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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/162,701	06/06/2002	Xin Wang	111325-113	6475
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22204	7590	10/21/2005		
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EXAMINER

REAGAN, JAMES A

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 10/162,701	Applicant(s) WANG ET AL.	
Examiner James A. Reagan	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on 06 June 2002.
- 2a)  This action is FINAL.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1-27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-27 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:
- Certified copies of the priority documents have been received.
  - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)

**DETAILED ACTION**

**Status of Claims**

1. This action is in response to the application filed on 06 June 2002.
2. Claims 1-27 have been examined.

**Information Disclosure Statement**

3. The Information Disclosure Statements have been considered. Initialed copies of the Form 1449 are enclosed herewith.

**Claim Rejections - 35 USC § 101**

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 10-19 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In this case, a license is non-statutory because it is not tangibly embodied.

Since the application currently before the Examiner is a utility patent, the claims must be directed to systems, methods, or articles of manufacture that have a clear utility. See MPEP 706.03(a). Over the years, numerous court decisions have analyzed the content of various claim language for meaningful, useful differences in structure or acts performed between the claims and the prior art. Some of these decisions have found that certain language adds little, if

anything, to the claimed structure or acts and therefore do not serve as a limitation on the claims to distinguish over the prior art. Thus, the limitations on the claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *In re Gulack*, 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (bd Pat App & Int 1985) and *In re Lowry*, 32 USPQ2d 1031 (CAFC 1994), where language provided certain limitations because of specific relationships required by the claims. In the computer arts we frequently examine claims that are directed to systems, methods, and articles (computer program products) that process data. In these specific cases, nonfunctional descriptive material is material that cannot exhibit any functional interrelationship with the way in which computing processes are performed.

As a result, when analyzing claim language for its limited effect, the Examiner will perform two basic steps:

- i) Review the claimed as a whole to see whether or not any descriptive material is being recited; and
- ii) If a descriptive material is found, determine how this descriptive material is being used in the claim as a whole.

In this case, the claim language contains nonfunctional data in the form of derived rules from non-statutory subject matter. This nonfunctional data is not processed by the computer, nor does it alter the process steps. It only means something to the human mind.

**Claim Rejections - 35 USC § 102**

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ginter et al. (US 5,892,900 A).

**Claims 1, 10, and 21:**

Ginter discloses usage rights associated with digital works evolving as publishers and distributors provide the digital content to consumers. See at least column 47, line 56 to column 48, line 33; column 4, lines 14-27; column 5, lines 29-41, as well as other relevant and related Figures and text. Ginter therefore discloses the following limitations:

- *obtaining a set of rights associated with an item, said set of rights including meta-rights specifying derivable rights that can be derived from the meta-rights by the rights consumer; and*
- *determining whether the rights consumer is entitled to derive the derivable rights specified by the meta-rights, and at least one of deriving the derivable rights, and generating a license including the derived rights if the rights consumer is entitled to derive the derivable rights specified by the meta-rights.*

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