



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.
12/791,645	06/01/2010	Scott Yancey	TET-P0001-01-US-e	3092
27268	7590	11/21/2016	EXAMINER	
Faegre Baker Daniels LLP 300 NORTH MERIDIAN STREET SUITE 2700 INDIANAPOLIS, IN 46204			DAGNEW, SABA	
			ART UNIT	PAPER NUMBER
			3688	
			NOTIFICATION DATE	DELIVERY MODE
			11/21/2016	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):

inteas@faegrebd.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SCOTT YANCEY and JORDAN CHASE CRAFTON

Appeal 2014-009267
Application 12/791,645
Technology Center 3600

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
BRADLEY B. BAYAT, *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-IN-PART and enter a NEW GROUND OF REJECTION.

THE INVENTION

The Appellants' claimed invention is directed to advertising using mobile devices (Spec. 1–3). Claim 18, reproduced below, is illustrative of the subject matter on appeal.

18. A method of advertising using a mobile device, the method comprising:

receiving at least one identifier code to a target phone number from the phone number of a mobile device and pairing the phone number of said mobile device to said at least one identifier code in a database, wherein said at least one identifier code corresponds to data encoded on the integrated circuit of an RFID transceiver;

transmitting a list message to the phone number of said mobile device, wherein said list message contains a list of commercial establishments;

receiving a selection message containing one or more selections from said list of commercial establishments;

associating the phone number of said mobile device and said at least one identifier code to at least one advertising campaign based at least partially upon said one or more selections; and

producing one or more incentive messages relating to said one or more selections based at least upon the detection of said data encoded on said RFID transceiver.

THE REJECTIONS

The following rejections is before us for review:

1. Claims 1–20 under 35 U.S.C. § 112(a), first paragraph, as failing to comply with the written description requirement.
2. Claims 1–20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

3. Claims 1–25 under 35 U.S.C. § 103(a) as being unpatentable over Balakrishnan (US 2008/0052159 A1, pub. Feb. 28, 2008).

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.¹

ANALYSIS

Written Description

The Examiner has determined that the written description requirement is not met by the term “RFID transceiver” in claims 1, 9, and 18 (Final Act. 2; *see also* Ans. 2–4).

In contrast, the Appellants have argued that this rejection is improper because “RFID tag 110 clearly provides support for the term RFID transceiver” (Appeal Br. 11). According to the Appellants, “RFID tags clearly have both a transmitter and a receiver” (*id.*) and “RFID tags are also transceivers in that they also transmit and receive signals” (Reply Br. 2).

We agree with the Examiner. The Specification does not contain the term “RFID transceiver” and Appellants have not cited convincing evidence in the record in support of their position. Accordingly, the rejection is sustained.

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

Rejection under 35 U.S.C. § 101

The Examiner rejected claims 1–20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter (Final Act. 3). In the Answer, the Examiner withdrew the rejection as to claims 1–17 (Ans. 2, 4). We note that the Examiner’s Answer was mailed June 19, 2014, six days prior to the issuance of the USPTO’s June 25, 2014 Preliminary Examination Instructions in view of the Supreme Court’s decision in *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014).

We will sustain this rejection for the reasons discussed below, but because our rationale for rejecting claims 18–20 differs from the Examiner’s, we denominate this rejection as a NEW GROUNDS OF REJECTION under 37 C.F.R. § 41.50(b).

Obviousness

Claims 1–8, 23, and 24

Claim 1 requires “associating the phone number of said mobile device and said at least one identifier code to at least one advertising campaign based at least partially upon said first keyword.”

The Appellants contend that Balakrishnan does not disclose the above limitation of claim 1 because “[t]he service provider ID is attached to the service provider regardless of anything that a review-providing customer does” and so the association is not performed “based at least partially upon said first keyword” as required by claim 1 (Appeal Br. 15).

In contrast, the Examiner has determined that the rejection is proper. The Examiner finds the claimed “identifier code” in Balakrishnan in the provider number stored in the review database 204 of Figure 2, and finds the

claimed “advertising campaign” in the marketing material of paragraph 121 of Balakrishnan (Final Act. 5–7). The Examiner cites further to this as being in Balakrishnan at paragraphs 36 and Figure 2 (item 222) (Final Act. 6, 18). The Examiner also cites paragraphs 26–32, 42, 43, and 47 of Balakrishnan (Ans. 5–9).

We agree with the Appellants. We have reviewed the cited portions of Balakrishnan and determine that the cited claim limitation is not shown as cited. For example, paragraph 121 discloses that providers can include review codes in marketing materials. The association is determined by the provider and not based on the content of the review code. Thus, the Examiner’s finding that the association between provider and promotional offer is “based at least partially upon said first keyword” is not supported.

Accordingly, the rejection of claim 1 and dependent claims 2–8, 23, and 24 is not sustained.

Claims 18, 19, 20, and 25

Claim 18 requires “associating the phone number of said mobile device and said at least one identifier code to at least one advertising campaign based at least partially upon said one or more selections.”

The Appellants contend that Balakrishnan does not disclose this limitation because “[a]s previously noted with respect to claim 1, the review code/service provider ID is already linked to the location it represents” (Appeal Br. 19–20).

In contrast, the Examiner has determined that the rejection is proper. The Examiner finds the “selection message” of claim 18 in Figure 4 of Balakrishnan and again finds the claimed “identifier code” in the provider

number in the review database 204 of Figure 2, and the claimed “advertising campaign” in the promotional offer of review database 204 (Final Act. 14–16). The Examiner also cites to paragraphs 36, 42, 43, and 84 (Final Act. 15).

We agree with the Appellants for similar reasons discussed above with respect to claim 1, as the above limitations are not disclosed by the above citations.

Accordingly, the rejection of claim 18 and dependent claims 19, 20, and 25 is not sustained.

Claims 9–17, 21, and 22

The Appellants contend that the rejection of claim 9 is improper because the “reviews of Balakrishnan are not detected ‘from a first RFID transceiver’” (App. Br. 18). The Appellants also argue that “the ‘review code’ within the RFID tag is not ‘uniquely paired with one and only one of said one or more phone numbers’” because in Balakrishnan the “review code is available to be used and associated with any number of reviewers, phones, and phone numbers” (*id.* at 19).

In contrast, the Examiner has determined that the rejection is proper. The Examiner finds the “database” of claim 9 in Balakrishnan in review database 204 and finds the “detecting” step in paragraph 47 (Final Act. 10–12).

We agree with the Examiner. Regarding the “detecting” step, Balakrishnan in paragraph 47 clearly discloses that review codes can be stored in and read from an RFID tag. Regarding the “uniquely paired” limitation, Appellants’ argument does not apprise us of error in the

Examiner's rejection under a broadest reasonable interpretation. Regardless of the number of reviewers ultimately associated with a particular review code in Balakrishnan, there must always be a first reviewer that will be uniquely paired with the review code.

Accordingly, the Examiner's rejection of claim 9 is sustained.

The Appellants have not provided separate arguments for dependent claims 10–17, and the rejection of these claims is sustained for the same reasons.

Regarding claims 21 and 22, Appellants contend that “no rejection is presented” (Appeal Br. 20).²

Appellants argument does not apprise us of error in the Examiner's rejection set forth in the Supplemental Office Action mailed March 21, 2013 at pages 16–17 (*see also* Ans. 11–12).

NEW GROUND OF REJECTION

Claims 1–25 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Alice identifies a two-step framework for determining whether claimed subject matter is judicially-expected from patent eligibility under § 101.

² The Appellants have presented arguments for the first time in the Reply Brief that were not made in the Appeal Brief, filed Aug. 18, 2014. Arguments which Appellants could have made but chose not to make in these Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv).

According to *Alice* step one, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept,” such as an abstract idea. *Alice*, 134 S. Ct. at 2355.

Taking claim 18 as representative of the claims on appeal, the claimed subject matter is directed to targeted advertising messages of an advertising campaign. Targeted advertising, i.e., matching consumers with a given product or service, is a fundamental economic practice and as such is an abstract idea.

Step two of *Alice* is “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.” *Id.*

We see nothing in the subject matter claimed that transforms the abstract idea of targeted advertising into an inventive concept.

Method claim 18 includes five steps of gathering information and transmitting information; that is, gathering particular data (“receiving at least one identifier code to a target phone number”), sending a message (“transmitting a list message to the phone number”), receiving a message (“receiving a selection message”), matching a consumer’s device to an advertising campaign (“associating the phone number of said mobile device and said at least one identifier code to at least one advertising campaign”), generating targeted advertising (“producing one or more incentive messages”). Claims 1 and 9 contain similar limitations.

The receiving, transmitting, receiving, and associating steps are known operations for gathering information and thus add little to patentably transform the information gathering abstract idea. As for the final step,

“producing one or more incentive messages” (claim 18), it simply expresses a mere post-solution activity of generating targeted advertising based on the gathered information.

Finally, we note that claims 1 and 9 call for the recited steps to be performed “electronically.” But any electronic device available at the time the application was filed would have satisfied these limitations. Claim 9 also requires “a database,” but any generic database available at the time the application was filed would have satisfied this limitation. The Specification supports that view. *See* Spec. 10, ll. 20–21 (“the database may be configured in any manner as known in the art”). “[T]he 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.” *Alice*, 134 S. Ct. at 2358 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)).

For the foregoing reasons, we find that claim 18 covers subject matter that is judicially-excepted from patent eligibility under § 101. The other independent claims – method claims 1 and 9 parallel claim 18 – similarly cover claimed subject matter that is judicially-excepted from patent eligibility under § 101. The dependent claims describe various information gathering schemes which do little to patentably transform the abstract idea.

Therefore, we enter a new ground of rejection of claims 1–25 under 35 U.S.C. § 101.

CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 112(a), first paragraph, as failing to comply with the written description requirement.

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1–8, 18, 19, 20, 23, 24, and 25 under 35 U.S.C. § 103(a) as unpatentable over Balakrishnan.

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 9–17, 21, and 22 under 35 U.S.C. § 103(a) as unpatentable over Balakrishnan.

We conclude that the Appellants have not shown that the rejection of claims 1-25 under 35 U.S.C. § 101 is in error but enter a new grounds of rejection below.

DECISION

The Examiner’s decision to reject claims 1–20 under 35 U.S.C. § 112(a), first paragraph, as failing to comply with the written description requirement is affirmed.

The Examiner’s decision to reject claims 1–8, 18, 19, 20, 23, 24, and 25 under 35 U.S.C. § 103(a) as unpatentable over Balakrishnan is reversed.

The Examiner’s decision to reject claims 9–17, 21, and 22 under 35 U.S.C. § 103(a) as unpatentable over Balakrishnan is affirmed.

Claims 1–25 are newly rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

NEW GROUND

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

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

Appeal 2014-009267
Application 12/791,645

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)