



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

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
11/967,343 12/31/2007 Frank Sandoval CTL60152PUS / 60152 6793

110936 7590 07/14/2016
Great Lakes Intellectual Property, PLLC /CableLabs
44750 Yorkshire
Novi, MI 48375

EXAMINER

CIVAN, ETHAN D

ART UNIT PAPER NUMBER

3684

NOTIFICATION DATE DELIVERY MODE

07/14/2016

ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

j.buser@greatlakesiplaw.com
d.smith@cablelabs.com
USPTO@dockettrak.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* FRANK SANDOVAL, DAVID HOOLEY, DAVID HUNTER,  
ALLEN GORDON, and CLARKE STEVENS

---

Appeal 2014–003843  
Application 11/967,343  
Technology Center 3600

---

Before ANTON W. FETTING, BIBHU R. MOHANTY, and  
NINA L. MEDLOCK, *Administrative Patent Judges*.

FETTING, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE<sup>1</sup>

Frank Sandoval, David Hooley, David Hunter, Allen Gordon, and Clarke Stevens (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1, 3, 7, 11, 12, 14, 21–33, and 35–39, the only claims pending in the application on appeal. Oral arguments were presented May 5, 2016. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

---

<sup>1</sup> Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed September 23, 2013) and Reply Brief (“Reply Br.,” filed February 17, 2014), and the Examiner’s Answer (“Ans.,” mailed December 17, 2013), and Final Action (“Final Act.,” mailed March 22, 2013).

The Appellants invented ways of selling products over interactive platforms, such as but not limited to interactive platforms operating according to disparate network implementations. Spec. 5–7.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below (bracketed matter and some paragraphing added).

1. A method of

allowing vendors to sell products over television networks  
where each network relies upon disparate interactive  
platforms to facilitate subscriber purchase of the products,

the method comprising:

[1] associating

a unique vendor ID with each vendor

and

a unique product ID with each product;

[2] receiving an advertisement from at least one of the vendors,

the advertisement including offers for purchasing one or  
more products being sold by the at least one of the  
vendors;

[3] packaging the advertisement into a first advertisement and a  
second advertisement,

the first advertisement packaged for inclusion within a  
first network associated with a first one of the at least two  
of the disparate interactive platforms

and

the second advertisement packaged for inclusion within a  
second network associated with a second one of the at  
least two of the interactive platforms,

the first advertisement being inoperable with the second  
one of the interactive platforms

such that the first advertisement cannot be shown using the second one of the interactive platforms, the second advertisement being inoperable with the first one of the interactive platforms

such that the second advertisement cannot be shown using the first one of the interactive platforms,

the packaging of the first and second advertisements allowing subscribers to navigate and purchase the one or more products,

the packaging of the first and second advertisements each including the vendor ID separately from the product ID for each product;

and

[4] upon receipt of a purchase confirmation message confirming subscriber purchase of one of the products,

the purchase confirmation message including the product ID separately from the vendor ID associated with the purchased product,

issuing a purchase order for the product and vendor identified by the product ID and vendor ID included in the purchase confirmation message.

Claims 1, 3, 7, 11, 12, 14, 21–33, and 35–39 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure.

Claims 1 and 3 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

Claims 1, 3, 7, 11, 12, 14, 21–33, and 35–39 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

## ISSUES

### FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

#### *Facts Related to Claim Construction*

01. The disclosure contains no lexicographic definition of “disparate.”
02. The ordinary meaning of “disparate” is fundamentally distinct or different in kind, or entirely dissimilar.<sup>2</sup>

#### *Facts Related to Appellants’ Disclosure*

03. The Specification does not describe something being inoperable.
04. The Specification describes disparate systems.

## ANALYSIS

*Claims 1, 3, 7, 11, 12, 14, 21–33, and 35–39 rejected under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure*

As to claim 1, reciting each of two advertisements being inoperable on one of the interactive platforms, the Examiner finds the Specification does not describe such inoperability. Ans. 3. We are not persuaded by Appellants’ argument that the Specification describes disparate systems.

---

<sup>2</sup> The American Heritage Dictionary of the English Language, Fifth Edition, 2015, <https://www.ahdictionary.com/word/search.html?q=disparate>

Disparate means “entirely dissimilar,” but mere dissimilarity, even in extremity, does not imply inoperability. The ability of audio and display applications to accommodate disparate file types is too widely known to accept such a proposition.

Claim 26, reciting “unable to operate,” is similarly unsupported.

As to claim 7, reciting inserting vendor and product IDs into ads that are then executed using disparate messaging schemes, we are persuaded by Appellants’ argument that the Examiner fails to present a prima facie case of unpatentability. App. Br. 11–13. The Examiner makes only the conclusory finding that “[t]he specification provides no support for these limitations.” Final Act. 4.

Claim 12 depends from claim 7 and this is the sole reason for its rejection here.

As to claims 21 and 22, each reciting “configuring the first and second advertisement applications to advertise the products for purchase within one of a pop-up advertisement and a banner advertisement,” and similar claims 28 and 33, we are not persuaded by Appellants’ argument that “[s]upport for these claim limitations is found in paragraph 18 of the originally filed application.” App. Br. 14. Specification paragraph 18 recites “[t]he iTV platform can display an advertisement, such as through a television commercial, pop-up/banner ad, or other user accessible interface, and provide a means by which the customer may order the product, such as by clicking on an icon or selecting a button on a remote control.” This is the sole description of the content of the limitation added by these claims. This description only describes generic use of a pop-up or banner ad. It does not describe using such ads in the context of their parent claims. Although this

description may make such a combination obvious, that is insufficient for written description. *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571–72 (Fed. Cir. 1997).

As to claims 23 and 29, each reciting “wherein the overlay and the displayed media does not display either one of the vendor ID and the product ID,” we are not persuaded by Appellants’ argument that “[s]upport for these claim limitations is found in paragraph 26 of the originally filed application.” App. Br. 14. Specification paragraph 26 recites “[o]nce registered, a vendor can be issued a unique ID and is given template code to add to their application. Vendors can supply pricing information for individual items. Each item can also be assigned an ID which is incorporated into the application template.” This does not describe the content of the limitation added by these claims. Appellants contend that “[o]ne having ordinary skill in the art would readily recognize that incorporating such IDs within the application would result in the application displaying the corresponding advertisement without displaying the incorporated vendor ID and product ID.” *Id.* at 15. Appellants provide no evidence or even reasoning for this assertion.

As to claims 31 and 32, each reciting “wherein the first and second advertisement applications are configured to include the vendor ID separately from the product ID within the purchase request” without entering those IDs, we are not persuaded by Appellants’ argument that “[s]upport for these claim limitations is found in paragraphs 18-19 and 21-22 of the originally filed application.” App. Br. 18. These paragraphs recite “[t]he iTV platform can display an advertisement, such as through a television commercial, pop-up/banner ad, or other user accessible interface, and

provide a means by which the customer may order the product, such as by clicking on an icon or selecting a button on a remote control” and “[a] transaction request may be generated in response to the customer purchase request.” This is the sole description of the content of the limitation added by these claims. This description only describes generic use of a button to execute something and incorporation of vendor and product IDs in a purchase transaction. It does not describe the absence of entering the IDs. Again, although this description may make such a combination obvious, that is insufficient for written description.

As to claims 36 and 37, each reciting that “devices are configured to descramble television signaling carried over” two networks, we are not persuaded by Appellants’ argument that support for these claim limitations is found in paragraphs 9 and 11 of the originally filed application. App. Br. 19. These paragraphs recite using cable, satellite, or broadcast television service providers. This description only describes generic use of such providers. It does not describe descrambling signals. Again, although this description may make such a combination obvious, that is insufficient for written description.

*Claims 1 and 3 rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention*

We are persuaded by Appellants’ argument that the limitation regarding packaging would be understood by one of ordinary skill (App. Br. 20–21).

*Claims 1, 3, 7, 11, 12, 14, 21–33, and 35–39 rejected under 35 U.S.C. § 101  
as directed to non–statutory subject matter*

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)  
(citations omitted) (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.

We find that this case’s claims themselves and the Specification provide enough information to inform one as to what they are directed to.

The preamble to claim 1 recites that it is a method of allowing vendors to sell products. The four steps in claim 1 result in issuing a purchase order. The preamble to claim 7 recites that it is a method of selling products. The four steps in claim 7 result in generating a purchase request. The preamble to claim 24 recites that it is a system configured to facilitate advertising products. The five components in claim 24 are configured to

generate advertisements. The Specification at 1 recites that the invention relates selling products. Thus, all this evidence shows that the independent claims are directed to selling products.

It follows from prior Supreme Court cases, and *Bilski* in particular, that the claims at issue here are directed to an abstract idea. Like the risk hedging in *Bilski*, the concept of selling products is a fundamental economic practice long prevalent in our system of commerce. The use of sales and advertising is also a building block of the modern economy. Thus, sales, like hedging, is an “abstract idea” beyond the scope of §101. *See Alice Corp.*, 134 S. Ct. at 2356.

As in *Alice Corp.*, 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 selling at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. *See id.* at 2357.

The remaining claims merely describe examples of advertisement packaging aids and content. We conclude that the claims at issue are directed to a patent-ineligible concept.

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two.

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.”

*Id.* 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.” *Id.* at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to associate labels such as IDs with products, receive and package ads, and issue purchase orders(claim 1); and further to identify text in a purchase order(claim 7); and assign IDs and generate ads amounts to electronic data generation, query and retrieval—among the most basic functions of a computer.

The limitations of interactivity, networks, operability, and navigation are not steps, but a recitation of the context within which ads are generated and packaged to elicit purchase orders. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. In short, each step does no more than require a generic computer to perform generic computer functions.

Claims 1, 7, and 26 do no more than identify vendors and products, obtain an ad, package the ad in two separate media forms, and issue a

purchase order. Aside from the packaging, such identification, ad buys, and purchase orders are notoriously old. Packaging ads in separate mutually inoperable formats is as old as the idea of marketing promotion channels, such as radio and newsprint. Reciting mutually inoperable electronic formats as in these claims is simply the electronic version of such notoriously old incompatible marketing channels. At bottom, all claims do no more than advise one to copy an ad into plural formats, each format compatible with the marketing channel employed. Advice is a recognized instance of an abstract concept.

Considered as an ordered combination, the computer components of Appellants' method add nothing that is not already present when the steps are considered separately. Viewed as a whole, Appellants' claims simply recite the concept of advertising for sales as performed by a generic computer. The method claims do not, for example, purport to improve the functioning of the 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 advertising using some unspecified, generic computer. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp.*, 134 S. Ct. at 2360.

#### CONCLUSIONS OF LAW

The rejection of claims 1, 3, 11, 14, 21–33, and 35–39 under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure is proper.

Appeal 2014-003843  
Application 11/967,343

The rejection of claims 7 and 12 under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure is improper.

The rejection of claims 1 and 3 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is improper.

The rejection of claims 1, 3, 7, 11, 12, 14, 21–33, and 35–39 under 35 U.S.C. § 101 as directed to non–statutory subject matter is proper.

#### DECISION

The rejection of claims 1, 3, 7, 11, 12, 14, 21–33, and 35–39 is 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). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2011).

AFFIRMED