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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOREY RAMER, ADAM SOROCA,
DENNIS DOUGHTY and NEAL J. KARASIC

Appeal 2016-004156
Application 13/459,179¹
Technology Center 3691

Before MURRIEL E. CRAWFORD, KENNETH G. SCHOPFER, and
TARA L. HUTCHINGS, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1–5 and 7–12. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

¹Real party in interest Millennial Media, Inc.

BACKGROUND

Appellants' invention is directed to a method and system for facilitating the selection of appropriate advertisements to be delivered to mobile communication facilities. Spec. 1

Claim 1 is illustrative:

1. A system for targeting advertising content of a first and second sponsor to a first and second mobile communication facility, the system comprising one or more computers having computer readable mediums having stored thereon instructions which, when executed by one or more processors of the one or more computers, causes the system to perform the steps of:

(a) receiving a first and second request for advertising content, wherein the first request is associated with a first user and the first mobile communication facility and the second request is associated with a second user and the second mobile communication facility, wherein a rendering capability of the first type of mobile communication facility is different from a rendering capability of the second type of mobile communication facility, wherein the rendering capability comprises a model of the respective mobile communication facility;

(b) retrieving data from a provider pertaining to the first and second users, wherein the data is at least one of:

- (i) credit card data;
- (ii) reward card data;
- (iii) mail order catalog data;
- (iv) survey data;
- (v) search query data;
- (vi) supermarket or pharmacy purchase data; and
- (vii) settop box television viewing data;

(c) selecting first and second items of advertising content from each of the first sponsor and the second sponsor based at least on a determination of relevancy of each advertising content to the data, wherein the relevancy determination generates respective relevancy scores, wherein the first items of advertising content require the rendering capability of the first type of mobile communication facility to be rendered thereon and the second items of advertising content require the rendering capability of the second type of mobile communication facility to be rendered thereon, wherein the first items of advertising content are incompatible with the second type of mobile communication facility and the second items of advertising content are incompatible with the first type of mobile communication facility;

(d) determining that the first item of advertising content of the first sponsor and the second item of advertising content of the second sponsor are more relevant to the first user than the second user based on the respective relevancy scores and determining that the first item of advertising content of the second sponsor and the second item of advertising content of the first sponsor are more relevant to the second user than the first user based on the respective relevancy scores; and

(e) transmitting the first item of advertising content of the first sponsor instead of the second item of advertising content of the second sponsor to the first mobile communication facility for display thereon and transmitting the second item of advertising content of the first sponsor instead of the first item of advertising content of the second sponsor to the second mobile communication facility for display thereon.

Appellants appeal the following rejection:

Claims 1–5 and 7–12 are rejected under 35 U.S.C. §101.

PRINCIPLES OF LAW

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 implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter.”); *Parker v. Flook*, 437 U.S. 584, 594–595 (1978)

(“Respondent’s application simply provides a new and presumably better method for calculating alarm limit values.”); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.”).

The patent-ineligible end of the spectrum includes fundamental economic practices, *Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611; mathematical formulas, *Parker*, 437 U.S. at 594–95; and basic tools of scientific and technological work, *Gottschalk*, 409 U.S. at 69. On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber, *Diamond*, 450 U.S. at 184 n.7, “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour, *Gottschalk*, 409 U.S. at 69.

If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an “inventive concept”—an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.*

Claims involving only data collection, analysis, and display are directed to an abstract idea. *Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent ineligible concept”); *see also In re TLI Comma ‘ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093-94 (Fed. Cir.

2016). Claims that use generic computer technology to perform data collection, analysis, and display and that do not recite an improvement to a particular computer technology are patent ineligible. *See, e.g., McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314-15 (Fed. Cir. 2016) (finding claims not abstract because they “focused on a specific asserted improvement in computer animation”).

ANALYSIS

Rejection under 35 U.S.C. §101

The Examiner holds that the claims are directed to the abstract idea of targeting advertising content which is a fundamental economic practice.

Final Act. 4. The Examiner finds that the additional elements other than the abstract idea are no more than mere instructions to implement the idea on a computer and/or are recitations of generic computer structure that serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry.

We are not persuaded of error on the part of the Examiner by Appellants arguments that the claims are directed to a processor and memory which are structural elements. Specifically, Appellants argue, relying on *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014), that the claims relate to an issue that did not exist in the pre-Internet world and that the claimed solution is rooted in computer technology in that the ad server and the data provider operate in a networked environment. App. Brief 5-6. Appellants contend that the claim addresses a business

challenge of effective targeting of advertisement to users of mobile devices that is particular to the Internet. App. Brief 5.

We are not persuaded by Appellants' argument that the claim is analogous to the claims in *DDR*, where the court noted that a claim may amount to more than any abstract idea recited in the claims when it addresses a business challenge, such as "retaining website visitors," where that challenge is particular to a specific technological environment, such as the Internet. *DDR Holdings*, 773 F.3d at 1257. In *DDR*, the court stated that "the [] patent's claims address the problem of retaining website visitors that, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be instantly transported away from a host's website after 'clicking' on an advertisement and activating a hyperlink." *Id.* This was done in the claim by serving a composite page with content based on the link that was activated to serve the page.

In contrast, claim 1, according to the Specification at pages 5–6, seeks to solve problems related to facilitating the selection of advertisements through an ad exchange by associating advertisement requests with a user, user profile or other mobile communication type information which are not computer technology problems but business problems. That this problem may be assisted by the use of a computer, or may be a network-centric solution, is not pertinent to determining whether the claim itself provides a technical solution to a computer technology problem. *See DDR Holdings*, 773 F.3d at 1258 ("not all claims purporting to address Internet-centric challenges are eligible for patent") (citation omitted); *see also id.* at 1259 (determining that the claims do not merely apply the abstract idea "to the particular technological environment of the Internet"). We note that claim 1 does not

recite an improvement to the computer. In fact, Appellants' Specification teaches at paragraph 391 that the processes, and steps of the invention, may be realized in hardware, software, or any combination of these suitable for a particular application and that the hardware may include a general purpose computer and/or dedicated computing device.

In view of the foregoing, we will sustain the Examiner's rejection as to claim 1. We also sustain the rejection as it is directed to the remaining claims because the Appellants have not argued the separate eligibility of these claims.

DECISION

The decision of the Examiner is affirmed.

TIME PERIOD

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. § 1.136(a)(1) (2009).

ORDER

AFFIRMED