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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* LAURA COCHRAN and MARK ORLANDO NELSON

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Appeal 2015-002587  
Application 13/178,857<sup>1</sup>  
Technology Center 3600

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Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and  
KENNETH G. SCHOPFER, Administrative Patent Judges.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Laura Cochran et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1–24. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

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<sup>1</sup> The Appellants identify The Nielsen Company (US), LLC as the real party in interest. App. Br. 2.

### THE INVENTION

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

1. A method, comprising:

selecting an attribute for a non-residential-based venue indicative of a type of person likely to attend the non-residential-based venue;

obtaining at least one of demographic data or psychographic data associated with the attribute; and

generating, using a processor, a venue profile for the non-residential-based venue using the at least one of the demographic data or psychographic data associated with the attribute.

### THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Ruuspakka	2011/0207440 A1	Aug. 25, 2011
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The following rejections are before us for review:

1. Claims 1–24 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Claims 17–24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.
3. Claims 1–24 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ruuspakka.

## ISSUES

Did the Examiner err in rejecting claims 1–24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter?

Did the Examiner err in rejecting claims 17–24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention?

Did the Examiner err in rejecting claims 1–24 under 35 U.S.C. § 102(e) as being anticipated by Ruuspakka?

## FINDINGS OF FACT

We rely on the Examiner’s factual findings stated in the Answer. Additional findings of fact may appear in the Analysis below.

## ANALYSIS

*The rejection of claims 1–24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.*

The Appellants’ challenge to the rejection fails to show error in the rejection.

The Examiner analyzed the claims in accordance with the two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101 as articulated in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014). Ans. 2–4. In accordance therewith, the Examiner found that (1) “the claims are directed towards the concept of generating and utilizing venue profiles for advertisement purposes . . . [, that is], an abstract idea” (Ans. 3), and (2)

[t]he claims do not recite limitations that are “significantly more” than the abstract idea . . . . The limitations are merely instructions to implement the abstract idea on a computer and require no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry.

(Ans. 3–4). From this, the Examiner determined that the claimed subject matter runs afoul of 35 USC § 101.

Pages 5 to 12 of the Reply Brief challenge the rejection as to claim 1 on various grounds.

Pages 5 to 11 of the Reply Brief discuss the first step of the *Alice* framework.

In that regard, the Appellants repeatedly rely on *PNC Bank v. Secure Access, LLC.*, Case No. CBM2014-00100 (PTAB Sept. 9, 2014) to make the point that the Examiner did not do what was required to be done. Principally, according to the Appellants, said case explains that *Alice* “clearly requires evidentiary support for a conclusion that a claim is directed to an abstract idea,” something the Appellants find the Examiner has not provided.

As a matter of course, what a different panel did in a different situation under a different set of facts has little bearing on how this case should be disposed of.

Still, examining earlier cases can have a role, especially in deciding whether a concept that claims are found to be directed to is an abstract idea. See *Amdocs (Israel) Limited v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016)(“Instead of a definition [for what an “abstract idea” encompasses], then, the decisional mechanism courts now apply is to

examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.”) In that regard, the patent claims (US 7,631,191 (“’191 patent”)) the *PNC Bank* panel had before them are not comparable to the claims here at issue. The ’191 patent claims involve authenticating a web page and were classified in class 713 covering electrical computers and digital processing systems subject matter. They are comparable to the claims involved in *BASCOM Global Internet Services v AT&T Mobility LLC.*, 827 F.3d 1341 (Fed Cir. 2016) (US 5,987,606, classified in class 713). In contrast, the claims here at issue, classified in class 705, involve information generation. More relevant cases are *Inventor Holdings, LLC v. Bed Bath & Beyond Inc.*, 123 F. Supp. 3d 557 (D. Del. 2015), *aff’d*, 643 F. App’x 1014 (Fed. Cir. 2016) (*see, e.g.*, US 6,381,582 (claim 1) (“generating data”), class 705) and *Morsa v. Facebook, Inc.*, 77 F. Supp. 3d 1007 (C.D. Cal. 2014), *aff’d*, 622 F. App’x 915 (Fed. Cir. 2015) (*see, e.g.*, US 7,904,337 (claim 12) (“generating an advertising presentation”), class 705).

Although we do not consider *PNC Bank* either controlling or germane, that panel’s consideration of evidence in making a determination under the first step of the *Alice* framework has merit. A similar approach was taken in *Apple, Inc. v. Ameranth, Inc.*, No. 2015-1703, 2016 WL 6958650 (Fed. Cir. Nov. 29, 2016). But these cases do not stand for the proposition that Examiners *must* provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea. There is no such requirement. *See, e.g.*, para. IV “July 2015 Update: Subject Matter Eligibility” to 2014 Interim Guidance on Subject Matter Eligibility

(2014 IEG), 79 Fed. Reg. 74618 (Dec. 16, 2014) (“The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a *question of law*. Accordingly, courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the ultimate legal conclusion on eligibility without making any factual findings”). (emphasis added). Evidence may be helpful in certain situations where, for instance, facts are in dispute. But it is not always necessary. It is not necessary in this case.

Claim 1 recites three steps: (a) selecting, (b) obtaining, and (c) generating. All three steps involve information, albeit three different types of information. Two types of information are gathered, and then a third type of information is generated that is associated with the other two. This is the essence of information generation – to take information and generate from that new information. Claim 1 as a whole is directed to that, the concept of information generation. Information generation is a fundamental building block of research, not to mention fundamental to human behavior for, among many goals, attaining knowledge. We naturally constantly take in information and from that generate new information. The abstract idea category of judicially-excepted subject matter broadly covers building blocks of human ingenuity, like fundamental economic practices (*see Alice*, 134 S. Ct. at 2355). Information generation is such a building block and thus properly categorized as an abstract idea. Thus, we agree with the Examiner that claim 1 is directed to an abstract idea.

The Appellants argue that the actual language of the claim, when taken as whole, is not an abstract idea. “[T]he Examiner ignores the actual claim language in favor of its straw man abstraction.” Reply Br. 9.

Claim 1 is not directed to “the concept of generating and utilizing venue profiles for advertisement purposes.” Rather, claim 1 at issue in the instant application recites selecting an attribute for a non-residential-based venue indicative of a type of person likely to attend the non-residential-based venue, obtaining at least one of demographic data or psychographic data associated with the attribute, and generating, using a processor, a venue profile for the non-residential-based venue using the at least one of the demographic data or psychographic data associated with the attribute.

*See id.* at 11. We disagree.

We find the Examiner properly and reasonably found that claim 1 is directed to “the concept of generating and utilizing venue profiles for advertisement purposes” (Ans. 3) and that that is an abstract idea. We have condensed it to “information generation” (*see above*), but that is simply a higher level of abstraction than the Examiner’s articulation of it. *Cf. Apple, Inc. v. Ameranth, Inc.*, 2016 WL 6958650, \*7 (Fed. Cir. Nov. 29, 2016) (“An abstract idea can generally be described at different levels of abstraction. As the Board has done, the claimed abstract idea could be described as generating menus on a computer, or generating a second menu from a first menu and sending the second menu to another location. It could be described in other ways, including, as indicated in the specification, taking orders from restaurant customers on a computer.”) The Appellants go to an even lower level of abstraction – wording what the claim is directed to so that it includes many of the terms recited in the claim. But that does not make the claim any less directed to an abstract idea. Under the first step of



the *Alice* framework, “[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. However it is described, we do not see that the Appellants have adequately shown that claim 1 is not directed to an abstract idea. Just because the claim includes more words than the Examiner relied upon to articulate the abstract idea to which he found the claim to be directed to is an insufficient reason to persuasively argue that claim 1 is not directed to an abstract idea. We should add that for all the criticism of a lack of evidentiary support, the Appellants themselves have put forward no rebuttal evidence showing claim 1 is *not* directed to an abstract idea or, if directed to information generation — irrespective of the level of abstraction to which it may be described—it is *not* an abstract idea.

We note the point about pre-emption. Reply Br. 11 (“[T]hat independent claim 1 is not directed to an abstract idea that would give rise to ‘a concern that monopolization of the basic tools of scientific and technological work might impede innovation more than it would promote it’ (Preliminary Examination Instructions, page 2)”). While pre-emption “might tend to impede innovation more than it would tend to promote it, ‘thereby thwarting the primary object of the patent laws’” (*Alice*, 134 S. Ct. at 2354 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012)), “the absence of complete preemption does not demonstrate patent eligibility” (*Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015)). *See also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir.), *cert. denied*, 136 S. Ct. 701, 193 (2015)(“[T]hat the claims do not preempt all price optimization

or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”).

We now turn to the second step of the *Alice* framework: “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*, 134 S. Ct. at 2355 (alteration in original) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294 (2012)).

Pages 11 and 12 of the Reply Brief address the second step of the *Alice* framework. According to the Appellants,

the Examiner has failed to satisfy the second prong of the test outlined in *Alice*. Even assuming an abstract idea is present in claim 1 (none has been identified), the recitations of claim 1 provide “meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment” (*Interim Eligibility Guidance*, page 22).

Reply Br. 11. The limitations argued as being meaningful have to do with the type of information that is recited in the claim. We are not persuaded that the type of information recited in claim 1 meaningfully limits the subject matter claimed as a whole so that in practice it amounts to significantly more than to be upon the information generation abstract idea itself.

None of the three individual steps, viewed “both individually and ‘as an ordered combination,’” transform the nature of the claim into patent-eligible subject matter. *See Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297, 1298). The claimed sequence of steps comprises only “conventional steps, specified at a high level of generality,” which is

insufficient to supply an “inventive concept.” *Id.* at 2357 (quoting Mayo, 132 S. Ct. at 1294, 1297, 1300).

The first two steps are data gathering steps that add little to patentably transform the information generation abstract idea. Furthermore, they are not linked to any device and thus could be practiced mentally. Adding a mental step cannot patentably transform an otherwise abstract idea into an inventive concept. *In re Comiskey*, 554 F.3d 967, 979 (Fed. Cir. 2009) (“mental processes—or processes of human thinking—standing alone are not patentable even if they have practical application”).

The third generating step generates information. Unlike the first two steps, it is linked to a “processor”; that is, by “using a processor,” information is generated. But any general-purpose computer available at the time the application was filed would have satisfied this limitation. The Specification supports that view. *See, e.g.*, para. 36 of the Specification. “[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.

As for the type of information involved, i.e., (a) “an attribute for a non-residential-based venue indicative of a type of person likely to attend the non-residential-based venue” (first step in claim 1); (b) “at least one of demographic data or psychographic data associated with the attribute” (second step in claim 1), and (c) “venue profile for the non-residential-based venue using the at least one of the demographic data or psychographic data associated with the attribute” (third step in claim 1), they provide a practical

application for information generation in advertising. But that is not enough to ensure that in practice the claimed subject matter amounts to significantly more than to be upon the information generation concept itself. *Cf.*

*CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1371 (Fed. Cir. 2011) (“The Court rejected the notion that the recitation of a practical application for the calculation could alone make the invention patentable.”).

The Appellants also address the rejection of claims 4, 5, 9, 12, 13, 17, 20, and 21. Reply Br. 12–16. But the arguments are essentially the same as those we have already addressed. These claims characterize the type of information involved even further. But this is not enough to ensure that in practice the claimed subject matter amounts to significantly more than to be upon the information generation concept itself. Claims 3, 13, and 21 include a “comparison.” But “comparing one thing to another” is an abstract idea. *See Blue Spike, LLC v. Google Inc.*, No. 14-CV-01650-YGR, 2015 WL 5260506 (N.D. Cal. Sept. 8, 2015), *aff’d*, No. 2016-1054, 2016 WL 5956746 (mem) (Fed. Cir. Oct. 14, 2016). Merely combining abstract ideas does not render the combination any less abstract. *Cf. Shortridge v. Found. Constr. Payroll Serv., LLC*, No. 14-CV-04850-JCS, 2015 WL 1739256 (N.D. Cal. Apr. 14, 2015), *aff’d*, No. 2015-1898, 2016 WL 3742816 (Fed. Cir. July 13, 2016).

We have considered all the Appellants’ arguments but find them unpersuasive as to error in the rejection. The rejection is sustained.

*The rejection of claims 17–24 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.*

We will reverse for the reason given in the Appeal Brief; that is, “breadth of a claim is not to be equated with indefiniteness.” App. Br. 6. We appreciate the Examiner’s concern that the claim 17 apparatus recites elements (“selector,” “retriever,” “profile generator”) whose specific structure is not readily ascertainable, but in light of the Specification, they reasonably broadly cover components of a computer system, namely a venue profiler (*see* Spec., Fig. 3 (element 218); *id.* at para. 36). The elements encompass a large number of possible structures but that does not make the claim indefinite. *Cf. In re Goffe*, 526 F.2d 1393, 1398 (CCPA 1975) (“The mere fact that the claims cover a large number of possible process steps and imaging member materials does not in and of itself make the claims indefinite.”)

*The rejection of claims 1–24 under 35 U.S.C. §102(e) as being anticipated by Ruuspakka.*

All the claims require selecting a first information, obtaining a second information, and generating a third information associated with the first and second information. The Examiner cited numerous passages in Ruuspakka as evidence that each said step is expressly described therein. *See* Final Act. 6–8. For example, the selecting step is said to be described in paras. 2–8, 10, 11, 27–30, 32, 34, 36–38, 42–44, 50–59, 65, 69, and 70 of Ruuspakka. *Id.* at 6–7. We have reviewed said passages but do not find there any description, for example, of “selecting” a first information to which a third information associated therewith is generated, as claimed. We see various

disclosures of “selecting advertisements” (*e.g.*, Ruuspakka, para. 27) that go more to a result being generated than to a selection to which another information associated therewith is then generated, as claimed. In that regard, we agree with the Appellants that “Ruuspakka selects an advertisement in a movie theater based on two **separate, unrelated** factors that are not associated with each other.” Reply Br. 19 (with respect to the disclosure in para. 53 of Ruuspakka). The evidence does not adequately support the Examiner’s position that Ruuspakka *expressly* describes what is claimed. Accordingly, we do not find that a prima facie case of anticipation has been made out in the first instance by a preponderance of the evidence.

#### CONCLUSIONS

The rejection of claims 1–24 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is affirmed.

The rejection of claims 17–24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention is reversed.

The rejection of claims 1–24 under 35 U.S.C. §102(e) as being anticipated by Ruuspakka is reversed.

#### DECISION

The decision of the Examiner to reject claims 1–24 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)(1)(iv).

Appeal 2015-002587  
Application 13/178,857

AFFIRMED