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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TIMO AHOPELTO

Appeal 2015-008205¹
Application 13/058,717²
Technology Center 3600

Before JOSEPH A. FISCHETTI, BRUCE T. WIEDER, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

HUTCHINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–36 and 38. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Our Decision references Appellant’s Appeal Brief (“App. Br.,” filed Dec. 15, 2014), Reply Brief (“Reply Br.,” filed Sept. 8, 2015), and Amended Specification (“Spec.,” filed Feb. 11, 2011), and the Examiner’s Answer (“Ans.,” mailed July 7, 2015) and Final Office Action (“Final Act.,” mailed June 19, 2014).

² Appellant identifies Apple, Inc. as the real party in interest. App. Br. 3.

We AFFIRM.

CLAIMED INVENTION

Appellant’s claimed invention “relates in general to delivery of promotional material via cellular networks. In particular the invention relates to targeted delivery of Internet-available promotional material to mobile service subscribers via their mobile devices[.]” Spec. ¶ 2.

Claims 1, 19, and 38 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method for identifying promotional content for delivery to at least one mobile device, the method comprising:
 - receiving, by a processor, a request from a mobile device for a promotional content item pertaining to a specified subject specified by the request;
 - searching, by the processor, one or more promotional content inventories including promotional content configured for delivery via the Internet based on the specified subject to identify promotional content for delivery to the mobile device;
 - selecting, by the processor, from the promotional content items identified as a result of the search, a first promotional content item determined to include a selectable element enabling the mobile device to immediately purchase an item advertised by the first promotional content item; and
 - reformatting, by the processor, the first promotional content item for delivery to the mobile device in one or more messages including at least one of text and multimedia objects.

REJECTIONS

Claims 1–36 and 38 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1, 2, 4–8, 13–20, 22–26, 31–36, and 38 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lang (US 2006/0178932 A1, pub. Aug. 10, 2006), and Grannan (US 2007/0244750 A1, pub. Oct. 18, 2007).³

Claims 3 and 21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lang, Grannan, and Bemmell (US 2008/0097851 A1, pub. Apr. 24, 2008).

Claims 9–12 and 27–30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lang, Grannan, and Ramer (US 2007/0060099 A1, pub. Mar. 15, 2007).

ANALYSIS

Non-Statutory Subject Matter

Appellant argues claims 1–36 and 38 as a group. Reply Br. 3–8. We select claim 1 as representative, and claims 2–36 and 38 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Under 35 U.S.C. § 101, an invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *See, e.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus*

³ We treat the Examiner’s identification at page 2 of the Final Office Action of claims 3 and 21 among the claims subject to rejection over Lang and Grannan as inadvertent error, given their separate rejection at pages 24–27 of the Final Office Action.

Laboratories, Inc., 132 S. Ct. 1289, 1300 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” *id.*, e.g., to an abstract idea. If the claims are not directed to a patent-ineligible concept, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Alice Corp.*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1297).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 132 S. Ct. at 1293. We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.

See Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1336 (Fed. Cir. 2016).

We are not persuaded of Examiner error by Appellant’s argument that the Examiner fails to establish a prima facie case rejection of patent-ineligible subject matter under 35 U.S.C. § 101. Reply Br. 3–4. In this regard, Appellant charges that the Examiner overgeneralizes the claims, fails to support the rejection with analysis and support from case law precedent, fails to consider the remaining claim elements not identified in step one of

the rejection, and fails to articulate the reasoning for the rejection with sufficient clarity and specificity. *Id.*

Yet the Federal Circuit has repeatedly noted that “the prima facie case is merely a procedural device that enables an appropriate shift of the burden of production.” *Hyatt v. Dudas*, 492 F.3d 1365, 1369 (Fed. Cir. 2007) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). The court has, thus, held that the USPTO carries its procedural burden of establishing a prima facie case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *See In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011). Thus, all that is required of the Office is that it set forth the statutory basis of the rejection, and the reference or references relied on, in a sufficiently articulate and informative manner as to meet the notice requirement of § 132. *Id.*; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (Section 132 “is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

Here, in rejecting the pending claims under § 101, the Examiner analyzed the claims in accordance with the *Mayo/Alice* two-step framework. Specifically, the Examiner notified Appellant that independent claims 1, 19, and 38 and their dependents are directed to “providing promotional content based on search requests from mobile devices,” which the Examiner characterizes as a fundamental economic practice, and a method of organizing human activities, i.e., abstract ideas. Ans. 3–4. The Examiner finds that the additional elements or combination of elements are not

sufficient to amount to significantly more than the abstract idea because the claims merely amount to an application of the abstract idea. *Id.* at 4–6. In particular, the Examiner finds that the elements, when taken alone, “each execute in a manner routinely and conventionally expected of these elements,” and, when taken as a combination, “do not offer substantially more than the sum of the functions of the elements when each is taken alone.” *Id.* at 5. The Examiner determines that the claims “do not effect an improvement to another technology or technical field” or “an improvement to the functioning of a computer itself,” and merely “link [] the use of an abstract idea to a particular environment.” *Id.* And the Examiner concludes that the claims merely amount to applying the abstract idea on a computer, requiring no more than a generic computer system. The Examiner, thus, notified Appellant of the reasons for the rejection “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” 35 U.S.C. § 132. And we find that, in doing so, the Examiner set forth a proper rejection under § 101 such that the burden then shifted to Appellant to demonstrate that the claims are patent-eligible.

Addressing the first step of the *Mayo/Alice* framework, Appellant argues that the claims are directed to “a unique method for selecting promotional content and reformatting it for delivery to a mobile device,” and not to “the execution of a basic financial concept.” Reply Br. 5. Appellant asserts that the Specification indicates that the invention provides a “technical advantage,” because “mobile media is limited by screen size and other qualities, and thus search functionality is not easily converted onto mobile devices,” and that operations include “the removal [of] certain

content that is inappropriate for inclusion in a text message and/or replacement or reformatting of some or all of the promotional content with corresponding text.” *Id.* (citing Spec. ¶¶ 16, 38).

Yet, the relevant question is whether the claims as a whole “focus on a specific means or method that improves the relevant technology,” or instead are “directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016), *citing Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016). Here, we find no such technological advance or improvement to technology.

Claim 1, for example, recites four steps for identifying promotional content for delivery to a mobile device. The steps include: (1) receiving a request from a mobile device for a promotional content item; (2) searching one or more promotional content inventories including promotional content configured for delivery via the Internet, (3) selecting from the promotional content items identified as a result of the search a first promotional content item determined to include a selectable element enabling the mobile device to immediately purchase an item advertised by the first promotional content, and (4) reformatting the first promotional content item for delivery to the mobile device.

Appellant’s Specification describes a need for advertisers to reach potential customers via the next new channel, namely, mobile marketing. Spec. ¶ 4. Having existing Internet-based advertising inventory made available for mobile subscribers would be a “significant revenue contributor.” *Id.* ¶ 15. Put simply, the Specification describes a business need to extend Internet-based advertising to mobile devices. The claimed

invention thus converts existing, Internet-based advertising inventory into messages including text and/or multimedia objects for delivery to mobile service subscribers. *Id.* ¶¶ 17, 33. To achieve this conversion, the Specification describes in generic terms “remov[ing] certain content that is inappropriate for inclusion in a text message and/or replacement or reformatting of some or all of the promotional content with corresponding text” to facilitate delivery of the Internet-based advertisement to a mobile device. *Id.* ¶ 38.

Considered in light of the Specification, the heart of the invention addresses a business need (i.e., extending delivery of existing Internet-based advertising to mobile service subscribers), and not to any claimed specific means for accomplishing this goal that improves technology. It follows from case law precedent, and *Ultramercial Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014) in particular, that the claims, considered as a whole and in light of the Specification, are directed to an abstract idea.

In *Ultramercial*, the patentee argued that its claims were “directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before.” *Ultramercial*, 772 F.3d at 714. But the court rejected this argument, finding that “the majority of the limitations describes only the abstract idea of showing an advertisement before delivering free content.” *Id.* at 715. The court acknowledged that the claim contained “certain additional limitations” that “add a degree of particularity,” but deferred consideration of “any novelty in implementation of the idea” as a factor to be considered in the second step in the analysis. *Id.*

Applying step two of the *Mayo/Alice* framework, the *Ultramercial* court found that none of the eleven claimed steps, viewed both individually and as an ordered combination, transformed the nature of the claim into patent-eligible subject matter. *Ultramercial*, 772 F.3d at 715. Particularly, the court found that the additional steps (e.g., updating an activity log, requiring a request to view the ad, restricting public access, and using the Internet) were routine or conventional steps insufficient to supply the requisite inventive concept. *Id.* at 716. The court determined, for example, that restricting public access represents insignificant, pre-solution activity. *Id.* The court further determined that limiting the use of the abstract idea to a particular technological environment (i.e., the Internet) was insufficient to save the claim. *Id.*

Like the claims in *Ultramercial*, the majority of the limitations of claim 1 describe only the abstract idea of identifying promotional content for delivery. For example, steps (1)–(3) (i.e., receiving, searching, and selecting) relate to the concept of identifying promotional content for delivery. Appellant cannot reasonably deny that identifying promotional content for delivery to a potential customer, i.e., targeted advertising, is an age-old and ubiquitous economic practice and, thus, an abstract idea. Moreover, Appellant cannot reasonably deny, and does not deny, that identifying promotional content for delivery also can be properly characterized as an abstract idea relating to a method of organizing human activities. *See* Ans. 3–4 (identifying claims as directed to an abstract method of organizing human activities). Although our articulation of the concept to which the claims are directed may differ from that articulated by the Examiner, any such difference only relates to the level of abstraction. *See*

Apple, Inc. v. Ameranth, Inc., 842 F.3d 1229, 1240–1241 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction.”).

We agree with the Examiner that the additional claim elements, when viewed individually and as an ordered combination, are insufficient to transform the abstract idea into patent-eligible subject matter. Claim 1, for example, further recites that the step of selecting includes determining that the promotional content item includes a “selectable element” enabling the mobile device to immediately purchase an item advertised by the promotional content item. But there is no indication in the Specification, nor does Appellant argue, that this step is anything more than a routine or conventional step. *See, e.g.*, Spec. ¶ 37 (“Additionally, the resulting promotional content may be further filtered based on a mobile subscriber’s ability to immediately access the special offers. Thus, for example, promotional content may be ordered first if they have click-to-buy or click-to-call functionality.”).

Claim 1 also additionally recites reformatting the promotional content item “for delivery to the mobile device in one or more messages including at least one of text and multimedia objects.” Appellant argues that “a mobile device may not be capable of receiving promotional content that is configured for delivery via the Internet,” and “concerns such as bandwidth and data usage can make [promotional content configured for the Internet] less appealing to an advertiser or a network operator [for delivery to a mobile device].” Reply Br. 7; *see also id.* at 5 (the claimed solution provides a “technical advantage” because mobile media is limited by screen size and other qualities). Yet Appellant does not claim to have invented the

technique of reformatting, nor for that matter does Appellant claim to have invented any advances in reformatting technology.

Here, the claimed “reformatting” broadly and generically focuses on the result of the reformatting (e.g., for delivery to the mobile device” in a message having text and/or multimedia objects), and not on any innovative technique or technology required to execute the step. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (2016) (“[i]nquiry must turn to any requirements for *how* the desired result is achieved.”). The claimed reformatting lacks any details regarding how the claimed reformatting is achieved and, as such, covers any known technology for reformatting. Similarly, the Specification also lacks details indicating that reformatting requires anything more than conventional, generic functionality. *See Spec.* ¶ 38 (“Operations performed at 225 may include the removal certain [sic] content that is inappropriate for inclusion in a text message and/or replacement or reformatting of some or all of the promotional content with corresponding text.”); *see also Elec. Power Grp.*, 830 F.3d at 1356 (“the essentially result-focused functional character of claim language has been a frequent feature of claims held ineligible under § 101”). Thus, similar to the situation in *Ultramercial*, here, the claimed reformatting merely limits the use of the abstract idea to a particular technological environment (i.e., mobile devices), which is insufficient to save the claim.

Appellant additionally argues that “the claims recite substantial features that particularly define the manner in which promotional content is searched, selected, and reformatted to facilitate delivery to a mobile device.” Reply Br. 7. But that the claims are “particularly defined” make them no less abstract. Appellant contends that the claims search promotional content

inventory that is configured for delivery via the Internet, thereby “increas[ing] the scope of available promotional content but can present issues with respect to a mobile device.” *Id.* Yet this feature relates to the business need addressed by the invention. Appellant asserts that mobile devices may be unable to receive the content configured for the Internet, or may find such content unappealing due to bandwidth and data usage concerns associated with the mobile device. *Id.* Yet, as described above, Appellant does not establish that the claimed reformatting, whether considered alone or as an ordered combination, transforms the nature of claim 1 into a patent-eligible application.

We are not persuaded by Appellant’s argument regarding preemption. *See* Reply Br. 7–8. There is no dispute that the Supreme Court has described “the concern that drives this exclusionary principle [i.e., the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption.” *Alice Corp.*, 134 S. Ct. at 2354. But characterizing pre-emption as a driving concern for patent eligibility is not the same as characterizing pre-emption as the sole test for patent eligibility. “The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability” and “[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 134 S. Ct. at 2354). Yet, although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

No technological advance is evident in the present invention. Claim 1 does not resolve any problem particular to computer networks and/or the

Internet. Instead, claim 1 merely employs generic computer components to perform generic computer functions, i.e., receiving and processing information, to solve a business need. *See Elec. Power Grp.*, 830 F.3d at 1355 (“Nothing in the claims, understood in light of the specification, requires anything other than off-the-shelf, conventional computer, network, and display technology for gathering, sending, and presenting the desired information”).

In view of the foregoing, we sustain the Examiner’s rejection of claim 1 under 35 U.S.C. § 101. We also sustain the Examiner’s rejection of claims 2–36 and 38, which fall with claim 1, under 35 U.S.C. § 101.

Obviousness

Independent Claim 1 and Dependent Claims 2, 4–8, and 13–18

We are persuaded by Appellant’s argument that the Examiner erred in rejecting independent claim 1 because Lang fails to disclose or suggest “selecting . . . from the promotional content items identified as a result of the search, a first promotional content item determined to include a selectable element enabling the mobile device to immediately purchase an item advertised by the first promotional content item,” as recited in claim 1. App. Br. 6–8. The Examiner relies on paragraphs 14 and 41 as disclosing the argued limitation. *See* Ans. 7. Yet we see nothing in the cited portions that teaches or suggests the argued limitation.

Lang is directed to a method and system for electronic coupons offered by businesses via the wireless devices operated by potential customers in a region. Lang Abstract. Lang’s system allows potential customers having a wireless communication device to identify coupons in a selected region that are associated with a category of goods or services of

interest to the customer. *Id.* ¶ 37; *see also id.* ¶¶ 14, 41. Coupons are distributed to the customer’s wireless communication device from a central server. *Id.* ¶ 37. The coupons are stored on the wireless device in an inactive or active status. *Id.* An active coupon may be presented to a business and redeemed. *Id.* Specifically, the potential customer presents the activated coupon stored on the wireless communication device to a business representative, and the business representative reviews the coupon and, if necessary, records the coupon’s serial number. *Id.* ¶ 21.

The Examiner finds that Lang at paragraphs 14 and 42 describes “immediate purchasing based on customer searches of available coupons[,] and the customer being able to refine the search for coupons of immediate interest,” which the Examiner equates to the step of “selecting,” as recited in claim 1. Final Act. 5. The difficulty with the Examiner’s analysis is that Lang’s coupon does not include a selectable element enabling the mobile device to immediately purchase an item advertised by the coupon, as called for in the argued claim limitation. Instead, Lang teaches that the customer redeems the coupon by first displaying the coupon on the mobile device, and then presenting the coupon to the business representative. Lang ¶ 21.

In view of the foregoing, we do not sustain the Examiner’s rejection of independent claims 1 and dependent claims 2, 4–8, and 13–18 under 35 U.S.C. § 103(a).

Independent Claims 19 and 38, and Dependent Claim 20, 22–26, and 31–36

Claims 19 and 38 includes language substantially similar to the language of claim 1, and stands rejected under the same reasoning as applied to claim 1. *See* Final Act. 20–21, 24. Therefore, we do not sustain the Examiner’s rejection of claims 19 and 38, and dependent claims 10, 22–26,

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and 31–36 under 35 U.S.C. § 103(a) for the same reasons set forth above with respect to claim 1.

Dependent Claims 3, 9–12, 21, and 27–30

Each of claims 3, 9–12, 21, and 27–30 depends, directly or indirectly, from one of independent claims 1 and 19. The rejections of these dependent claims do not cure the deficiencies in the rejections of independent claims 1 and 19. Therefore, we do not sustain the Examiner’s rejections of claims 3, 9–12, 21, and 27–30 under 35 U.S.C. § 103(a) for the same reasons set forth above with respect to independent claims 1 and 19.

DECISION

The Examiner’s rejection of claims 1–36 and 38 under 35 U.S.C. § 101 is affirmed.

The Examiner’s rejections of claims 1–36 and 38 under 35 U.S.C. § 103(a) are reversed.

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