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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDWARD DAVID MONNERAT and MEHUL S. PATEL

Appeal 2016-000336
Application 13/795,919[1]
Technology Center 2400

Before JASON V. MORGAN, HUNG H. BUI, and JOHN R. KENNY, *Administrative Patent Judges*.

BUI, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Office Action rejecting claims 1–12 and 23–33, which are all of the claims pending on appeal. Claims 13–22 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.[2]

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[1] According to Appellants, the real party in interest is Comcast Cable Communications, LLC. App. Br. 2.

[2] Our Decision refers to Appellants' Appeal Brief filed May 5, 2015 ("App. Br."); Reply Brief filed September 29, 2015 ("Reply Br."); Examiner's Answer mailed July 23, 2015 ("Ans."); Final Office Action mailed July 30, 2014 ("Final Act."); and original Specification filed March 12, 2013 ("Spec.").

STATEMENT OF THE CASE

Appellants' invention relates to "advertisement tracking" that includes "monitor[ing] user actions during the advertisement to determine the efficacy of the advertisement." Spec. ¶¶ 1, 3. According to Appellants, user actions may include "[1] changing the audio level of the advertisement during play, [2] obstructing the advertisement, or [3] changing the z-order [e.g., the order determining which application remains visible when two applications overlap in the display area] of the window containing the advertisement." Spec. ¶ 3; Abstract.

Claims 1, 5, and 7 are independent. Claim 1 is illustrative of Appellants' invention, as reproduced with disputed limitations emphasized below:

> 1. A method, comprising:
> determining whether an advertisement was obscured during a presentation of the advertisement on a display device;
> *determining a time at which a user action has occurred during the presentation of the advertisement on the display device*; and
> generating an advertisement effectiveness report for the advertisement, wherein the report indicates how the advertisement was obscured during the presentation of the advertisement on the display device and *the time at which the user action occurred during the presentation of the advertisement on the display device*.

App. Br. 12 (Claims App'x.).

Examiner's Rejections and References

(1) Claims 1–6, 9, 11, 12, 24–26, 28–31, and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pottjegort (US 2013/

0185164 A1; published July 18, 2013; "Pottjegort") and Li et al., (US 2009/0077579 A1; published Mar. 19, 2009; "Li"). Final Act. 2–6.

(2) Claims 7, 8, 23, 27, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pottjegort, Li, and Rozmaryn et al., (US 2010/0005403 A1; published Jan. 7, 2010; "Rozmaryn"). Final Act. 6–7.

(3) Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pottjegort, Li, and Morris et al., (US 2013/0018731 A1; published Jan. 17, 2013; "Morris"). Final Act. 7.

ISSUE

Based on Appellant's arguments, the dispositive issue presented on appeal is whether the Examiner erred in finding the cited prior art teaches or suggests the disputed limitations: "determining a time at which a user action has occurred during the presentation of the advertisement on the display device" and "wherein the [advertisement effectiveness] report indicates . . . the time at which the user action occurred during the presentation of the advertisement on the display device," as recited in Appellants' independent claim 1 and similarly recited in claims 24 and 30. App. Br. 5–8; Reply Br. 2–4.

ANALYSIS

With respect to independent claim 1, the Examiner finds Pottjegort teaches a method of determining the visibility of electronic advertisements, shown in Figure 6, comprising: "determining whether an advertisement was obscured during a presentation of the advertisement on a display device . . . and generating an advertisement effectiveness report for the advertisement,

wherein the report indicates how the advertisement was obscured during the presentation of the advertisement on the display device." Final Act. 3 (citing Pottjegort ¶¶ 40–41, 72–73). According to the Examiner, "Pottjegort discloses that browser 715 reports advertisement visibility information to metric server 740." Ans. 3 (citing Pottjegort ¶¶ 41, 72–73).

The Examiner acknowledges Matsumoto does not explicitly teach certain well known features relating to advertisement tracking, such as: (1) "determining a time at which a user action has occurred during the presentation of the advertisement on the display" and (2) the "report [also] indicates 'the time at which the user action occurred during the presentation of the advertisement on the display device,'" as evidenced from Li's method for sending advertisements, monitoring advertisements received by subscriber devices to track customers' viewing behavior and estimating an effectivity index for target advertisements in order to support the conclusion of obviousness. *Id*. at 2–3 (citing Li ¶¶ 60–62, Fig. 5).

Appellants do not dispute the Examiner's factual findings regarding Pottjegort. Nor do Appellant challenge the Examiner's rationale for combining the references. Instead, Appellants only dispute the Examiner's factual findings regarding Li. In particular, Appellants acknowledge Li's Figure 5 only shows a data structure that "stores information corresponding to device states, such as a 'display on duration' and a 'display off duration,'" but argue:

> [n]othing in Figure 5 indicates that the data structure stores an indication of <u>a time at which a user action has occurred</u> during the presentation of the advertisement on the display device. . . . Nothing in Li discusses what user action allegedly occurred during the presentation of the advertisement on the display device or the time at which the user action occurred during the

presentation.

App. Br. 6 (citing Li Fig. 5). According to Appellants, Li discusses "'advertising device state data compris[ing] speaker volume data, multi-device usage user device data and current end device data.'" App. Br. 7. As such, Appellants contend Li does not teach or suggest the disputed limitations: "determining a time at which a user action has occurred during the presentation of the advertisement on the display device" and "wherein the [advertisement effectiveness] report indicates . . . the time at which the user action occurred during the presentation of the advertisement on the display device," as recited in Appellants' claim 1.

The Examiner responds that (1) Li's "data structure includes information about subscriber interactions with the subscriber device at a time of a specific commercial being displayed"; and (2) "[t]he time of the subscriber interactions is determined to be during the display of the commercial" and, as such, the "broad claim limitation of determining a time has been interpreted to mean determining a range of time from the beginning to the end of individual commercials." Ans. 3 (citing Li ¶ 60, Fig. 5) (emphasis added).

We do not agree with the Examiner's construction. At the outset, we note Appellants' claim 1 recites, *inter alia*, (1) "determining a time at which a user action has occurred during the presentation of the advertisement on the display device" and (2) "wherein the report indicates . . . the time at which the user action occurred during the presentation of the advertisement on the display device." As recited in Appellants' claim 1, the time limitation refers to a user action that occurs during the presentation of an advertisement on a display device, and not the range of time from a beginning to an end of

individual commercials, as per the Examiner's construction. As recognized by Appellants, the Examiner's construction ignores the phrase "'a time **at which a user action has occurred during** the presentation . . .'" Reply Br. 2.

Nevertheless, we still agree with the Examiner that Li teaches or suggests the disputed limitations of Appellants' claim 1. As explained by the Examiner, Li's data structure, as shown in Figure 5, "includes information about subscriber interactions with the subscriber device at a time of a specific commercial being displayed." Ans. 3 (citing Li ¶ 60, Fig. 5). For example, Li's data structure includes information relating to: (1) a degree of active advertising data viewing 516; (2) the strength of [user] response 518; and (3) an effective index for a particular advertising category for a particular advertisement 520. *See* Li ¶ 62. These categories of information refer to user actions occurring during the presentation of an advertisement which are part of Li's method for sending advertisements, monitoring advertisements received by subscriber devices to track customers' viewing behavior and then estimating an effectivity index for target advertisements. *See* Li ¶¶ 4, 10–13. According to Li, monitoring and tracking of users' viewing and user actions relative to an advertisement includes:

> (1) "records indicating subscriber behavior, including whether or not and for how long audio on a subscriber device has been muted and/or fast forward or other controls have been hit [by user actions]. *See* Li ¶ 26;
>
> (2) "[records of] correlating the time during which the advertisement plays back with subscriber behavior indicates whether the advertisement was rendered to the screen and/or

> speakers, which portions, and for how long to per-second or greater accuracy [by user actions]. *See* Li ¶ 26;
>
> (3) "identif[ing] subscriber behavior about media content consumption [based on user actions]." *See* Li ¶ 27; and
>
> (4) "correlation of advertisement viewership with patterns of consumer behavior. For example, tracking viewership of an advertised media event and estimating a degree of correlation that exists between having viewed its advertisement(s) and tuning into, and/or pre-recording, the event. Another embodiment estimates how a degree of correlation differs depending on whether the advertising data is presented in an episode in a 'regular' series, a 'special' episode in a regular series, special event (Super Bowl, etc.) or a pay-per-view show." *See* Li ¶ 30.

As described by Li, subscriber behavior is based on user actions and "a time at which a user action has occurred during the presentation of the advertisement" as recited in Appellants' claim 1. Tracking subscriber behaviors and subscriber [user] actions taken during the presentation of an advertisement, as disclosed by Li, is well known in the art and any effort to incorporate these features as part of Pottejegort's method of determining the visibility of electronic advertisements would have been obvious to those skilled in the art because these well-known features perform the same known function and yield no more than one would expect otherwise. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). A skilled artisan would "be able to fit the teachings of multiple patents together like pieces of a puzzle" since the skilled artisan is "a person of ordinary creativity, not an automaton." *Id.* at 420–21.

Lastly, we note Appellants have not demonstrated the Examiner's proffered combination of references would have been "uniquely challenging or difficult for one of ordinary skill in the art." *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418). Nor have Appellants provided objective evidence of secondary considerations which our reviewing court guides "operates as a beneficial check on hindsight." *Cheese Systems, Inc. v. Tetra Pak Cheese and Powder Systems, Inc.,* 725 F.3d 1341, 1352 (Fed. Cir. 2013).

For these reasons, we sustain the Examiner's obviousness rejection of independent claim 1 and similarly, independent claims 24 and 30, and their respective dependent claims 2–6, 9, 11, 12, 25, 26, 28, 29, 31, and 33, which Appellants do not argue separately. App. Br. 8.

Claim 10 depends from claim 1, and further recites: "wherein the report further indicates one or more applications that received the one or more user inputs." The Examiner further relies on Morris for teaching a system for displaying advertisements in which "the report further indicates one or more applications that received the one or more user inputs." Final Act. 7–8.

Appellants argue (1) Morris does not teach what the Examiner alleges, and (2) Morris only teaches "the client software compares a timer value to a minimum display time and, based on that comparison, determines whether or not to display a new ad." App. Br. 9–10.

We are not persuaded. Instead, we adopt the Examiner's findings and explanations provided on page 3 of the Examiner's Answer.

OTHER ISSUES

In the event of further prosecution of this application, this panel suggests that the Examiner consider rejecting claims 1–12 and 23–33 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, i.e., an abstract idea in light of the Supreme Court decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S.Ct. 2347 (2014) and the Federal Circuit decision in *Ultramercial Inc. v. Hulu, Inc.,* 772 F.3d 709 (Fed. Cir. 2014).

In *Alice*, the Supreme Court sets forth an analytical "framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Id.* at 2355 (citing *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S.Ct. 1289, at 1296–97 (2012)). The first step in the analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts." *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims "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." *Id.* (quoting *Mayo*, 132 S.Ct. at 1298, 1297). In other words, the second step is to "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.* (brackets in original) (quoting *Mayo*, 132 S.Ct. at 1294). The prohibition against patenting abstract idea "'cannot be circumvented by attempting to limit the use of the formula to a particular technological environment' or adding 'insignificant postsolution activity.'" *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010).

Following the framework set out in *Alice*, the same Federal Circuit in *Ultramercial Inc. v. Hulu, Inc.,* 772 F.3d 709 (Fed. Cir. 2014)., held *Ultramercial's* patent on a method of viewing ads in order to access online content invalid under § 101 because: (1) *Ultramercial's* process of receiving copyrighted media, selecting an advertisement, offering the media in exchange for watching the selected advertisement, displaying the advertisement, allowing the consumer access to the media, and receiving payment from the sponsor of the ad all merely describe an "abstract idea" of using advertising as a currency – devoid of a concrete or tangible application; and (2) "the use of the Internet is not sufficient to save otherwise abstract claims from ineligibility under § 101." *See Ultramercial,* 772 F.3d at 716 (citation omitted).

Similar to *Ultramercial*, Appellants' process claims 1 and 30 and corresponding apparatus claim 24 and their respective dependent claims 2–12, 23, 25–29, and 31–33 recite sending and tracking of such an advertisement and, as such, may be directed to non-patentable subject matter under 35 U.S.C. § 101 for the same reasons outlined by the Federal Circuit in *Ultramercial*.

CONCLUSION

On the record before us, we conclude Appellants have not demonstrated the Examiner erred in rejecting claims 1–12 and 23–33 under 35 U.S.C. § 103(a).

DECISION

As such, we AFFIRM the Examiner's final rejection of claims 1–12 and 23–33.

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