UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/144,538	06/23/2008	Robert F. Deeming	10587.0740-00000	1764

100692 7590 08/18/2015

AOL Inc./Finnegan
901 New York Ave., NW
Washington, DC 20001

EXAMINER
BERONA, KIMBERLY SUE

ART UNIT	PAPER NUMBER
3696	

MAIL DATE	DELIVERY MODE
08/18/2015	PAPER

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT F. DEEMING and STEVEN B. JOHNSON

Appeal 2013-001524[1]
Application 12/144,538[2]
Technology Center 3600

Before NINA L. MEDLOCK, PHILIP J. HOFFMANN, and TARA L. HUTCHINGS, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–30. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

---

[1] Our decision references Appellants' Appeal Brief ("App. Br.," filed June 25, 2012) and Reply Brief ("Reply Br.," filed October 31, 2012), and the Examiner's Answer ("Ans.," mailed August 27, 2012) and Non-Final Office Action ("Final Act.," mailed October 14, 2011).

[2] Appellants identify AOL Inc. as the real party in interest. App. Br. 3.

CLAIMED INVENTION

Appellants' claimed invention "generally relates to the field of advertisements, and more particularly to location-specific web advertisements" (Spec. ¶ 1).

Claim 1, reproduced below, is illustrative of the subject matter on appeal:

> 1. A computer-implemented method of generating a geocoded targeted web advertisement for a user viewing web pages, the method comprising:
>
> determining, using a processor, a geographic location from content of a web page;
>
> searching for geographic information associated with the geographic location;
>
> determining coordinates associated with a centroid of the geographic location from the geographic information;
>
> identifying geographic specific advertisements associated with determined coordinates of the centroid; and
>
> generating, using a processor, a geocoded targeted web advertisement for display to the user based at least in part on the geographic specific advertisements.

REJECTIONS

I. Claims 1–20 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

II. Claims 1–5, 9–15, 19–25, 29, and 30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Silverbrook (US 2008/10091527 A1, pub. Apr. 17, 2008) and Olligschlaeger (US 2008/0201143 A1, pub. Aug. 21, 2008).

III. Claims 1, 11, and 21 are alternatively rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes (US 2008/0227467 A1, pub. Sept. 18, 2008) and Nordmark (US 2007/0271146 A1, pub. Nov. 22, 2007).[3]

IV. Claims 2–5, 9, 10, 12–15, 19, 20, 22–25, 29, and 30 are alternatively rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes, Nordmark, and Silverbrook.

V. Claim 6, 16, and 26 are rejected under 35 U.S.C. § 103(a) as unpatentable over Silverbrook, Olligschlaeger, and Choi (US 2007/0208616 A1, pub. Sept. 6, 2007), or alternatively rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes, Nordmark, and Choi.

VI. Claims 7, 17 and 27 are rejected under 35 U.S.C. § 103(a) as unpatentable over Silverbrook, Olligschlaeger, and Monberg (US 6,523,021 B1, iss. Feb. 18, 2003), or alternatively rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes, Nordmark, and Monberg.

VII. Claims 8, 18, and 28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Silverbrook, Olligschlaeger, and Inokuchi (US 2004/0080510 A1, pub. Apr. 29, 2004), or alternatively rejected under 35 U.S.C. § 103(a) as being unpatentable over Barnes, Nordmark, and Inokuchi.

[3] From our review of the Final Office Action, it appears to us that the Examiner mistakenly references dependent claim 22, rather than independent claim 21, as the subject of this rejection, and that claim 22, not claim 21, should have been identified among the claims rejected under 35 U.S.C. § 103(a) as unpatentable over Barnes, Nordmark, and Silverbrook.

ANALYSIS

Rejection I

Claims 1–10

The Examiner finds that claims 1–10 are directed to an abstract idea, and states that the rationale for this finding is that "[c]laim 1 does not recite a particular machine or a transformation in an active step involving the machine or transformation" (Final Act. 11). The Examiner indicates that a "similar analysis is applicable to dependent claims 2–10" (*id.*).

Before the mailing date of the Examiner's Answer, the Supreme Court held in *Bilski v. Kappos*, 561 U.S. 593 (2010) that a patent claim's failure to satisfy the machine-or-transformation test is not dispositive of the § 101 inquiry. *Id.* at 604. Because the Examiner relies only on the machine-or-transformation test, the Examiner has failed to establish a prima facie case of patent-ineligibility.

Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 101 of claims 1–10.

Claims 11–20

Independent claim 11 recites "[a] computer readable storage medium storing a computer program product configured to store instructions for generating a geocoded targeted web advertisement for a user viewing web pages." Claims 12–20 depend, directly or indirectly, from independent claim 11.

The Examiner rejected claims 11–20 under 35 U.S.C. § 101 on the ground that the claims broadly cover transient propagating signals, which are not patentable subject matter (Final Act. 12–14). Appellants maintain that the rejection is improper and should be reversed because claim 11 satisfies

the machine or transformation test (App. Br. 9–10). We agree with the Examiner.

In our view, when given its broadest reasonable interpretation in light of the Specification, the phrase "computer readable storage medium" includes transitory signals, which are non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter); *see also Ex parte Mewherter*, 107 USPQ2d 1857, 1862 (PTAB 2013) (precedential) (finding a machine readable storage medium non-statutory under § 101). Therefore, we sustain the Examiner's rejection of claims 11–20 under 35 U.S.C. § 101.

Rejection II

We are persuaded by Appellants' argument that the Examiner erred in rejecting independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) because neither Silverbrook nor Olligschlaeger discloses or suggests "determining, using a processor, a geographic location from content of a web page," as recited in claim 1, and similarly recited in claims 11 and 21 (App. Br. 10–12; *see also* Reply Br. 5–7).

The Examiner relies on Silverbrook as disclosing the argued limitation and, in the Final Office Action, identifies paragraphs 6, 7, 11, 12, 23–30, 36–39, 107, 167–169, 185–191, 199–202, 207, 210–214, 247, and 978 of Silverbrook as support (*see* Final Act. 3–6). The Examiner additionally cites paragraphs 313–343, 364–370, 384, 385, 401, 423, 424, 434, 439, 453–455, 781–788, 790, 856–905, 925, 929, 930, 946, 951–953, 975–981,986, 989, and Figures 36 and 37 of Silverbrook in the Response to Argument section of the Answer (Ans. 28–36). We have carefully reviewed the cited portions of Silverbrook, and we agree with Appellants that none of these paragraphs discloses or suggests "determining, using a processor, a

geographic location from content of a web page," as recited in claim 1, and similarly recited in claims 11 and 21.

Silverbrook is directed to a method for enabling a user to access information from a computer system via a printed substrate, e.g., paper (Silverbrook ¶ 6). Coded data are printed onto the substrate, and are read by an optical sensing device when the user interacts with the substrate using the sensing device (*id.*). "For example, a user may select a printed hyperlink using the sensing device and retrieve a corresponding webpage via a display device or printer" (*id.*). In the preferred embodiment, the Silverbrook invention is configured to work with a netpage networked computer system (*id.* ¶ 569). Silverbrook, thus, discloses a netpage consisting of a printed page invisibly tagged with references to an online description of the page, and describes that the netpage allows markings made with a netpage pen on its surface to be simultaneously captured and processed by the netpage system (*id.* ¶¶ 591, 595). Silverbrook describes that selected text may be inserted into a web keyword search engine (e.g., Google) to provide feedback to a user and that searching based on selected text can be enhanced with contextual information (*id.* ¶ 802). Thus, in addition to the selected text, the search query may be "augmented with information from the environmental context [e.g., geographical location, time of day, day of week, date, weather, etc.] and user context" (*id.* ¶ 978).

The Examiner takes the position that Silverbrook, thus, discloses determining a "geographic location" (Final Act. 3, 4, 6). But the geographic location in Silverbrook is information from an "environmental context;" the geographic location is not determined from "content of a web page," as called for in independent claims 1, 11, and 21.

The Examiner's reliance on paragraphs 781–788 and Figures 36 and 37 in the Response to Argument section of the Answer also is misplaced. The Examiner asserts that "Silverbrook shows an actual example using a geographic location (Fig. 36) wherein the sensor device homes [sic] in on 'in Spain' on a printed page . . . and the words 'in Spain' are picked up, and can be copied into an active GUI application on the computer" (Ans. 28–29). However, as Appellants point out, Silverbrook discloses that text, e.g., "in Spain," is selected from a printed page using Silverbrook's sensor device for one of two reasons, i.e., (1) to make the selected text available to another application via a selection hyperlink (*see, e.g.*, Silverbrook ¶¶ 671, 673, 785) or (2) to copy the selected text to a clipboard so that the user can paste the text into other active applications (*see id.* ¶ 786) (Reply Br. 6–7). We find nothing in paragraphs 781–788 and Figures 36 and 37, or in any of the other portions of Silverbrook, identified by the Examiner, that discloses or suggests "determining, using a processor, a geographic location from content of a web page," as recited in claim 1, and similarly recited in claims 11 and 21.

Therefore, we do not sustain the Examiner's rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as unpatentable over Silverbrook and Olligschlaeger. For the same reasons, we also do not sustain the Examiner's rejection of claims 2–5, 9, 10, 12–15, 19, 20, 22–25, 29, and 30, each of which depends from one of independent claims 1, 11, and 21. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("dependent claims are nonobvious if the independent claims from which they depend are nonobvious").

Rejection III

We are persuaded by Appellants' argument that the Examiner erred in rejecting independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) because neither Barnes nor Nordmark discloses or suggests "determining, using a processor, a geographic location from content of a web page," as recited in claim 1, and similarly recited in claims 11 and 21 (App. Br. 14–16; *see also* Reply Br. 9–10).

The Examiner cites Barnes as disclosing the argued feature (Final Act. 17–18 (citing Barnes ¶¶ 21, 23, 35, 38, 39, 52, 57, 58, and 60)). However, having reviewed the cited portions of Barnes, we agree with Appellants that none of the cited paragraphs discloses or suggests "determining, using a processor, a geographic location from content of a web page," as recited in claim 1, and similarly recited in claims 11 and 21.

Barnes is directed to systems and methods for mobile device advertising (Barnes Abstract), and discloses a system including a mobile device, a content provider, and an advertisement provider (*id.* ¶ 8). The mobile device includes an application, e.g., a web browser, for requesting content from the content provider, which enables advertisement providers to supplement the requested content with advertisements (*id.* ¶ 4). Barnes discloses that, as part of a request for content, the mobile device sends at least one location fix to the content provider, which forwards the location fix to the advertisement provider (*id.* ¶ 21). Based on the location fix, the advertisement provider selects an advertisement designed for a specific location and transmits the advertisement to the mobile device (*id.*). Thus, rather than determining a geographic from content of a web page, as called for in claims 1, 11, and 21, the mobile device sends its own location information with its request for content.

In view of the foregoing, we do not sustain the Examiner's rejection of independent claims 1, 11, and 21 under 35 U.S.C. § 103(a) as unpatentable over Barnes and Nordmark.

Rejections IV–VII

The remaining rejections based on Choi, Monberg, and Inokuchi, in combination with one or more of Silverbrook, Olligschlaeger, Barnes, and Nordmark, do not cure the deficiency in the Examiner's rejections of independent claims 1, 11, and 21. Therefore, we do not sustain the rejections under 35 U.S.C. § 103(a) of claims 2–10, 12–20, and 22–30, each of which depends, directly or indirectly, from independent claims 1, 11, and 21, respectively.

DECISION

The Examiner's rejection of claims 1–10 under 35 U.S.C. § 101 is reversed.

The Examiner's rejection of claims 11–20 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejections of claims 1–30 under 35 U.S.C. § 103(a) are reversed.

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

AFFIRMED-IN-PART

Klh