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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/554,661	07/20/2012	Nicholas W. Nyhan	275840	2644
23460	7590	10/31/2016	EXAMINER	
LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6731			BOVEJA, NAMRATA	
			ART UNIT	PAPER NUMBER
			3682	
			NOTIFICATION DATE	DELIVERY MODE
			10/31/2016	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* NICHOLAS W. NYHAN and RONIT AVIV

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Appeal 2014-007766  
Application 13/554,661  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, BIBHU R. MOHANTY, and  
NINA L. MEDLOCK, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 21–34. We have jurisdiction over the appeal under 35 U.S.C. § 6(b). Appellants appeared for oral hearing on October 6, 2016.

We REVERSE.

Claim 21 is illustrative:

21. A method for measuring, through on-line surveys, effectiveness of advertisements displayed upon a computer for viewing by a user, the method comprising the steps of:

receiving, by a user computer, an on-line advertisement, issued by an advertising server, including a code embedded within executable instructions;

executing, by the user computer, the on-line advertisement including the code;

generating, by a server separate and distinct from the advertising server, an indicator identifying an instance of the on-line advertisement being executed on the user computer;

storing the indicator within a repository, the indicator providing information associated with the on-line advertisement executed on the user computer;

administering, by an on-line survey provider, a survey relating to the on-line advertisement; and

evaluating responses to the survey in accordance with the indicator within the repository of previous user exposure to the on-line advertisement indicated by contents of the repository, the indicator being used during the evaluating to distinguish exposed group member responses to the survey from control group member responses.

Appellants appeal the following rejections:

1. Claims 28–34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.
2. Claims 28–34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.
3. Claims 21–34 under 35 U.S.C. § 103(a) as unpatentable over Goldhaber (US 5,794,210, iss. Aug. 11, 1998) and Official Notice.

#### ISSUE

Did the Examiner err in rejecting the claims under 35 U.S.C. § 112, first paragraph, because the Examiner failed to establish that a person of

ordinary skill in the art could not make or use the invention without undue experimentation?

Did the Examiner err in rejecting the claims under 35 U.S.C. § 112, second paragraph, because it is clear how a computer readable medium can be executed by three different entities?

Did the Examiner err in rejecting the claims because the Examiner did not establish a reason to modify the method of Goldhaber so that it includes evaluating responses to a survey in accordance with an indicator that distinguishes exposed group member responses to the survey from control group member responses?

## ANALYSIS

### Enablement

When rejecting a claim for lack of enablement, “the [United States Patent and Trademark Office] bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application.” *In re Wright*, 999 F.2d 1557, 1561–62 (Fed. Cir. 1993) (citing *In re Marzocchi*, 439 F.2d 220, 223–24 (CCPA 1971)).

The test for compliance with the enablement requirement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Some experimentation, even a considerable amount, is not “undue” if, e.g., it is merely routine, or if the specification provides a reasonable amount of

guidance as to the direction in which the experimentation should proceed. *Id.* (citing *Ex parte Jackson*, 217 USPQ 804, 807 (BPAI 1982)). The “undue experimentation” analysis involves the consideration of several factors, including: (1) the quantity of experimentation; (2) the amount of direction or guidance presented; (3) the presence or absence of working examples; (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill of those in the art; (7) the predictability or unpredictability of the art; and (8) the breadth of the claims. *Wands*, 858 F.2d at 737.

The Examiner argues that there is no support for a computer-readable medium and thus the claims are not enabled by the Specification (Final Act 3). We note that the Examiner’s reasoning appears to be directed to whether the Specification includes a written description of the claimed invention rather than whether the claims are enabled. However, in the rejection, the Examiner clearly states that the claims fail to comply with the enablement requirement (Final Act. 2; Ans. 2). As such, we treat this rejection as one made under the enablement requirement of 35 U.S.C. § 112, first paragraph. In making this rejection, the Examiner fails to address whether a person of ordinary skill in the art at the time of the invention would have been able to make and use the invention without undue experimentation. Therefore, the rejection cannot be sustained.

### Indefiniteness

The Examiner argues that it is unclear how a single computer-readable medium is being executed by the user computer, the server and the advertising server (Final Act. 4). We agree with the Appellants that the claims “a computer readable medium” covers multiple storage entities and

those entities can contain the instructions for multiple machines (Appeal Br. 6). In addition, we note that a single computer-readable storage medium can be coupled successively to multiple machines, i.e., the advertising server, the user computer, and the server. Therefore, we will not sustain this rejection.

Obviousness

The Appellants argue that there is no reason to modify the method of Goldhaber. We agree.

The Examiner found that Goldhaber discloses the invention except that Goldhaber does not disclose that responses from a control group are evaluated (Final Act. 7–9). The Examiner takes Official Notice that it is old and well known to maintain a control group to which the exposed group may be compared (Final Act. 9). The Examiner concludes that it would have been obvious to modify the method of Goldhaber to evaluate responses from a control group to provide a baseline to which the test group responses may be compared (Final Act. 10).

We find that Goldhaber discloses an attention brokerage server that delivers ads to consumers (col. 15, ll. 48–50). A consumer can click on an ad and have that ad presented (col. 16, ll. 6–10). The advertisement display may ask the consumer questions or otherwise require consumer interaction to ensure that the consumer paid attention to the ad and based on determining that the consumer did pay attention to the ad, an amount of digital currency may be deposited in the consumer’s account (col. 16, ll. 10–17). As such, the objective of Goldhaber is to determine whether the consumer paid attention to the ad. It is not clear from the rejection of the

Examiner why a person of ordinary skill in the art would include a control group in the Goldhaber method. Goldhaber is not comparing the actions of one group in relation to a control group but instead is determining whether those consumers that are exposed to the ad, pay attention to the ad.

Therefore, although it may be true that it was known to include a control group to distinguish two sets of users, it is not clear how such a control group would be utilized in the Goldhaber method. In this regard, as the objective in Goldhaber is to determine if a consumer paid attention to an ad and to reward those that do pay attention, it is not seen how one executing the Goldhaber method would seek to provide a baseline to which the test group may be compared. The consumers are all exposed to the ad in Goldhaber and in accordance with a determination of whether they paid attention, paid compensation.

As the Examiner has not established a reason to modify Goldhaber in accordance with the Official Notice taken, we will not sustain this rejection.

#### DECISION

The decision of the Examiner is reversed.

#### ORDER

REVERSED