

Keywords: 35 U.S.C. §101, non-statutory subject matter,
General: The P.T.A.B. interprets claim recitations of “machine-readable storage medium” as including signals and maintains the rejection of the claims as covering non-statutory subject matter.

Ex parte Mewherter

Patent Trial and Appeal Board
May 8, 2013 (Precedential Opinion)

I. Facts

Appellants, Mewherter et al., filed a patent application assigned to International Business Machines Corp. relating to a method and system for converting a slide show presentation into a raster image that includes a link to a descriptive text (e.g. title) in a non-presentation application. In particular, the Appellants claimed a *machine-readable storage medium* that stores a computer program for converting the slide show presentation for use with a non-presentation application.

Exemplary independent claim 16 recites “a *machine-readable storage medium* having stored thereon a computer program for converting a slide show presentation for use within a non-presentation application, the computer program comprising a routine set of instructions for causing the machine to perform the steps of:

extracting a slide title for a first slide in a slide show presentation produced by a slide show presentation application executing in memory of a computer;
converting said first slide with said slide title into a raster image;
disposing both said slide title and said raster image of said slide in a markup language document; and
repeating said extracting, converting and disposing steps for a selected group of other slides in the slide show presentation.”

Among other things, in a Non-Final Office Action, the Examiner rejected claims 16-22 under Section 101 as being directed to non-statutory subject matter. Appellants subsequently appealed the Examiner’s rejection to the Patent Trial and Appeal Board (hereinafter “the Board”). The Appellants asserted that the recited “a machine-readable *storage medium*” is limited to a medium for permanently storing information and does *not include transitory media* as distinguished from a machine-readable medium, which may include a transitory medium such as a carrier wave. In addition, the Appellants quoted a dictionary definition of the term storage medium, which states that “a storage medium is well-known to mean any device in which data can be copied and held until a later time.” The Appellants also asserted that the Board had previously interpreted “machine-readable storage medium” to cover *only* statutory subject matter (*Ex parte Mehta, Ex parte Dureau, and Ex parte Bash*). Therefore, the Appellants contended that those skilled in the art, as well as the Board, would recognize that there is a difference between a transmission medium (e.g., light, electricity, etc.) and a storage medium (e.g., memory, hard disk, etc.).

In contrast, in the Office Action, the Examiner had argued that because the Appellants’ specification failed to expressly limit “a machine-readable storage medium” to exclude signals, carrier waves, etc., the recited “machine-readable storage medium” included transitory propagating signals. The Examiner applied guidance from the USPTO Subject Matter Eligibility of Computer-Readable Media, which states that “[t]he broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine-readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent.”

II. Issue

Did the Appellants show that the Examiner erred in determining that claims 16-22 include transitory media and are not directed to patent-eligible subject matter under 35 U.S.C. § 101.

III. Discussion

No. The Board agreed with the Examiner's rejection and noted that the Appellants did not dispute the Examiner's and the Office's position with regard to the broadest reasonable interpretation of "computer-readable media" as including non-statutory subject matter. Rather the Appellants argued that the inclusion of the term "storage" into the contested recitations operated to exclude transitory media. However, the Board and the Examiner did not find any limitation on the form of the "machine-readable storage medium" present in the specification (e.g., a discussion of what did or what did not constitute a "medium" in the specification). Accordingly, the Board turned to extrinsic evidence to determine the meaning of "machine-readable storage medium."

The Board relied on published applications filed between 2001 and 2003, including applications assigned to International Business Machines Corp., which used the term "machine-readable storage medium." The Board indicated that in publications assigned to International Business Machines Corp., Hewlett-Packard, Cisco, and others, the term "*machine-readable storage medium*" included "other suitable computer readable media including transmission media such as digital, analog, and wireless communication links." The Board also cited publications from Sun Microsystems, Oracle, Siemens, Plantronics, Portal Software, Neoteris, and several others that described similar storage media. In each publication the storage media *included* "a data signal embodied in a carrier wave." Therefore, the Board disagreed with the Appellants argument that a storage medium is well-known to mean "any device into which data can be copied and held until some later time." The Board also stated that data can be copied and held by a transitory medium temporarily for future recovery and, thus, the dictionary definition provided by Appellants also allowed for a transitory recording medium.

The Board also agreed with the Examiner that the Mehta, Dureau, and Bash decisions did not compel a different result. Moreover, because the decisions in Mehta, Dureau, and Bash had not been designated as precedential, the decisions were not binding to the Board. Furthermore, the Board noted that with respect to Dureau and Bash, the specification included language which excluded transitory media from the definition of storage medium.

Accordingly, given the amount of available guidance and extrinsic evidence, the Board concluded that those of ordinary skill in the art would understand the claim term "machine-readable storage medium" to include transitory subject matter (e.g., signals) and found that the Examiner did *not* err in rejecting the claims under 35 U.S.C. § 101 for claiming non-statutory subject matter.

IV. Conclusion

Disclose sufficient language in the specification that excludes transitory media from a "storage medium." Include the term "non-transitory" when claiming a machine-readable medium to exclude signals, "physical" or "tangible" is not sufficient to preclude a reading of the media being transitory.