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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/361,415	01/28/2009	Robert C. LEWIS	QC080156	8223
12371	7590	10/31/2017	EXAMINER	
Muncy, Geissler, Olds & Lowe, P.C./QUALCOMM			ALVAREZ, RAQUEL	
4000 Legato Road, Suite 310			ART UNIT	PAPER NUMBER
Fairfax, VA 22033			3622	
			NOTIFICATION DATE	DELIVERY MODE
			10/31/2017	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* ROBERT C. LEWIS  
and GIRIDHAR D. MANDYAM

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Appeal 2016-003541  
Application 12/361,415<sup>1</sup>  
Technology Center 3600

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Before MICHAEL J. STRAUSS, MICHAEL J. ENGLE, and  
PHILLIP A. BENNETT, *Administrative Patent Judges*.

ENGLE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1–63. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

*Technology*

The application relates to a system that “distributes and tracks advertisements presented on a mobile communication device.” Spec. ¶ 3.

*Illustrative Claim*

Claim 1 is illustrative and reproduced below with the limitations at issue emphasized:

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<sup>1</sup> Appellants state the real party in interest is Qualcomm Inc. App. Br. 3.

1. A method for presenting advertisement content on a first client device, comprising:

monitoring, by the first client device, user interaction of a user with the first client device to determine an opportunity to present an advertisement within a first computing environment;  
and

presenting, by the first client device, a selected advertisement to the user on the first client device while tracking an exposure metric;

wherein a second client device monitors user interaction of the user with the second client device to determine another opportunity to present the selected advertisement to the user within a second computing environment while tracking the exposure metric to satisfy an advertising target, wherein *the selected advertisement presented to the user on the first client device comprises the same content as the selected advertisement presented to the user within the second computing environment.*

#### *Rejections*

Claims 1–63 stand rejected under 35 U.S.C. § 103(a) as obvious over the combination of Vasudevan et al. (US 2008/0240010 A1; Oct. 2, 2008) and Apple et al. (US 2007/0073585 A1; Mar. 29, 2007). Final Act. 4.

Claims 1–63 stand rejected under 35 U.S.C. § 101 as being directed to ineligible subject matter. Ans. 2–4; Reply Br. 2.<sup>2</sup>

Claims 1–63 stand rejected on the grounds of non-statutory obviousness-type double patenting over U.S. App. No. 12/361,438.<sup>3</sup> Final Act. 3.

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<sup>2</sup> We note that other than the first page, Appellants' Reply Brief does not expressly show any page numbers. For clarity of the record, Appellants are encouraged to include page numbers.

<sup>3</sup> "Panels have the flexibility to reach or not reach provisional obviousness-type double-patenting rejections." *Ex parte Jerg*, No. 2011-000044, 2012

## ISSUES

1. Did the Examiner err in finding Apple teaches or suggests “the selected advertisement presented to the user on the first client device comprises the same content as the selected advertisement presented to the user within the second computing environment,” as recited in claim 1?

2. Did the Examiner err in finding the combination of Apple and Vasudevan teaches or suggests “determining physical proximity of the first client device to the second client device,” as recited in claim 5?

3. Did the Examiner err in concluding claim 1 is directed to an abstract idea under § 101?

## ANALYSIS

### § 103

#### *A) Claims 1–4, 6–23, 25–33, 35–52, and 54–63*

Claim 1 recites “the selected advertisement presented to the user on the first client device comprises the same content as the selected advertisement presented to the user within the second computing environment.” App. Br. 14 (Claims App’x).

The Examiner relies on Apple for teaching this limitation. Final Act. 4–5. The Examiner finds Apple discloses a “system [that] enables an advertiser to measure the effectiveness of advertisements transmitted to the user through multiple media channels, including, but not limited to: television, radio, personal computer, billboard, magazines, newspapers,

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WL 1375142 at \*3 (BPAI Apr. 13, 2012) (informative); *see also Ex parte Moncla*, 95 USPQ2d 1884 (BPAI 2010) (precedential). Here, both applications remain pending so the double patenting rejection remains provisional, and we exercise our discretion in not reaching it.

product package, and/or other wireless devices, as well as a wireless network.” Apple Abstract; Ans. 5. For example, “paragraph 0145 teaches providing advertisements and/or associated data codes 0200 directly to user **wireless device [0120] and non-wireless device 0122** in order to receive response data from such devices to determine which media device is more effective.” Ans. 5.

Appellants argue there is no evidence that the “same content” is presented to the same user within the second computing environment. App. Br. 8–10.

We agree with the Examiner, however, that Apple teaches measuring the effectiveness of the same advertisement on the same user in different media channels. Ans. 5.

For example, if an Advertiser wanted to measure the effect that varying an Independent Variable, e.g., Media Device 0110, would have on User Response, it could transmit Advertisement A to Sample Group A, which viewed Advertisement A *on a Television and Wireless Device*, and Advertisement A to Sample Group B, which viewed Advertisement A *on a Television, Wireless Device, and Personal Computer*. Because Sample Group A and Sample Group B viewed the same Advertisement A, Sample Group A and Sample Group B were statistically similar, and Sample Group A and Sample Group B viewed the Same Advertisement A on the same Media Devices 0110 except for the Personal Computer, an Advertiser can attribute any difference in User Response to Advertisement A viewed on a Personal Computer.

Apple ¶ 697 (emphasis added). Thus, consistent with the Examiner’s findings, Apple teaches individual users in both sample groups viewed “the same Advertisement” on at least two different devices, such as a television and a wireless device. Therefore, we agree with the Examiner that Apple teaches or suggests “the selected advertisement presented to the user on the

first client device comprises the same content as the selected advertisement presented to the user within the second computing environment.”

Accordingly, we sustain the Examiner’s rejection of claim 1, and claims 2–4, 6–23, 25–33, 35–52, and 54–63, which Appellants argue are patentable for similar reasons. *See* App. Br. 11; 37 C.F.R. § 41.37(c)(1)(iv).

*B) Claims 5, 24, 34, and 53*

Dependent claim 5 recites “determining physical proximity of the first client device to the second client device.” App. Br. 15 (Claims App’x). Dependent claims 24, 34, and 53 recite commensurate limitations. *Id.* at 18, 20, 24.

The Examiner finds “Apple was . . . cited to teach the first and second devices being client devices and Vasudevan was cited to teach determining proximity of one device to the other device. Therefore, the combination of the references teaches proximity of the first client device to the second client device.” Ans. 6.

We agree with Appellants, however, that the Examiner has not explained why it would have been obvious or beneficial to determine physical proximity of two client devices rather than the proximity of a client to a vendor. Reply Br. 14–15. As the Supreme Court has held, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Instead, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* The Examiner has not provided such a reason here.

Accordingly, we do not sustain the Examiner's rejection of claim 5, and also of claims 24, 34, and 53 under 35 U.S.C. § 103(a).

§ 101

The Examiner concludes claim 1 is “directed to the abstract idea of presenting the same advertisement content to the same user via a first and second computing environment.” Ans. 2.

The first step in a § 101 analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts” of “laws of nature, natural phenomena, and abstract ideas.” *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). “The inquiry often is whether the claims are directed to ‘a specific means or method’ for improving technology or whether they are simply directed to an abstract end-result.” *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1326 (Fed. Cir. 2017). “The Supreme Court has recognized that all inventions embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas. But not all claims are *directed to* an abstract idea.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241 (Fed. Cir. 2016) (quotation omitted).

Here, we are not persuaded that the claims are directed to an abstract idea. Rather, sending the same advertising content to two different devices is the specific technical means or method for improving the abstract idea of advertising. Whether the claim scope is broad and the claims are obvious under § 103 is a separate inquiry from whether the claims are directed to ineligible subject matter under § 101. *See Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject

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matter of a claim falls within the § 101 categories of possibly patentable subject matter.”).

Accordingly, we do not sustain the Examiner’s rejection of claims 1–63 under § 101.

#### DECISION

For the reasons above, we affirm the Examiner’s decision rejecting claims 1–4, 6–23, 25–33, 35–52, and 54–63 under § 103.

We reverse the Examiner’s decision rejecting claims 5, 24, 34, and 53 under § 103 and claims 1–63 under § 101.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED-IN-PART