t]here is no teaching or suggestion in Brooks that it would be desirable, beneficial, or even optional to provide data to both a requesting device and a non-requesting device based on a single request” (PO App. Br. 9 (citing RAN 8)), and argues that this statement negates the Examiner’s finding that “Brooks recognizes the inherent advantages of formatting the same content in

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different ways for different devices” (*id.* (citing RAN 11 and the Examiner’s reference to Brooks 7:21–33)). We are not persuaded the statements are in conflict; Patent Owner’s assertion is simply unfounded. Brooks is simultaneously capable of teaching the formatting of content for different devices (“gateway computer 100 is configured to receive video data from computer system 110 and to provide video data to each device according to that device’s bandwidth limitations, and in the output format desired” (Brooks 7:22–25)) while also *not* teaching that the differently formatted content is provided to a requesting device and a non-requesting device based on a single request. We also do not find the Examiner to have provided a mere conclusory statement as Patent Owner asserts without foundation. PO App. Br. 9.

We also are not persuaded of error by Patent Owner’s naked assertion that “the idea to modify Brooks with parts of Rolf . . . comes from the guiding hand of hindsight.” *Id.* at 10.

Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, such a reconstruction is proper.

In re McLaughlin, 443 F.2d 1392, 1395 (CCPA 1971). Here, Patent Owner provides insufficient persuasive argument or evidence that the Examiner has engaged in *impermissible* hindsight reasoning. The Request articulates a clear line of reasoning why it would have been obvious for one of ordinary

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skill in the art to have combined Brooks and Rolf (Request 31), which the Examiner adopted (Action Closing Prosecution 16 (mailed June 27, 2011); *accord* RAN 14). The reasoning (e.g., “[t]he combination of Brooks with Rolf would have been obvious to a person of ordinary skill in the art because they both allow a server to format content for portable devices and personal computers”; and “they both have web based user interfaces that facilitate the user accessing the remotely stored content,” Request 31) is not based on hindsight gleaned from Patent Owner’s Specification, but instead shows the claimed invention amounts to no more than a combination of then familiar elements. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

Patent Owner also asserts that because Brooks requires a request from each download device, it teaches away from providing a choice of destination devices. PO Reb. Br. 2. Building on that argument, Patent Owner asserts error because a secondary reference cannot cure a teaching away in a primary reference. *Id.* We are not persuaded that Brooks teaches away from Patent Owner’s claimed invention.

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Ricoh Co., Ltd. v. Quanta Computer, Inc.*, 550 F.3d 1325, 1332 (Fed. Cir. 2008) (citations omitted). A reference does not teach away if it merely expresses a general preference for an

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alternative invention from amongst options available to the ordinarily skilled artisan, and the reference does not discredit or discourage investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). Patent Owner has not persuasively established that, by teaching that individual download devices each request content, Brooks discredits or discourages content being made available to multiple devices in response to a single request.

In view of the foregoing, we are not persuaded that the Examiner's proposed combination of Brooks and Rolf is unsupported by some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness and are thus unpersuaded of error in the Examiner's rejections based on Brooks and Rolf (rejections C–E) in this regard.

C. Evidence of Commercial Success

Patent Owner argues that Patent Owner has provided sufficient evidence of commercial success to overcome the Examiner's determination of obviousness. App. Br. 13–14; PO Reb. Br. 5. We disagree for at least the reasons stated by the Examiner. Ans. 15–17. We do not find the Examiner to have failed to consider the evidence, as Appellant asserts. PO Reb. Br. 5. The Examiner found the Evidence insufficient. Ans. 15. We also are unpersuaded of error by Appellant's assertion that the Examiner relied on Requester's representation that it did not practice the invention in reaching the conclusion that the evidence of commercial success was insufficient to overcome obviousness. PO Reb. Br. 5. We find no error in the Examiner's

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determination even in the face of Requester's decision to take a license and withdraw from this proceeding.

Accordingly, in view of the foregoing and because Patent Owner does not otherwise argue the rejections with particularity, we are unpersuaded of error in rejections C–E and Z–EE.

VII. DECISION

The Examiner's decision that claims 2–42 are unpatentable over the prior art is affirmed.

In the event neither party files a request for rehearing within the time provided in 37 C.F.R. § 41.79, and this decision becomes final and appealable under 37 C.F.R. § 41.81, a party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

AFFIRMED

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