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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID H. TANNENBAUM

Appeal 2016-004356¹
Application 13/272,853²
Technology Center 3600

Before NINA L. MEDLOCK, AMEE A. SHAH, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Our Decision references Appellant’s Specification (“Spec.,” filed Oct. 13, 2011), Appeal Brief (“Appeal Br.,” filed Sept. 11, 2015), and Reply Brief (“Reply Br.,” filed Mar. 21, 2016), the Examiner’s Final Office Action (“Final Act.,” mailed Feb. 12, 2015) and Answer (“Ans.,” mailed Jan. 22, 2016), and the transcript of the oral hearing held on September 19, 2017 (“Tr.”).

² Appellant identifies Fantod Audio Limited Liability Company, “which is affiliated with Intellectual Ventures Management LLC,” as the real party in interest. Appeal Br. 1.

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134, Appellant appeals from the Examiner's decision to reject claims 19–22 and 29–40. We have jurisdiction under § 6(b). We AFFIRM.

SUBJECT MATTER ON APPEAL

The invention “relates to the delivery of merchandise from a merchandise provider to a merchandise seeker and more particularly to a system and method for allowing a merchandise provider to identify merchandise seekers.” Spec. ¶ 2. Claims 19, 29, and 34 are the independent claims on appeal. Claim 19, reproduced below, is illustrative of the claimed subject matter:

19. A method of providing to a user information pertaining to merchandise available at geographically diverse locations, said method comprising:

initiating, by a system, access to a device under control of said user to determine if an identity associated with the system is stored at the device, said system being associated with a plurality of geographically diverse locations;

determining a current location of said device under control of said user; and

if the identity is stored at the device, accessing, by the system, merchandise information based on a location associated with both the system and said current location of said device under control of said user.

REFERENCES

The Examiner relies on the following prior art in rejecting the claims on appeal:

Souissi et al. (“Souissi”) US 6,091,959 July 18, 2000

Appeal 2016-004356
Application 13/272,853

Calvert	US 6,526,275 B1	Feb. 25, 2003
Dahod et al. (“Dahod”)	US 6,574,608 B1	June 3, 2003
Richton	US 6,650,902 B1	Nov. 18, 2003

“Gnutella1–14,” Information Disclosure Statement by Applicant dated Oct. 13, 2011 and “Gnutella15–19,” Information Disclosure Statement by Applicant dated Dec. 12, 2011 (collectively “Gnutella”).

REJECTIONS

The Examiner rejects the claims on appeal as follows:

claims 19–22 and 29–40 under 35 U.S.C. § 101 as non-statutory subject matter;

claims 19–21, 29–31, 34–36, 39, and 40 under § 103(a) as unpatentable over Calvert, Gnutella, and Dahod;

claim 22 under § 103(a) as unpatentable over Calvert, Gnutella, Dahod, and Souissi;

claims 32 and 37 under § 103(a) as unpatentable over Calvert, Gnutella, Dahod, and Official Notice; and

claims 33 and 38 under § 103(a) as unpatentable over Calvert, Gnutella, Dahod, and Richton.

ANALYSIS

Non-Statutory Subject Matter

In rejecting the claims under 35 U.S.C. § 101, the Examiner applies the two-step framework set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289, 1296–97 (2012) and reiterated in *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347, 2355 (2014), which considers, in the first step, whether the claims are

directed to a patent-ineligible concept, e.g., an abstract idea, and, if so, considers, in the second step, whether the claims, individually and as an ordered combination, recite an inventive concept—an element or combination of elements sufficient to ensure the claims amount to significantly more than the abstract idea and transform the nature of the claims into a patent-eligible concept. More specifically, under the first step of the analysis, the Examiner finds the claims are directed to “providing advertisements based on a location of the device,” which is both a method of organizing human activity and an idea of itself, and, therefore, an abstract idea. Ans. 3. Under the second step, the Examiner finds the claims do not recite additional limitations amounting to significantly more than the abstract idea because the claims amount to a mere instruction to apply the abstract idea using some unspecified, generic computer. *Id.* at 7.

As an initial matter, we are unpersuaded of error by Appellant’s argument that the claims do not preempt all applications involving a location of a consumer. Appeal Br. 11–13. Although preemption may be the concern driving the exclusion of abstract ideas from patent-eligible subject matter, preemption is not the test for 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*, 134 S. Ct. at 2354).

Turning to the two-step analysis for patent-eligibility under § 101, Appellant argues the Examiner’s characterization of the claims pursuant to the first step is disconnected from the claim language because the claims

require a location of a device. Appeal Br. 6–8; Reply Br. 1. Appellant’s argument is not persuasive of error because the Examiner characterizes the claims as “providing advertisements based on a location of the device,” which takes into account the location of the device. Ans. 3.

Appellant similarly argues that determining a location of a device is not an abstract idea. Appeal Br. 8; Reply Br. 1–2. We disagree.

As the Examiner explains in the Final Office Action, the concept of delivering targeted location-based information is an abstract idea. Final Act. 3. Indeed, the Federal Circuit has held that tailoring content based on a user’s location is an abstract idea. *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369 (Fed. Cir. 2015). The issue here is whether providing information based on a location of a device, as opposed to a location of a user, falls outside the realm of abstract ideas. We find it does not. Our reviewing court has held concepts involving devices to be abstract ideas. For example, in *Affinity Labs of Texas, LLC v. Amazon.com, Inc.*, the Federal Circuit determined that the concept of delivering user-selected media content to portable devices is an abstract idea. 838 F.3d 1266, 1269 (Fed. Cir. 2016). In doing so, the court explained that the claims are directed to the use of conventional or generic technology without any indication that the invention reflects an inventive solution to a problem associated with the technology. *Id.*

Like the claims in *Affinity Labs*, there is no indication that the claimed device is something other than a generic computer component. For example, Appellant’s Specification describes PC 21 as “any type of processor and/or memory, including a telephone, pager, portable computer, personal assistants, and the like.” Spec. ¶ 36. The present claims also do not address

a problem associated with the device. Accordingly, Appellant does not apprise us of error in the Examiner's finding that "providing advertisements based on a location of the device" is an abstract idea.

After considering Appellant's arguments pursuant to the first step of the patent-eligibility analysis, we are not persuaded that the Examiner erred in finding the claims are directed to the abstract idea. Accordingly, we turn to Appellant's arguments under the second step.

Appellant argues the claims amount to significantly more than the abstract idea because determining a location of a device is not generic data processing. Appeal Br. 9–10; Reply Br. 2–3. We find this argument unpersuasive under the second step for essentially the same reasons we find it unpersuasive under the first step. Namely, the Specification describes that the device is a conventional or generic component, and the claims do not describe how a location of a device is determined. As such, we fail to see how determining a location of a device requires something other than generic data processing, which does not amount to significantly more than the abstract idea.

Appellant additionally argues the claimed functions are not routine and conventional computer functions because they are novel and nonobvious. Appeal Br. 10. Appellant's argument is not persuasive.

Notwithstanding that "the § 101 patent-eligibility inquiry and, say, the § 102 novelty inquiry might sometimes overlap' . . . a claim for a *new* abstract idea is still an abstract idea." *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (quoting *Mayo*, 132 S. Ct. at 1304). The question in the second step of the patent-eligibility analysis is not whether an additional feature is novel, but whether the implementation of the abstract

idea involves “more than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1347–48 (quoting *Alice*, 134 S. Ct. at 2359).

Here, we fail to see how the implementation of the abstract idea requires something apart from generic computing components performing well-understood, routine, and conventional computer functions. For example, as set forth above, the claims do not describe how a location of a device is determined, nor do the claims address a problem associated with the device. Consequently, Appellant does not apprise us of error in the Examiner’s finding that the claims recite something apart from the generic computer implementation of the abstract idea. Ans. 6.

Appellant further contends that the claims are patent-eligible because, like the claims in *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), the present claims improve a computer system. Tr. 7–8. According to Appellant, by having the identity associated with the system stored at the device and having the system access the device, the claimed invention enables a user to receive local information without having to send a request for the information and without being spammed. *Id.* at 7–10. Appellant’s argument is unpersuasive.

In *BASCOM*, the Federal Circuit held “[t]he inventive concept described and claimed in the ’606 patent is the installation of a filtering tool at a specific location, remote from end-users, with customizable filtering features specific to each end user.” 827 F.3d at 1350. In determining this feature to be an inventive concept, the Federal Circuit explained that the remote location of a filtering tool having customizable user-specific filtering

features provides the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server. *Id.* The Federal Circuit further explained that the “claims do not merely recite the abstract idea of filtering content along with the requirement to perform it on the Internet or on generic computer components,” but instead the claims are “a technical improvement over prior art ways of filtering [Internet] content.” *Id.* Notably, the Federal Circuit specifically determined that “the claims may be read to ‘improve[] an existing technological process.’” *Id.* at 1351 (citing *Alice*, 134 S. Ct. at 2358).

In contrast to the claims in *BASCOM*, the present claims are an improvement to the abstract idea of “providing advertisements based on a location of the device,” not an improvement to the technological implementation of the abstract idea. As set forth above, Appellant explains that the claimed invention enables a user to receive local information without having to send a request for the information and without being spammed. Tr. 7–10. Receiving unsolicited offers and limiting unwanted offers are not technical issues, nor do they arise exclusively upon the computer implementation of the abstract idea of “providing advertisements based on a location of the device.” For example, receptionists are routinely used to screen solicitations. Given that the claims do not recite an improvement to the technological implementation of the abstract idea, Appellant’s reliance on *BASCOM* does not apprise us of error in the Examiner’s finding that the claims do not recite additional limitations amounting, individually or as an ordered combination, to significantly more than the abstract idea.

In view of the foregoing, Appellant does not apprise us of error in the Examiner's determination that the claims are directed to non-statutory subject matter. We, therefore, sustain the rejection of claims 19–22 and 29–40 under 35 U.S.C. § 101.

Obviousness

Appellant has persuaded us that the prior art does not teach an “identity associated with the system,” as recited in independent claim 19. Appeal Br. 14–17; Reply Br. 3–4.

Independent claim 19 recites “initiating, by a system, access to a device under control of said user to determine if an identity associated with the system is stored at the device.” Independent claim 19 thus requires that the “identity associated with the system” is the identity associated with the system that is initiating access to a user's device.

Here, the Examiner relies on Calvert's teaching of information related to a communication device user's favorite fast food restaurant for disclosing an “identity associated with the system.” Ans. 13. Calvert discloses a communication system that, either periodically on its own or responsive to a request for a particular product from a communication device, determines an approximate location of the communication device and whether the requested product is available in the general vicinity of the communication device. Calvert 3:17–26. As the Examiner finds, in addition to conveying a request for a particular product, Calvert discloses conveying specific information about a communication device user, including favorite fast food chains. Calvert 14:5–28. The fast food chains, however, are not part of Calvert's communication system, and the fast food chains do not initiate

access to the user's communication device. As such, we fail to see how the combined teachings of Calvert, Gnutella, and Dahod would result in the claimed "identity associated with the system."

In view of the foregoing, we do not sustain the Examiner's rejection of independent claim 19 and claims 20 and 21 depending therefrom. Each of independent claims 29 and 34 recites a similar limitation to the limitation discussed above in regard to independent claim 19, and the Examiner's rejection of independent claims 29 and 34 suffers from the same deficiency as the Examiner's rejection of independent claim 19. Accordingly, we similarly do not sustain the Examiner's rejection of independent claims 29 and 34 and claims 30, 31, 35, 36, 39, and 40 depending therefrom. The Examiner's rejections of claims 22, 32, 33, 37, and 38 also suffer from the same deficiency as the Examiner's rejection of independent claim 19, and we do not sustain the Examiner's rejections of these claims.

DECISION

The Examiner's decision to reject claims 19–22 and 29–40 under 35 U.S.C. § 101 is affirmed.

The Examiner's decision to reject claims 19–22 and 29–40 under 35 U.S.C. § 103(a) is 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). 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED