

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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8 *Ex parte* MICHAL WAYNE BROWN, MARK JOSEPH HAMZY, and  
9 SCOTT THOMAS JONES  
10

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12 Appeal 2007-0575  
13 Application 09/946,202<sup>1</sup>  
14 Technology Center 2100  
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17 Decided: November 8, 2007  
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21 Before ALLEN R. MACDONALD, JEAN R. HOMERE, and CAROLYN  
22 D. THOMAS, *Administrative Patent Judges*.

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24 THOMAS, C., *Administrative Patent Judge*.

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26 DECISION ON APPEAL  
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<sup>1</sup> Filing date: September 5, 2001. The real party in interest is International Business Machines Corporation.

1 STATEMENT OF THE CASE<sup>2</sup>

2 Appellants appeal under 35 U.S.C. § 134 from a Final Rejection  
3 of claims 1-51 entered June 15, 2005. We have jurisdiction under  
4 35 U.S.C. § 6(b).

5 Appellants invented an apparatus and method for providing access  
6 rights information on computer accessible content. The apparatus and  
7 method provides a mechanism through which access rights information is  
8 provided in association with information and content such that use of the  
9 information and content is controlled based on the access rights information.  
10 (Specification 4:3-9). The claims set forth Appellants' claimed invention,  
11 which is a method of controlling access (claims 1, 6, 9, and 37), a medium  
12 for controlling access to content (claims 13 and 47), and an apparatus for  
13 controlling access (claims 25 and 42).

14 Claims 1-51 are pending and claims 1, 6, 9, 13, 25, 37, 42, and 47 are  
15 independent claims. As best representative of the disclosed and claimed  
16 invention, claim 1 is reproduced below:

- 17 1. A method of controlling access to content, comprising:  
18 receiving the content and access rights information associated  
19 with the content, wherein the access rights information identifies a manner  
20 in which a user may earn access to the content;  
21 receiving an action from a user to access the content; and

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<sup>2</sup> Throughout our opinion, we shall refer to Appellants' Appeal Brief ("Br.") filed on October 3, 2005, and Reply Brief ("Reply Br.") filed on September 18, 2006, and to the Examiner's Answer ("Answer") mailed on July 17, 2006, for the respective details thereof.





1 *Mai*

2 1. Mai describes a “credit system and method that enables users to  
3 purchase and earn credits that may be redeemed to purchase multimedia  
4 content transmitted to a client ... permissive marketing offer specifies a  
5 number of credits that the user will be rewarded for performance of a  
6 requested action.” (Mai, Abstract).

7 2. Mai discloses that “the broadband content delivery system  
8 10 also transmits a control channel (signal) that is received by the  
9 client 18. The control channel contains information and instructions  
10 that help enable the client 18 (i.e., the client software) to access and  
11 control the content 20 provided by the broadband content delivery  
12 system 10. The control channel is used to issue commands or  
13 directives to the client 18.” (Mai, paragraph [0029]).

14 3. Mai discloses that “[t]he client software enables access to  
15 the broadband content...” (Mai, paragraph [0027]).

16 4. Mai discloses that “[t]hese commands or directives may  
17 result in feedback or a report back from the client 18 to the NOC 12  
18 via the Internet.” (Mai, paragraph [0029]).

19 5. Mai discloses that “[t]he credit system and method enables  
20 permissive marketing in which third-parties to [sic] reward users with  
21 credits in exchange for the users performing a requested action.”  
22 (Mai, Abstract).

1           6. Mai describes that “the credit system enables advertisers or  
2 vendors to promote their products or services through permissive marketing  
3 by awarding credits to users that view their ads, test their products or  
4 purchase their products on-line, among other things.” (Mai, paragraph  
5 [0026]).

6           7. Mai further states that “the present invention may be used to  
7 purchase and earn credits that may be used to access and purchase  
8 broadband content...” (Mai, paragraph [0027]).

9           8. Mai discloses “[t]he PPV server 581 receives and processes  
10 the PPV order, ... If the user does not have sufficient credits, the  
11 method 80 may include requesting the user to purchase more credits  
12 861, ... If the user does not purchase more credits, the method 80 ends  
13 and the PPV order is deleted.” (Mai, paragraph [0047]).

14           9. Mai discloses that “additional content 20 may be provided  
15 by third-parties as on-demand broadband content ...” (Mai, paragraph  
16 [0031]).

17           10. Mai further discloses that “[t]he web browser 56 also is  
18 used to access the NOC 12, the ISP 16, and third-party websites that  
19 include other content... .” (Mai, paragraph [0036]).

20           11. Mia discloses that “... it may maintain a ... database, for  
21 storing information concerning users, the access rights of the users  
22 and their account status.” (Mai, paragraph [0040]).





1           24. Kim discloses that “[t]he user selects a new site and while the  
2 browser program is retrieving the data from the server over the Internet, a  
3 transition screen is displayed.... This transition screen includes a full  
4 browser advertisement during the transition time between displays of the  
5 previous information and the new site information.” (Kim, paragraph  
6 [0068]).

7           25. Kim discloses that “[t]he client software detects the URL and text  
8 information, then runs a matching algorithm to search for AD inventory as  
9 described in the next section. The client software also detects whether the  
10 downloading time of the target web page exceeds a pre-determined threshold  
11 value. If it does, then a matched AD is presented.” (Kim, paragraph  
12 [0077]).

13           26. Kim discloses “[t]he users of the client 305 do not request the  
14 information positively. The information provider 301 provides the  
15 information with the intention of interesting the user 313. The user can  
16 enjoy the automatic presentation of the information by the information  
17 presentation part 309, and can actively retrieve and use the information by  
18 the information catalog 311.” (Kim, paragraph [0069]).

19           27. Kim discloses that “[t]he client 305 always communicates with  
20 the server 303 by...downloading client program update information and  
21 advertisement presentation control update information, etc.” (Kim,  
22 paragraph [0070]).



1 underlying factual determinations including (1) the scope and content of the  
2 prior art, (2) any differences between the claimed subject matter and the  
3 prior art, (3) the level of skill in the art, and (4) where in evidence, so-called  
4 secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18  
5 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these  
6 questions might be reordered in any particular case, the [*Graham*] factors  
7 continue to define the inquiry that controls.”)

8 In *KSR*, the Supreme Court emphasized “the need for caution in  
9 granting a patent based on the combination of elements found in the prior  
10 art,” *id.* at 1739, and discussed circumstances in which a patent might be  
11 determined to be obvious. In particular, the Supreme Court emphasized that  
12 “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of  
13 *Hotchkiss*, 11 How. 248.” *KSR*, 127 S. Ct. at 1739 (citing *Graham v. John*  
14 *Deere Co.*, 383 U.S. 1, 12 (1966) (emphasis added)), and reaffirmed  
15 principles based on its precedent that “[t]he combination of familiar  
16 elements according to known methods is likely to be obvious when it does  
17 no more than yield predictable results.” *Id.* The Court explained:

18 When a work is available in one field of endeavor,  
19 design incentives and other market forces can  
20 prompt variations of it, either in the same field or a  
21 different one. If a person of ordinary skill can  
22 implement a predictable variation, § 103 likely  
23 bars its patentability. For the same reason, if a  
24 technique has been used to improve one device,  
25 and a person of ordinary skill in the art would  
26 recognize that it would improve similar devices in

1                   the same way, using the technique is obvious  
2                   unless its actual application is beyond his or her  
3                   skill.

4 *Id.* at 1740. The operative question in this “functional approach” is thus  
5 “whether the improvement is more than the predictable use of prior art  
6 elements according to their established functions.” *Id.*

7           The Supreme Court stated that there are “[t]hree cases decided after  
8 *Graham* [that] illustrate this doctrine.” *Id.* at 1739. “In *United States v.*  
9 *Adams*, ... [t]he Court recognized that when a patent claims a structure  
10 already known in the prior art that is altered by the mere substitution of one  
11 element for another known in the field, the combination must do more than  
12 yield a predictable result.” *Id.* at 1739-40. “*Sakraida and Anderson’s-Black*  
13 *Rock* are illustrative – a court must ask whether the improvement is more  
14 that the predictable use of prior art elements according to their established  
15 function.” *Id.* at 1740.

16           The Supreme Court stated that “[f]ollowing these principles may be  
17 more difficult in other cases than it is here because the claimed subject  
18 matter may involve more than the simple substitution of one known element  
19 for another or the mere application of a known technique to a piece of prior  
20 art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be  
21 necessary for a court to look to interrelated teachings of multiple patents; the  
22 effects of demands known to the design community or present in the  
23 marketplace; and the background knowledge possessed by a person having  
24 ordinary skill in the art, all in order to determine whether there was an

1 apparent reason to combine the known elements in the fashion claimed by  
2 the patent at issue.” *Id.* at 1740-41. The Court noted that “[t]o facilitate  
3 review, this analysis should be made explicit.” *Id.*, citing *In re Kahn*, 441  
4 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds  
5 cannot be sustained by mere conclusory statements; instead, there must be  
6 some articulated reasoning with some rational underpinning to support the  
7 legal conclusion of obviousness”). However, “the analysis need not seek out  
8 precise teachings directed to the specific subject matter of the challenged  
9 claim, for a court can take account of the inferences and creative steps that a  
10 person of ordinary skill in the art would employ.” *Id.*

11 The scope of patentable subject matter under section 101 is broad, but  
12 not infinitely broad. “Congress included in patentable subject matter *only*  
13 those things that qualify as ‘any ... process, machine, manufacture, or  
14 composition of matter, or any ... improvement thereof....’” *In re*  
15 *Warmerdam*, 33 F.3d 1354, 1358 (Fed. Cir. 1994) (quoting 35 U.S.C.  
16 § 101) (emphasis added). Thus, “[d]espite the oft-quoted statement in the  
17 legislative history of the 1952 Patent Act that Congress intended that  
18 statutory subject matter ‘include anything under the sun that is made by  
19 man,’[citation omitted], Congress did not so mandate.” *Id.*

## 20 21 ANALYSIS

22 Claims 1-51 are pending. Appellants separately argue claims 1, 2, 3,  
23 6, 9, 12, 37, 41, 38, 39, and 40.

1 For claims 4, 5, 7, 8, 10, 11, 13-36, and 42-51, Appellants appear to  
2 merely repeat the same arguments made for claim 1.<sup>3</sup> We will therefore  
3 treat claims 4, 5, 7, 8, 10, 11, 13-36, and 42-51, as standing or falling with  
4 claim 1. Claims 2, 3, 6, 9, 12, 37, 41, 38, 39, and 40 will be addressed  
5 separately. *See* 37 C.F.R. § 41.37(c)(1)(vii). *See also In re Young*, 927 F.2d  
6 588, 590 (Fed. Cir. 1991).

7

8 *Analysis Regarding Claim 1*

9 With respect to Claim 1, Appellants contend that “none of the cited  
10 references teach or otherwise suggest that the received access rights  
11 information themselves are used to identify a manner in which a user may  
12 earn access to the content.” (Br. 10). Appellants further contend that “the  
13 credits earned in Marks are generic and not based on particular *received*  
14 content.” (emphasis in original). (Reply Br. 2).

15 The Examiner states the “Mai fails to teach wherein the access rights  
16 information identifies a manner in which a user may earn access to the  
17 content.” (Answer 4). We disagree.

18 Claims are given their broadest reasonable construction “in light of  
19 the specification as it would be interpreted by one of ordinary skill in the

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<sup>3</sup> Although Appellants appear to group the claims in the Appeal Brief, the limitations argued were not always found in the individual claims listed. As such, the majority of the claims shall stand or fall with claim 1.

1 art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir.  
2 2004).

3 Appellants’ Specification discloses that “[t]he access rights  
4 information may be used to control access to content, identify how access to  
5 content may be obtained,...” and “... access rights information of the present  
6 invention may be used to define the amount of money, credits, points, etc.  
7 that is earned by a user that accesses the associated content.” (Appellants’  
8 Specification 4, ll. 19-31).

9 Similarly, Mai discloses a credit system that enables users to purchase  
10 (i.e., gain access to) and earn credits that may be redeemed to purchase  
11 multimedia content transmitted to a client. In Mai, the delivery system used  
12 to transmit the content also transmit a control channel (signal) that contains  
13 information and instructions that help enable the client to access and control  
14 the content. Further, in Mai, the control channel is used to issue commands  
15 or directives to the client. (FF 1-3). Thus, it is our view that Mai discloses  
16 receiving content and access rights information (e.g., the control channel  
17 signal) associated with the content, wherein the access rights information  
18 identifies a manner (e.g., information and instructions) in which a user may  
19 earn access to the content, as set forth in claim 1.

20 For at least the reasons noted above regarding Mai’s control channel  
21 signal, Appellants’ argument that the credits earned in Marks are generic and  
22 not based on particular received content is insufficient given Mai’s  
23 disclosure.

1           Mai further discloses that the transmitted commands or directives may  
2 result in feedback or a report back from the client. (FF 4). In addition, Mai  
3 discloses that through permissive marketing (i.e., advertisements), users are  
4 rewarded with credits in exchange for the users performing a requested  
5 action. (FF 5-7). Also, Mai discloses that the PPV server receives a PPV  
6 order (from the client). (FF 8). Thus, Mai discloses receiving an action  
7 from a user (e.g., in the form of feedback or users performing a requested  
8 action) to access the content, as set forth in claim 1.

9           In addition, Mai discloses determining if the user has earned access to  
10 the content, and if not, disallowing access to the content by the user. (FF 8).

11           The Examiner further contends that “Marks teaches a method for  
12 controlling access to content wherein access rights identifies how a user may  
13 earn access to content.” (Answer 4). We agree.

14           Marks discloses methods for providing payment for internet  
15 programming including providing audio/video commercials within the  
16 programming themselves and allowing the user to earn credits so as to  
17 access such programming by providing personal information to the providers  
18 so as to personalize such commercials. (FF 14-16). Thus, Marks discloses  
19 means for controlling access to content based on credits earned by enabling  
20 delivery of advertisements.

21           Here “access rights information” is interpreted as any data which  
22 allows the freedom or ability to obtain or make use of something. Marks  
23 disclose earning credits so as to gain access to content. Claims are given

1 their broadest reasonable construction “in light of the specification as it  
2 would be interpreted by one of ordinary skill in the art.”

3 As noted above, both Mai and Marks disclose, *inter alia*, gaining  
4 access to content through earned credits, which are earned by a user  
5 performing an action. Appellants’ own Specification discloses that access  
6 rights may define the amount of credits that is earned by a user. As such,  
7 based on the scope and content of Mai and Marks, it is our opinion that the  
8 facts support the conclusion that the method in claim 1 is disclosed in the  
9 combination of Mai and Marks. Accordingly, we conclude that the subject  
10 matter of claim 1 would have been obvious to one of ordinary skill in the art  
11 given the teachings of Mai and Marks.

12  
13 *Analysis Regarding Claim 2*

14 With respect to Claim 2, Appellants contend that “none of the cited  
15 references teach or otherwise suggest the claimed access rights information  
16 that identifies how a user may earn access to content by a requisite user  
17 action.” (Br. 11).

18 As noted above, Mai discloses a control channel signal that helps the  
19 client to access and control the received content. (FF 2). The control  
20 channel in Mai includes commands or directives that may require a feedback  
21 from the client. (FF 4). In addition, Mai discloses receiving an order for a  
22 PPV and if the user does not have sufficient credits, the method includes  
23 requesting the user to purchase more credits. (FF 8).

1           Thus, Mai teaches presenting a user action to the user in response to a  
2 request for a PPV program. In Mai, the user action (earning/purchasing  
3 more credits) must be performed to earn access to the content (PPV).  
4 Accordingly, we conclude that the subject matter of claim 2 would have  
5 been obvious to one of ordinary skill in the art given the teachings of Mai  
6 and Marks.

7

8 *Analysis Regarding Claim 3*

9           With respect to Claim 3, Appellants contend that “Claim 3 expressly  
10 recites that the other access rights information *identifies a quantity earned*  
11 *through a particular type of action performed on the associated other*  
12 *content.*” (Br. 12) (emphasis in original).

13           The Examiner contends that “Mai-Marks teaches ... receiving other  
14 content and other access rights information associated with the other content,  
15 wherein the other access rights information identifies a quantity earned  
16 through a particular type of action performed on the associated other  
17 content.” (Answer 5). We agree.

18           For example, Mai discloses content, additional content, and other  
19 content that is used in its credit system. (FF 2, 9-10). Thus, Mai discloses  
20 receiving other content. Mai further discloses that access rights of the users  
21 are stored in databases regarding the broadband content delivery system.  
22 (FF 11). Thus, Mai discloses other access rights information associated with  
23 the other content. Mai further discloses that credits can be earned and used

1 to access the content. (FF 7). Mai discloses how a specific quantity of  
2 credits can be earned for performing a requested action. (FF 1). Mai further  
3 discloses that watching an infomercial, for example, can lead to earning a  
4 credit reward of one hundred (100) credits. (FF 12). Thus, Mai discloses  
5 receiving other content and access rights and a quantity earned through a  
6 particular type of action performed.

7 Marks also discloses other content (ads) being delivered with  
8 audio/visual programming. (FF 17). Furthermore, Marks discloses that  
9 advertising (other content) appear in conjunction with content. (FF 18).

10 Accordingly, we conclude that the subject matter of claim 3 would  
11 have been obvious to one of ordinary skill in the art given the teachings of  
12 Mai and Marks.

13

#### 14 *Analysis Regarding Claim 6*

15 With respect to Claim 6, Appellants contend that “none of the cited  
16 references teach or suggest the claimed feature of ‘determining a quantity  
17 earned by a user through accessing the content based on the associated  
18 access rights information, *wherein the received access rights information*  
19 *identifies a quantity earned through a particular type of action performed by*  
20 *the user on the content and is part of the content’.” (Br. 12) (emphasis in  
21 original).*

22 In the present invention, the access rights information is a part of the  
23 content. Appellants’ Specification defines “a part of the content” as

1 “inserting the access rights information in the file header”, for example.  
2 (Appellants’ Specification 42, lines 19-21). Although the access rights  
3 information is not limited to being in the file header, it is required that the  
4 access rights information be a part of the content. Mai discloses inserting  
5 instructions in a packet header in the infomercial. (FF 13). Thus, Mai  
6 discloses access rights information that is a part of the content.

7 Accordingly, we conclude that the subject matter of claim 6 would  
8 have been obvious to one of ordinary skill in the art given the teachings of  
9 Mai and Marks.

10

11 *Analysis Regarding Claims 9 and 12*

12 With respect to Claim 9, Appellants contend that “none of the cited  
13 references teach or suggest the claimed feature of *receiving access rights*  
14 associated with content, where the content is an electronic mail message.”  
15 (Br. 13) (emphasis in original). With respect to Claim 12, Appellants  
16 contend that “none of the cited references teach or suggest the claimed  
17 feature of ‘wherein the method is implemented in an electronic mail  
18 application’.” (Br. 14).

19 At least Marks disclose that email has become a well-established  
20 method for Internet advertising. (FF 20). Accordingly, we conclude that the  
21 subject matter of claims 9 and 12 would have been obvious to one of  
22 ordinary skill in the art given the teachings of Mai, Marks, and Brown.

23

1 *Analysis Regarding Claim 37*

2           With respect to Claim 37, Appellants contend that “Claim 37  
3 determines a rendering order based on actual received data – the received  
4 access rights information. None of the cited references teach or suggest an  
5 order of rendering that is determined based upon data actually received.”  
6 (Br. 15). Appellants further contend that “there would have been no  
7 motivation to modify the teachings of Kim to base the order that pages are  
8 rendered on content ... that is received.” (Br. 15). Appellants also contend  
9 that “Mai does not teach or otherwise provide the missing claimed feature of  
10 receiving main content access rights information.” (Br. 15).

11           The Examiner contends that Kim discloses “... the main content is the  
12 target URL, ... the additional content is an advertisement, and determining  
13 ... if the advertisement should be rendered first.” The Examiner further  
14 contends that Mai discloses “the use of access rights information in files.”  
15 (Answer 11-12). We agree.

16           Our findings above regarding Mai’s access rights information are  
17 equally applicable here. Regarding Kim, Kim discloses presenting  
18 advertisement materials in a transition screen while the user is waiting for  
19 the target URL. (FF 21-22). Kim further discloses that such advertisement  
20 is delivered after determining whether the downloading time of the target  
21 web page exceeds a pre-determined threshold value. (FF 23-25). Thus, it is  
22 our opinion that while Mai discloses receiving main content with main  
23 access rights information, Kim discloses receiving additional content (an

1 AD) and determining if the received additional content is to be rendered  
2 before the main content. Accordingly, we conclude that the subject matter  
3 of claim 37 would have been obvious to one of ordinary skill in the art given  
4 the teachings of Kim and Mai.

5

6 *Analysis Regarding Claim 41*

7 With respect to Claim 41, Appellants contend that “none of the cited  
8 references teach or suggest the claimed feature of ‘wherein the main access  
9 rights information specifies that the additional content must be accessed by a  
10 user before accessing the main content’.” (Br. 16).

11 The Examiner contends that “*Kim-Mai* teaches ... the main access  
12 rights information specifies that the additional content must be accessed by a  
13 user before accessing the main content.” (Answer 12). We agree.

14 As noted above, Mai discloses the control channel signal that contains  
15 information regarding access to content. (FF 2). Kim further discloses that  
16 the client’s software detects downloading time and determines if the  
17 additional content will be rendered first. (FF 23-25). Additionally, Mai  
18 discloses a permissive marketing system whereby the user in certain  
19 circumstances must access additional content in order to gain access to the  
20 main content. (FF 7-9). Thus, it is our view that both Kim and Mai  
21 discloses situations wherein the access rights information (software)  
22 specifies that additional content must be accessed before accessing the main  
23 content. Accordingly, we conclude that the subject matter of claim 41

1 would have been obvious to one of ordinary skill in the art given the  
2 teachings of Kim and Mai.

3

4 *Analysis Regarding Claim 38*

5 With respect to Claim 38, Appellants contend that “Kim expressly  
6 teaches away from user interaction when transitioning from one user  
7 selected page to another.” (Br. 17). Appellants further contend that “[n]ot  
8 only is there no suggestion or motivation in Kim to modify the teachings in  
9 accordance with the features of Claim 38, such a modification would defeat  
10 the expressed desires of Kim, strongly evidencing non-obviousness.” (Br.  
11 17).

12 The Examiner contends that “Marks teaches rendering content  
13 responsive to receiving a user interaction associated with additional  
14 content.” (Answer 13). We agree.

15 Marks disclose that a user can gain access to content by enabling the  
16 delivery of advertisement. (FF 15-17). Furthermore, Mai discloses how  
17 watching an infomercial can lead to earning credit, which can be used to  
18 access content. (FF 12). Thus, both Mai and Marks disclose rendering main  
19 content responsive to receiving a user interaction associated with additional  
20 content.

21 It is our opinion that Appellants’ argument that Kim teaches away  
22 from user interaction is insufficient. While Kim teaches that the users do not  
23 request the information positively, Kim does disclose that the user can

1 actively retrieve and use the information (FF 26). Thus, some user  
2 interaction is contemplated by Kim.

3 Accordingly, we conclude that the subject matter of claim 38 would  
4 have been obvious to one of ordinary skill in the art given the teachings of  
5 Kim, Mai, and Marks.

6

7 *Analysis Regarding Claim 39*

8 With respect to Claim 39, Appellants contend that “none of the cited  
9 references teach or suggest the claimed feature of ‘wherein receiving  
10 additional content further comprises receiving additional access rights  
11 information associated with the additional content’.” (Br. 17). We disagree.

12 Kim discloses receiving advertisement presentation control update  
13 information. (FF 27). Thus, it is our view that Kim discloses receiving  
14 additional access rights information associated with the additional content.

15 Accordingly, we conclude that the subject matter of claim 38 would  
16 have been obvious to one of ordinary skill in the art given the teachings of  
17 Kim, Mai, and Marks.

18

19 *Analysis Regarding Claim 40*

20 With respect to Claim 40, Appellants contend that “since Mai does not  
21 teach receiving additional access rights information (since Kim is being  
22 relied upon for such teaching), it necessarily follows that Mai does not teach  
23 the particulars of the claimed additional access rights information detailed in

1 Claim 40.” (Br. 18). Appellants further contend that “Mai ...described  
2 crediting a user account, where a verification server *determines a credit*  
3 *award from a verification database*, and thus it is not with respect to any  
4 type of information received by a user...” (Br. 18) (emphasis in original).

5 Kim discloses dynamically configuring the time interval for showing  
6 the additional content from within the client or from a remote server. (FF  
7 28). Thus, it is our view that Kim discloses additional access rights  
8 information is enabled to quantify an amount of the user interaction with the  
9 additional content. Accordingly, we conclude that the subject matter of  
10 claim 40 would have been obvious to one of ordinary skill in the art given  
11 the teachings of Kim, Mai, and Marks.

#### 12 13 NEW GROUND OF REJECTIONS

14 In addition to affirming the Examiner’s rejection of claims 1-51 under  
15 35 U.S.C. § 103(a), this decision, pursuant to our authority under 37 C.F.R.  
16 § 41.50(b), contains new grounds of rejection.

17 Claims 1-8, 13-24, and 47-51 are rejected under 35 U.S.C. § 101  
18 because the claimed invention is directed to non-statutory subject matter.  
19 Claims 1 and 13, reproduced *supra*, are representative.

#### 20 *Regarding Claim 1*

21 Specifically, it is our view that claim 1 is directed to an unpatentable  
22 abstract idea because it is neither tied to a particular machine nor operated to  
23 change materials to a different state or thing.

1            “[T]he Supreme Court has held that a claim reciting an algorithm or  
2 abstract idea can state statutory subject matter only if, as employed in the  
3 process, it is embodied in, operates on, transforms, or otherwise involves  
4 another class of statutory subject matter, i.e., a machine, manufacture, or  
5 composition of matter. 35 U.S.C. § 101.... Thus, a claim that involves both  
6 a mental process and one of the other categories of statutory subject matter  
7 (i.e., a machine, manufacture, or composition) may be patentable under  
8 § 101.” *See In Comiskey*, 499 F.3d 1365, 1376-77 (Fed. Cir. 2007).

9            “However, mental processes –or processes of human thinking-  
10 standing alone are not patentable even if they have practical application.”  
11 *Id.*

12            Independent claim 1 recites “[a] method of controlling access to  
13 content”. Claim 1 does not necessarily require a machine, and claim 1 does  
14 not describe a process of manufacture or a process for the alteration of a  
15 composition of matter. It is our view that claim 1 merely claims the mental  
16 process of controlling access to content by the decision of a human. In  
17 essence, claim 1 describes “determining if the user has earned access to the  
18 content”, and thus claims the use of mental processes to allow access to  
19 content. Thus, claim 1 seeks to patent the use of human intelligence in and  
20 of itself.

21            For the above reasons, we find that claims 1-8 recite non-statutory  
22 subject matter. Claims 2-8 share the same interpretations as discussed *supra*

23

1 for claim 1. For the reasons *supra*, we conclude that claims 2-8 are also  
2 directed to non-statutory subject matter.

3

4 *Regarding Claim 13*

5 Specifically, claim 13 is directed to “[a] computer program product in  
6 a computer readable medium...” and Appellants explicitly states that the  
7 “computer-readable media include ... transmission-type media such as  
8 digital and analog communications links.” (FF 29).

9 We find that Appellants’ description of a ‘computer readable media’  
10 implicates carrier waves and signals despite the absence of such terms in the  
11 description.

12 That said, the issue, quite simply, is whether a claimed computer  
13 readable media that is broad enough to include transmission-type media – a  
14 media that includes carrier waves and signals – is statutory subject matter.  
15 We have argued that a carrier wave or signal is not statutory subject matter  
16 because it does not fall within any of the four categories of statutory subject  
17 matter. *See In re Petrus A.C.M. Nuijten*, --- F.3d ---, (2007 WL 2728397)  
18 (Fed. Cir. Sept. 20, 2007). In this instance, claim 13 includes both statutory  
19 and non-statutory subject matter that, according to recent proposed USPTO  
20 interim guidelines, must be amended to recite solely statutory subject  
21 matter.<sup>4</sup>

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<sup>4</sup> *See also* “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,” 1300 Off. Gaz. Pat. Office 142, Annex

1 Even if as carrier wave or signal could be considered to be an article  
2 of manufacture, however, we find that such a carrier wave or signal does not  
3 operate as the claimed computer readable media. Claim 13, for example,  
4 recites a computer readable medium having instructions for causing a  
5 computer to execute a method. As a result, it is our view that the computer  
6 cannot perform the claimed functions while the instructions are within a  
7 carrier wave or a signal. In other words, the information, while on the  
8 carrier wave or signal, is unavailable to the computer for performing the  
9 functions recited in claim 13.

10 For the above reasons, we find that claims 13-24 and 47-51 recites  
11 non-statutory subject matter. The “medium” of claims 14-24 and 47-51  
12 share the same interpretations as discussed *supra* for “medium” in claim 13.  
13 For the reasons *supra*, we conclude that claims 14-24 and 47-51 are also  
14 directed to non-statutory subject matter.

15  
16 *37 C.F.R. § 41.50(b)*

17 *37 C.F.R. § 41.50(b)* provides that, “[a] new ground of rejection  
18 pursuant to this paragraph shall not be considered final for judicial review.”

19 *37 C.F.R. § 41.50(b)* also provides that the Appellants, *WITHIN TWO*  
20 *MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the

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IV(C)(2)(Nov. 22, 205) (“[A] claim that can be read so broadly as to include statutory and nonstatutory subject matter must be amended to limit the claim to a practical application.”).

1 following two options with respect to the new grounds of rejection to avoid  
2 termination of proceedings (37 C.F.R. § 1.197 (b)) as to the rejected claims:

3 (1) Reopen prosecution. Submit an appropriate amendment of the  
4 claims so rejected or new evidence relating to the claims so rejected,  
5 or both, and have the matter reconsidered by the examiner, in which  
6 event the proceeding will be remanded to the examiner ...  
7

8 (2) Request rehearing. Request that the proceeding be reheard under  
9 37 C.F.R. § 41.52 by the Board upon the same record ...  
10

#### 11 CONCLUSION

12 1. Appellants have failed to establish that the Examiner erred in  
13 rejecting claims 1-51 as being unpatentable under 35 U.S.C. § 103(a).

14 2. Thus, claims 1-51 are not patentable.

15 3. Since we have entered a new ground of rejection against claims  
16 1-8, 13-24 and 47-51, our decision is not a final agency action.  
17

#### 18 DECISION

19 In view of the foregoing discussion, we affirm the Examiner's  
20 rejection of claims 1-51.

21 We have entered a new ground of rejection against claims 1-8, 13-24  
22 and 47-51 under 37 C.F.R. § 41.50 (b).  
23  
24  
25

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1           No time period for taking any subsequent action in connection with  
2 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
3 § 1.136(a)(1)(iv)(2006).

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AFFIRMED  
37 C.F.R. § 41.50(b)

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