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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DAVID PIEPENBRINK, LEONARDO VELAZQUEZ, LEE  
CHOW, SUDHA GOPAL, and HELEN LY

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Appeal 2013-000045  
Application 11/963,923  
Technology Center 3600

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Before ANTON W. FETTING, BIBHU R. MOHANTY, and  
TARA L. HUTCHINGS, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–25, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

## THE INVENTION

The Appellants' claimed invention is directed to communications networks and a unified storefront (Spec. para. 1). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A system comprising:

an asset database having a plurality of assets, each asset associated with a plurality of asset categories and with one of a plurality of access devices;

a search engine in communication with the asset database, the search engine adapted to search for a first asset included in the plurality of assets based on a metadata search inquiry received from a first access device of the plurality of access devices, and

adapted to display a search result on a graphical user interface on a display device of the first access device;

a recommendation engine, in a processor, in communication with the asset database, the recommendation engine adapted to provide a first list of assets including a second asset that is included in the plurality of assets based on the metadata search inquiry,

adapted to remove the second asset from the first list of assets to create a second list of assets, adapted to recommend a third asset based on customer usage information, adapted to recommend the third asset also based on the first access device of the plurality of access devices in communication with the recommendation engine, and adapted to display the second list of assets and the third asset on the graphical user interface, wherein the second asset has been previously purchased by a user associated with the first access device; and

an advertisement module in communication with the asset database, the advertisement module adapted to provide an asset advertisement based upon the customer usage information and one of the asset categories being searched by the search engine, and adapted to display the asset advertisement on the graphical user interface, wherein the asset advertisement is for a

fourth asset associated with a second access device that is a different type of access device than the first access device.

#### THE PRIOR ART

The Examiner relies upon the following prior art as evidence of unpatentability:

|            |                    |               |
|------------|--------------------|---------------|
| Escobar    | US 2002/0053084 A1 | May 2, 2002   |
| Haberman   | US 2006/0271594 A1 | Nov. 30, 2006 |
| Jacoby     | US 2006/0271953 A1 | Nov. 30, 2006 |
| Harper     | US 2007/0083441 A1 | Apr. 12, 2007 |
| Kumar      | US 2007/0094067 A1 | Apr. 26 2007  |
| Eichstaedt | US 2007/0100959 A1 | May 3, 2007   |

#### THE REJECTIONS

The following rejections are before us for review:

1. Claims 1–25 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.
2. Claims 1–8 are rejected under 35 U.S.C. § 103(a) as unpatentable over Harper, Kumar, Jacoby, and Haberman.
3. Claims 23–25 are rejected under 35 U.S.C. § 103(a) as unpatentable over Harper, Kumar, Jacoby, and Escobar.
4. Claims 23–25 are rejected under 35 U.S.C. § 103(a) as unpatentable over Harper, Kumar, Jacoby, and Eichstaedt.
5. Claims 9–22 are rejected under 35 U.S.C. § 103(a) as unpatentable over Jacoby, Harper, and Kumar.

## FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence<sup>1</sup>.

## ANALYSIS

### *Rejection under 35 U.S.C. § 101*

The Examiner has rejected claims 1–12 under 35 U.S.C. § 101 as being directed to software *per se* (Ans. 5). In contrast, the Appellants have argued that this rejection is improper (Appeal Br. 10, Reply Br. 2).

We agree with the Examiner. Here, the elements of claim 1 for example, are drawn to an “asset database,” “search engine,” “recommendation engine,” and “advertisement module.” Here, the cited database, engines, and modules in the claim can be drawn to software *per se*. The rejection of claim 1–12 is sustained.

With regards to the rejection of claims 13–25, the rejection of record in the Examiner’s Answer was mailed July 18, 2012 and applied essentially only the machine or transformation test to these claims (Ans. 5). However, the Supreme Court had already modified the analysis of non-statutory subject matter and the use of the machine-or-transformation test on June 28, 2010. The Supreme Court made clear in *Bilski v. Kappos*, 130 S. Ct. 3218 (2010) that a patent claim's failure to satisfy the machine-or transformation test is not dispositive of the § 101 inquiry. The Answer in the remarks section for the first time does mention the claim being directed to an abstract idea, but here there has been insufficient analysis of the claim language to

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<sup>1</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

establish a prima facie case. As the rejection of record has not applied a complete analysis to establish a prima facie case of claims 13–25 under 35 U.S.C. § 101, the rejection of these claims is not sustained.

*Rejections under 35 U.S.C. § 103(a)*

The Appellants first argue that the rejection of claim 1 is improper because the cited art fails to disclose the claim limitation to “remove the second asset from the first list of assets to create a second list of assets” and “wherein the second asset has been previously purchased by a user associated with the first access device” (Appeal Br. 11–12). The Appellants argue that Harper fails to disclose this claim limitation at paragraph 91 and Figure 19 (Appeal Br. 11–12).

In contrast, the Examiner has determined that the rejection is proper and that the cited claim limitation is shown by Harper at paragraph 91 and Kumar at paragraph 426 (Ans. 7, 8, 22, 23).

We agree with the Examiner. Harper at paragraph 91 discloses after a product is scanned, a recommendation list is generated based on top-selling products in the genre which would serve as a “first list of assets.” Kumar at paragraph 426 discloses removing past purchased products from a recommendation list which would serve to form a “second list of assets” by removing the previously purchased asset from the first list. Here, the combination of the cited references discloses the argued claim limitation.

The Appellants secondly argue that with regard to claim 1, the modification of Harper by Kumar would be unsatisfactory for its intended purpose (Appeal Br. 13, Reply Br. 3). We find this argument unpersuasive. Initially, we note that while the Appellants have argued with regard to the

Harper and Kumar references, the rejection of record also includes both the references of Jacoby and Haberman as well. Regardless, to the extent argued here, the modification of the prior art to remove from the first list of assets, previously purchased products would have been an obvious, predictable combination in the rejection of record to avoid offering products already purchased.

For these reasons, the rejection of claim 1 is sustained. The Appellants have provided the same arguments for claims 2–25, and the rejections of these claims are sustained for the same reasons given above.

#### CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1–12 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 13–25 under 35 U.S.C. § 101 as directed to non-statutory subject matter.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1–25 under 35 U.S.C. § 103(a) as listed in the Rejections section above.

#### DECISION

The Examiner's rejections of claims 1–25 are sustained.

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

AFFIRMED

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