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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GREGORY J. NAWROCKI and DAVID J. NUGENT

Appeal 2014-002037
Application 12/495,014
Technology Center 3600

Before: MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and
MICHAEL W. KIM, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE¹

Appellants seek our review under 35 U.S.C. § 134 from the
Examiner's final rejection of claims 1–19. We affirm.

¹ Appellants identify American Spirit Data Solutions, LLC as the real party
in interest. (Appeal Br. 3).

THE CLAIMED INVENTION

Appellants claimed invention “relates generally to presentations that are shared by a plurality of end users and more particularly to modifications of such presentations.” (Spec., para. 2).

Claim 1 is illustrative of the claimed subject matter:

1. A method comprising:

by a control circuit:

receiving a data message in conjunction with a corresponding source identifier from each of a plurality of sources, wherein the plurality of sources each have, at the time of sourcing their respective data message, a corresponding attending end user who aggregately comprise end users, wherein the end users are all presently sharing a common presentation;

using the source identifier to determine additional identifying information for at least a substantial number of the end users;

using the additional identifying information to determine characterizing information for at least a substantial number of the end users;

at the control circuit or elsewhere:

using the characterizing information to modify the common presentation.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Diederiks	US 2007/0136122 A1	June 14, 2007
Li	US 2007/0169143 A1	July 19, 2007
Arnold	US 2008/0120182 A1	May 22, 2008

REJECTIONS

The following rejections are before us for review.

The Examiner rejected claims 1–12 under 35 U.S.C. § 101 as reciting ineligible subject matter.

The Examiner rejected claims 1–11 and 13–19 under 35 U.S.C. § 103(a) as unpatentable over Diederiks and Arnold.

The Examiner rejected claim 12 under 35 U.S.C. § 103(a) as unpatentable over Diederiks, Arnold, and Li.

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence.

1. The Specification does not lexicographically define the term *control circuit*, but describes, by example, that it may be a “digital computer.” (Spec., para. 36).
2. The Specification does not lexicographically define the term *substantial*, but describes it by example, stating:

a substantial number of end users shall be understood to refer to at least thirty percent of the responding end users. Other thresholds can of course apply depending upon the needs and/or opportunities as tend to characterize a given application setting. For example, in some settings, as few as ten percent may be sufficient while in other cases it may be required that a great percentage (such as seventy-five, eighty, or ninety percent) be achieved.

(Spec., para. 27).
3. The ordinary and customary definition of the term *substantial* is “considerable in importance, value, degree, amount, or extent.” (The Free Dictionary by Farlex, last retrieved from <http://www.thefreedictionary.com/substantial> on June 17, 2016).

4. Arnold discloses a billboard system that adapts the displayed message to information received from a consumer's mobile device, such as a preferred language or currency. (Arnold, para. 21).
5. Arnold discloses the information may be displayed to a consumer "via a display device, such as a television, a computer monitor, a printer, speakers, a display on the contactless device, or through other means."
(*Id.*).
6. Arnold provides an example of its billboard system in a restaurant, stating:

If the consumer is proximate to a smart billboard system that typically displays a menu in Chinese, a contactless reader associated with the smart billboard system may detect the preference-based information on the consumer's contactless device and translate the menu into English. If a preferred currency for the consumer is also stored on the contactless device, the smart billboard system may calculate the prices for the menu items in the preferred currency based on, for example, real-time exchange rates.

(Arnold, para. 22).

ANALYSIS

Rejection of claims 1–12 under 35 U.S.C. § 101²

Appellants argue limitations, directed to using information to determine other information, are not insignificant extra-solution activity in

² Should there be further prosecution of this application (including any review for allowance), the Examiner may wish to review claims 13–19 for compliance under 35 U.S.C. § 101 in light of the recently issued preliminary examination instructions on patent eligible subject matter. See "Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank*

the context of an analysis of patentable subject matter under Section 101. (Appeal Br. 10; *see also* Reply Br. 2–3). The Examiner found insignificant extra-solution activity is among the factors considered in determining the whether the claims are focused on an abstraction. (Final Act. 4.). We find no error with the Examiner’s reasoning here.

The Supreme Court:

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, [] determine whether the claims at issue are directed to one of those patent-ineligible concepts. [] If so, we then ask, “[w]hat else is there in the claims before us? [] To answer that question, [] consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. [The Court] described step two of this analysis as a search for an “‘inventive concept’”—i.e., an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”

Alice Corp. Pty. Ltd. v CLS Bank Intl., 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012)). To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

As in *Alice Corp. Pty. Ltd.*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of risk hedging in *Bilski* and the concept of using information to determine, or find, and modify, other information, as at issue

International, et al.,” Memorandum to the Examining Corps, June 25, 2014.

here. The abstraction here focuses on receiving data, using that data to find other data, and using the other data to modify the received data. Both are squarely within the realm of “abstract ideas” as the Court has used that term. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2357.

The remaining claims limit the types of information, or uses of information, or add additional information types to the method, such as an incentives. We conclude that the claims at issue are directed to a patent-ineligible concept, because they are merely an abstract idea, capable of being performed through human thought and insignificant data input and output operations.

The introduction of a “control circuit” into the claims does not alter the analysis at *Mayo* step two. The “control circuit” is not defined, but is described as encompassing a “digital computer.” (FF 1).

the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea “while adding the words ‘apply it’” is not enough for patent eligibility. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implement[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our §101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

Alice Corp. Pty. Ltd., 134 S. Ct. at 2358 (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea [] on a generic computer.” *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2359. They do not.

Viewed as a whole, Appellants’ method claims simply recite the abstract concept of managing information. Even were the steps implied as being performed on a computer, the method claims do not, for example, purport to improve the functioning of a computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims at issue amount to nothing significantly more than an instruction to apply the abstract idea of managing information to a specific type of information in the form of a “presentation.” Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360.

Rejection of claims 1–11 and 13–19 under 35 U.S.C. § 103(a)

Initially, we note that the Appellants argue independent claims 1, 13, and 17 together as a group. (Appeal Br. 5). Correspondingly, we select representative claim 1 to decide the appeal of these claims, with remaining claims 13 and 17 standing or falling with claim 1. Appellants do not provide a substantive argument as to the separate patentability of 2–11, 14–16, 18, and 19 that depend from claims 1, 13, and 17. Thus claims 2–11 and 13–19 stand or fall with claim 1. *See*, 37 C.F.R. § 41.37(c)(1)(vii).

Appellants argue “[w]hile Arnold teaches modifying displayed content as a function of a single individual, Arnold does not teach modifying displayed content as a function of ‘a substantial number’ of such persons.” (Appeal Br. 11–13; *see also* Reply Br. 3–4).

We are not persuaded by Appellants' argument. In Appellants' Specification, there is no explicit definition of the term "substantial"; only examples of percentages of users considered to be "substantial." (FF 2). Thus, there is no guidance provided for a given situation as to what level is required to be considered "substantial," as claimed. Instead, we rely on the ordinary and customary meaning of "substantial" to be "considerable in importance, value, degree, amount, or extent." (FF 3). We, thus, construe "substantial number of users" to be a number of users which is a "considerable" number in importance.

Arnold discloses a system that modifies displayed content on a billboard system (FF 4, 5), where a user is proximate, and has personal preference information on the device showing a different language preference than the language currently displayed, the billboard will change the display to use the user's language preference instead. (FF 6). In this particular situation, we find that even a single user with a different language preference within proximity of the billboard system will affect a change in the display. (FF. 6). As such, we find that the single user is "considerable in importance" because he/she causes the altered display. Arnold's example, thus, meets the claim language.

Appellants also argue Arnold teaches away. (Appeal Br. 12). We are not persuaded, because Arnold specifically meets the claim language, as we have shown above.

In addition, a "reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Kahn*, 441

F.3d 977, 990 (Fed. Cir. 2006) (citations and internal quotation marks omitted). *See also In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (noting that merely disclosing more than one alternative does not teach away from any of these alternatives if the disclosure does not criticize, discredit, or otherwise discourage the alternatives). Arnold does not discourage one from having a number that is “considerable in importance,” as the English-language consumer (FF 6), and, thus, does not teach away.

Rejection of claim 12 under 35 U.S.C. § 103(a)

Appellants do not argue claim 12 separately, so we affirm its rejection on the same basis as that of claim 1, above.

CONCLUSIONS OF LAW

The Examiner did not err in rejecting claims 1–12 under 35 U.S.C. § 101.

The Examiner did not err in rejecting claims 1–19 under 35 U.S.C. § 103(a).

DECISION

For the above reasons, the Examiner’s rejections of claims 1–19 are affirmed.

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