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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MITCH GREEN

Appeal 2016-003834¹
Application 12/645,662²
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, 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 1–16 and 21–23. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellant’s Appeal Brief (“App. Br.,” filed Aug. 6, 2015) and Reply Brief (“Reply Br.,” filed Feb. 29, 2016), and the Examiner’s Answer (“Ans.,” mailed Dec. 30, 2015), and Final Office Action (“Final Act.,” mailed Dec. 29, 2014).

² Appellant identifies Adobe Systems Incorporated as the real party in interest. App. Br. 1.

CLAIMED INVENTION

Appellant's claimed invention "relates generally to computer software that runs, displays, provides, or otherwise uses electronic content."

Spec. ¶ 1.

Claims 1, 13, and 23 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer-implemented method comprising:
 - receiving, by a processor of a first device, a request to transfer a first application from the first device to a second device, the first application including machine-readable code that, when read by a web browser, causes the first application to be displayed;
 - in response to the request, determining an advertisement for use on the second device while transferring the first application to the second device, wherein the advertisement is determined by comparing category or keyword information associated with the first application with category or keyword information associated with the advertisement; and
 - transferring, by the processor of the first device, the first application from the first device to the second device, wherein, while transferring the first application from the first device to the second device, the advertisement is presented at the second device.

REJECTIONS³

Claims 1–16 and 21–23 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1–16 and 21–23 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

³ The Examiner has withdrawn the rejection under 35 U.S.C. § 112, second paragraph. Ans. 2.

Claims 1–16 and 21–23 are rejected under 35 U.S.C. § 103(a) as unpatentable over Barsade et al. (US 2002/0169670 A1, pub. Nov. 14, 2002) and Hoyle (US 6,771,290 B1, iss. Aug. 3, 2004).

ANALYSIS

Written Description

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact and is assessed on a case-by-case basis. *See, e.g., Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000) (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991)). The disclosure, as originally filed, need not literally describe the claimed subject matter (i.e., using the same terms or *in haec verba*) in order to satisfy the written description requirement. But the Specification must convey with reasonable clarity to those skilled in the art that, as of the filing date, Appellant was in possession of the claimed invention. *See id.*

We are persuaded by Appellant’s argument that the Examiner erred in rejecting claims 1–16 and 21–23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (App. Br. 7–9). The Examiner maintains that the Specification lacks written description support for the phrase “the first application including machine-readable code that, when read by a web browser, causes the first application to be displayed,” as recited in independent claims 1, 13, and 23. Ans. 2–3. In particular, the Examiner finds that the Specification “do[es] not explain how the machine-readable code is read by the browser.” Final Act. 3. The Examiner finds that if Appellant intended to limit a machine readable code

to HTML code or a keyword, the Appellant should recite an HTML code or keyword instead. Ans. 4. In the Answer, the Examiner interprets “a machine-readable code” as a barcode or QR code, and then finds that the Specification provides inadequate support for a barcode or QR code. *Id.*

However, we agree with Appellant that a person of ordinary skill in the art would understand from the Specification, particularly including paragraphs 2, 5, 11, 25, and 27, that Appellant was in possession of the claimed invention at the time the application was filed. App. Br. 8–9. Paragraph 25, for example, describes embedding HTML embed code for a host application into a first user’s web page such that then the first user’s page is loaded by a web browser, the host application is part of the content displayed on the first user’s page. The host application can then be executed. Spec. ¶ 25. In our view, one of ordinary skill in the art would understand that Appellant had possession of a first application including machine-readable code, such as HTML embed code for a first code, that when read by a web browser causes the first application to be displayed.

In view of the foregoing, we do not sustain the Examiner’s rejection of claims 1–16 and 21–23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Non-Statutory Subject Matter

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) (internal citation and quotations omitted).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (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.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, 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*, 566 U.S. at 79, 78).

“The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257–58 (Fed. Cir. 2016) (internal citations omitted). In cases involving software innovations, this inquiry often turns on whether the claims focus on “the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016).

Here, exemplary claim 1 recites a method that results in an advertisement being presented. The method performs the steps of receiving a request to transfer a first application from a first device to a second device, determining an advertisement for use on a second device while transferring the first application, and transferring the first application while presenting the advertisement at the second device. According to the Specification, “applications,” such as widgets and other small applications, are “offered in a bundle with a utility or entertainment application such that a user downloading the utility or entertainment application receives [an] advertisement application as well.” Spec. ¶ 2. Different distribution models may bundle applications and advertising, causing applications from competitors to be inadvertently bundled together to the disappointment of both businesses. *Id.* ¶ 3. Business entities have an interest in their applications not being paired with a competitor’s application or other objectionable or undesirable content. *Id.*

To prevent undesirable bundling, the claimed invention associates an application with a restriction that prevents it from being offered, bundled, or used with other applications associated with a certain category or keyword. *Id.* ¶ 4. Competitors can use such techniques to prevent undesirable cross promotion, bundling, and sharing of applications. *Id.* When a request to share an application is received, an advertisement is determined by comparing information associated with an application with information associated with an advertisement. *Id.* ¶ 5. Specifically, the method compares a keyword or category associated with an application with inclusion or exclusion lists associated with advertisements. *Id.* In other words, the claims focus on solving a problem perceived by a business related

to an objectionable bundling of the business's application with undesired or objectionable content, such as a competitor's advertisement. The claimed advance relies on category or keyword information associated with the application and advertisement to solve this problem.

The claim language, in light of the Specification, thus supports the Examiner's determination that the claims are directed to the abstract idea of "targeted advertising," which is a fundamental economic practice. Ans. 9; Final Act. 4 (determining that the claims are directed to "presenting [an] advertisement while transferring the first application"); *see also* App. Br. 28 (the claims recite "a specific way of determining and presenting an advertisement in a specific context"). In addition, we agree with the Examiner that the claimed method is not meaningfully distinct from claims involving the collection, organization, manipulation, and display of data that have been deemed patent-ineligible by the Federal Circuit. *See* Ans. 9 (citing numerous cases).

For example, in *Electric Power Group*, the Federal Circuit held that claims focused "on collecting information, analyzing it, and displaying certain results of the collection and analysis" are directed to an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). Stating that "[i]nformation as such is an intangible," the Federal Circuit in *Electric Power Group* noted that the Federal Circuit has "treated collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas." *Id.* (internal citations omitted). The Federal Circuit pointed out that "[i]n a similar vein, . . . [it has] treated analyzing information by steps people go through in their minds, or by mathematical algorithms, without

more, as essentially mental processes within the abstract-idea category.” *Id.* at 1354.

Similarly, in *Intellectual Ventures I LLC v. Erie Indemnity*, 850 F.3d 1315, 1328 (Fed. Cir. 2017), the Federal Circuit held that creating and using an index to search for and retrieve data is an abstract idea. In that case, the court determined that

organizing and accessing records through the creation of an index-searchable database, includes longstanding conduct that existed well before the advent of computers and the Internet. For example, a hardcopy-based classification system (such as library-indexing system) employs a similar concept There, classifiers organize and cross-reference information and resources (such as books, magazines, or the like) by certain identifiable tags, e.g., title, author, subject. Here, tags are similarly used to identify, organize, and locate the desired resource.

Id. at 1327. The court further determined that the claims were not “focused on *how* usage of the [] tags alters the database in a way that leads to an improvement in the technology of computer databases, as in *Enfish*,” but instead focuses “at a high level on searching a database using an index.” *Id.* at 1328.

Much like the situation in *Electric Power* and *Intellectual Ventures*, the advance Appellant’s claims “purport to make is a process of gathering and analyzing information of a specified content, then . . . [transmitting] the results, and not any particular assertedly inventive technology,” i.e., an abstract idea. *Elec. Power Grp.*, 830 F.3d at 1354. Like the use of tags at issue in *Intellectual Ventures*, Appellant’s claims focus at a high-level on the use of keywords or categories to identify an advertisement to bundle with the

advertisement, and do not focus on any particular technical implementation that improves technology.

At step two, we “must determine whether the claims do significantly more than simply describe [the] abstract method” and, thus, transform the abstract idea into patent eligible subject matter. *Ultramarcial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). We look to see whether there are “additional features” in the claims that constitute an “inventive concept,” rendering the claim eligible for patenting even if they are directed to an abstract idea. *Alice*, 134 S. Ct. at 2357. Those “additional features” must be more than “well-understood, routine, conventional activity.” *Mayo*, 566 U.S. at 77, 79.

Appellant repeats the steps for receiving, determining, and comparing, as recited in the steps of claim 1, and summarily asserts that these features are directed to significantly more than applying the abstract idea of presenting an advertisement while transferring an application. *See* App. Br. 27–28. Yet, each of these steps is a well-understood, routine operation for processing information that itself is an abstract idea. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (claims held to be directed to an abstract idea where “[t]he advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions”).

The claims additionally recite that the first application includes machine-readable code that, when read by a web browser, causes the first application to be displayed. Yet, the claim language does not provide any specific showing of what is inventive about this limitation or the technology

used to achieve it. *See Secured Mail Sols. LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 912 (Fed. Cir. 2017) (holding “claim language [that] does not provide any specific showing of what is inventive about the [limitations in question] or about the technology used to generate and process it” does not satisfy *Alice*’s second step.) Similarly, the Specification (*see, e.g.*, Spec. ¶¶ 25–27) does not explain what is innovative about this feature, or provide any implementation details for how it is achieved, suggesting that the feature utilizes only existing technologies. *See Move, Inc. v. Real Estate Alliance Ltd.*, 2017-1463, 2018 WL 656377, at *4 (Fed. Cir. Feb. 1, 2018) (“the failure to provide any implementation details for the zoom features suggests that the zoom feature utilizes only existing technologies”). Stated another way, we are not persuaded that including machine readable code in the application that causes the first application to be displayed when read by a web browser is other than routine, additional activity, which is insufficient under step two. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014) (“routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet” are insufficient to render patent eligibility).

The claims also additionally recite generic computer components, such as a “processor” and “device,” but employing generic computer components fails to transform the abstract idea into a patent-eligible application. *Alice*, 134 S. Ct. at 2357; *see also* Spec. ¶¶ 21–23 (describing well-known processors, devices, and storage medium employed by the claimed invention to implement the abstract idea). Here, we are not persuaded that the Examiner erred in determining that the additional elements, considered individually and as a combination, relate to more than

an implementation of the abstract idea in a particular technological environment. *See* Ans. 8–9.

We are not persuaded by Appellant’s argument regarding preemption. App. Br. 28. Although 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,” *see Alice Corp.*, 134 S. Ct. at 2354, 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). Although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

Appellant argues that the claims are like those in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), because they recite “a specific way of determining and presenting an advertisement in a specific context, during a download of an application.” App. Br. 28. Appellant further argues that the claims are similar because the claims do not “rely[] on normal, expected manners of presenting an advertisement that are shown in the references cited in the claim rejections.” *Id.* at 29.

However, we do not find any parallel between the pending claims and those in *DDR Holdings*. The claims at issue in *DDR Holdings* changed the routine, conventional functioning of Internet hyperlink protocol to direct a user of a host website to a “store within a store” on the host website, rather

than to an advertiser's third-party website, when the user clicks an advertisement. *DDR Holdings*, 773 F.3d at 1257–58. The court determined that the invention was “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” and that the claimed invention did not simply use computers to serve a conventional business purpose. *Id.*

In contrast, Appellant's claimed invention solves a problem of ensuring that advertisements bundled with a business's application are not objectionable to the business, such as excluding competitor advertisements from the bundling.. This problem is a business problem, not a technical problem. The claims recite a specific way and specific context for determining and presenting the advertisement — namely, the advertisement is determined by comparing keyword information and is presented during transfer of the application. Yet, while these steps limit the scope of the abstract idea, the limitations are not sufficient to transform Appellant's otherwise patent-ineligible abstract idea into patent-eligible subject matter. *See Alice Corp.*, 134 S. Ct. at 2358 (“we rejected the argument [in *Parker v. Flook*, 437 U.S. 584, 594–95 (1978)] that ‘implement[ing] a principle in some specific fashion’ will ‘automatically fal[l] within the patentable subject matter of § 101”); *id.* (“limiting the use of an abstract idea “‘to a particular technological environment’” is not enough for patent eligibility) (citing *Bilski v. Kappos*, 561 U.S. 593, 609–611 (2010)); *see also Ultramercial*, 772 F.3d at 714 (rejecting the argument that claims “directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before” were patent-eligible).

We are not persuaded by Appellant’s argument that because the “references cited in the rejection of claim 1 do not actually disclose the recitations of claim 1,” the claim elements or combination of elements “cannot be well-understood, routine, or conventional in any computer implementation.” App. Br. 29. A finding of novelty or non-obviousness does not automatically lead to the conclusion that claimed subject matter is patent-eligible. Although the second step in the *Mayo/Alice* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “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 Corp.*, 134 S. Ct. at 2355 (citation omitted). A novel and non-obvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 566 U.S. at 90.

We are not persuaded, for the reasons set forth above, that the Examiner erred in rejecting claims 1–16 and 21–23 under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection.

Obviousness

We are persuaded by Appellants’ argument that the Examiner erred in rejecting independent claims 1, 13, and 23 under 35 U.S.C. § 103(a) at least because none of the cited references, individually or in combination, discloses or suggests “in response to the request, determining an advertisement for use on the second device while transferring the first application to the second device, wherein the advertisement is determined by comparing category or keyword information associated with the first

application with category or keyword information associated with the advertisement,” as recited in claim 1, and similarly recited in claims 13 and 23. App. Br. 11–16. The Examiner acknowledges that Barsade does not teach this limitation, and relies on Hoyle to cure the deficiency. Final Act. 6–7 (citing Hoyle, col. 6, ll. 1–21); see also Ans. 4 (citing Hoyle, col. 5, ll. 13–40, 43; col. 6, ll. 1–21; col. 10, ll. 35–55). However, we find nothing in the cited portions of Hoyle that discloses or suggests the argued limitation.

Hoyle relates to user interfaces that provide advertising over the Internet. Hoyle, col. 1, ll. 14–18. Hoyle describes providing a user of a computer with an “automatically-upgradeable software application.” *Id.* at col. 5, ll. 62–65. In particular, a program is separated into a plurality of program modules, and some or all of the program modules have at least one version identifier associated with them. *Id.* at col. 5, l. 65–col. 6, l. 3. A version identifier of the program modules is operable upon execution to access the stored version identifiers and at least one updated version identifier from a server via a network, including a global public network such as the Internet. *Id.* at col. 6, ll. 3–7. The updated version identifiers “represent updated program modules accessible from a server via the network.” *Id.* at col. 6, ll. 7–9. The program module is further operable to download one or more updated program modules when the stored version identifier and the updated version identifier are different, with the updated program modules replacing one or more of the program modules. *Id.* at col. 6, ll. 9–13. In this way, software upgrades can be carried out automatically without any user action required. *Id.* at col. 6, ll. 13–15.

Hoyle describes that a GUI module generates an application window that is separated into a first region having a number of user-selectable items or links, and a second region or banner region for advertisements. *Id.* at col. 10, ll. 35–40; col. 5, ll. 13–26. At least some of the user selectable items are associated with a different data set, and each data sets is representative of another category of information (e.g., finance, sports, and news). *Id.* at col. 5, ll. 13–21. A first program module provides a user with information associated with links selected by links, and also notifies a second module, i.e., an ADM module, regarding the user’s selection. *Id.* at col. 5, ll. 28–32. The ADM module stores statistical data regarding the user’s selections of information, software applications, and other network accessible files, and permits targeted banner advertisements based upon the selections. *Id.* at 5, col. 35–42. In particular, upon determining new advertising is needed, the ADM module downloads new banners from the ADM server, and sends the ADM server computer usage information used in profiling the end user. *Id.* at col. 10, ll. 45–52.

The Examiner finds that Hoyle’s version identifier teaches the claimed “category” and “keyword.” *See* Final Act. 7 (“*version identifier (category or keyword)*”); *see also* Ans. 5 (“*version identifier (category or keyword)*”). We disagree. Appellant’s Specification defines the term “category” to mean “a topic, subject, or description that an application (hosting, advertisement, or other) is associated with that can be selected as defining or describing the content of an application.” Spec. ¶ 16. Exemplary categories include health and fitness, music and radio, science and nature, sports and recreation, travel, movies and radio, home and garden, gaming, education, hobbies and interests, etc. *Id.* Additionally, the

Specification defines the term “keyword” to mean “a word or phrase that is generally received as input from a user describing the content of an application.” *Id.* ¶ 17. Exemplary keywords for a baseball game application include “baseball” and “game.” *Id.* Hoyle’s version identifier, on the other hand, “represent[s] [whether] updated program modules are accessible from a server” (Hoyle, col. 6, ll. 7–9). In our view, one of ordinary skill would understand, in light of the Specification, that the terms “category” and “keyword,” as recited in claim 1, and similarly recited in claims 13 and 23, are not met by a version identifier, as taught by Hoyle. *See App. Br. 13.*

Additionally, even if Hoyle’s version identifier taught the claimed category or keyword, Hoyle does not teach or suggest: (1) determining an advertisement by comparing the version identifier of the application to a version identifier of the advertisement, (2) making the determination in response to a request to transfer a first application, or (3) while transferring the first application, as required by claims 1, 13, and 23. Instead of being based on a version identifier associated with the application, Hoyle’s advertisement is selected based on accumulated data regarding a user’s interaction with user-selectable data. Moreover, the advertisements are determined when the ADM module determines an update is needed, not in response to a request to transfer an application and while transferring the application.

In view of the foregoing, we do not sustain the Examiner’s rejection of independent claims 1, 13, and 23, and their dependents under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claims 1–16 and 21–23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is reversed.

The Examiner's rejection of claims 1–16 and 21–23 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejections of claims 1–16 and 21–23 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