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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PERRY ROBINSON MACNEILLE, YIMIN LIU,
JULIUS MARCHWICKI, SCOTT BURNELL, EDWARD WEHRMAN,
OLEG YURIEVITCH GUSIKHIN, and BASAVARAJ TONSHAL

Appeal 2016-004411¹
Application 13/671,987²
Technology Center 3600

Before NINA L. MEDLOCK, TARA L. HUTCHINGS, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

HUTCHINGS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1–19. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Our decision references Appellants’ Specification (“Spec.,” filed Nov. 8, 2012), Appeal Brief (“App. Br.,” filed Aug. 11, 2015), Reply Brief (“Reply Br.,” filed Mar. 15, 2016), the Examiner’s Answer (“Ans.,” mailed Jan. 22, 2016) and the Final Office Action (“Final Act.,” mailed May 26, 2015).

² Appellants identify Ford Global Technologies, LLC as the real party in interest. App. Br. 2.

CLAIMED INVENTION

Appellants' claimed invention "generally relate[s] to a method and apparatus for digital coupon presentation." Spec. ¶ 1.

Claims 1, 13, and 19 are the independent claims on appeal. Claims 1 and 13, reproduced below, are illustrative of the claimed subject matter:

1. A system comprising:
 - a processor configured to:
 - receive an entertainment media element including an interactive advertisement and coupon;
 - present the interactive advertisement and coupon in a vehicle;
 - receive vehicle-occupant acquiescence to store the coupon;
 - store of the coupon; and
 - store events digitally associated with the coupon, designated as triggers for suggesting redemption of the coupon.

13. A system comprising:
 - a processor configured to:
 - receive incoming event notification from a vehicle system;
 - compare the event notification to a stored event, relating to a coupon previously presented to and stored by a vehicle occupant;
 - upon a correlation between the event notification and at least one stored event, present the stored coupon for redemption;
 - receive an indication that redemption of the stored coupon is desired; and
 - provide guidance in redeeming the stored coupon.

REJECTIONS

Claims 1–19 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 2–8.

Claims 1–12 are rejected under 35 U.S.C. § 103(a) as unpatentable by French et al. (US 6,882,290 B2, iss. Apr. 19, 2005). Final Act. 8–13.

Claims 13–19 are rejected under 35 U.S.C. § 103(a) as unpatentable over French and Treyz et al. (US 2008/0228600 A1, pub. Sept. 18, 2008). Final Act. 13–17.

ANALYSIS

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).

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.” *Id.* (quoting *Mayo*, 566 U.S. at 79, 78).

The step-one analysis calls upon us to consider “the claims in their entirety to ascertain whether their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015). The question is whether the claims as a whole “focus on a specific means or method that improves the relevant technology” or are “directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016).

Before turning to the claims individually, we note that Appellants’ Specification describes the invention as relating to digital coupon presentation. Spec. ¶ 1. In the Background section, the Specification provides that traditional forms of advertisement include a simple advertisement played over the radio in a vehicle, and a data stream delivering content from the Internet. *Id.* ¶ 2. And the inventors have recognized that advances in content delivery systems and user display systems provide additional resources that can be applied to achieve new and improved advertisement content delivery. *See id.*

Independent Claims 13 and 19, and Dependent Claims 14–18

Claim 19 recites a computer implemented method that performs a sequence of steps that results in providing guidance in redeeming the stored coupon. The steps include: (1) receiving an event notification from a vehicle system, (2) comparing the event notification to a stored event relating to a coupon previously presented to and stored by a vehicle occupant, (3) presenting the stored coupon for redemption upon a correlation between the event notification and stored event, (4) receiving and indication that redemption of the stored coupon is desired, and (5) providing guidance

in redeeming the stored coupon. Claim 13 recites similar language but in the format of a “system” comprising a “processor” for performing the steps.

In rejecting claim 19 under 35 U.S.C. § 101, the Examiner first determines that claim 19 is directed to an abstract method of organizing human activities. In particular, the Examiner determines:

[t]he claimed invention is directed to the methods of organizing the human activities of receiving an event notification, comparing the event notification to stored events related to stored coupons, presenting the correlated stored coupons for redemption, receiving an indication that the coupon is desired and providing guidance in redeeming the coupon. As noted above, methods of organizing human activities are examples of abstract ideas explicitly referenced in *Alice Corp.*

Final Act. 5. In the Answer, the Examiner additionally finds the claims analogous to claims related to collecting, processing, and displaying data that the Federal Circuit has held to be patent-ineligible, and claims directed to mental steps. *See* Ans. 3–5. Turning to step two of the analysis, the Examiner determines that the recited steps are not enough to transform the abstract idea into a patent-eligible application, because the steps are “a mere instruction to apply the abstract idea.” *Id.* at 5–6. The Examiner finds that the additional elements alone and in combination contain “no improvement to another technology or technical field, no improvements to the functioning of the computer itself, and no meaningful limitations beyond generally linking the use of an abstract idea to a particular technical environment.” *Id.* at 6. Instead, “the claims require no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional.” *Id.*

Turning to claim 13, the Examiner determines that the same analysis should be used for claim 13 as claim 19, because the additional component,

a “processor,” “add[s] nothing of substance to the underlying abstract idea” and “[a]t best . . . merely provid[es] an environment in which to carry out the abstract idea.” *Id.*

Appellants argue that the Examiner erred by listing the limitations of the claims without identifying “an actual abstract idea embodied by the claims.” App. Br. 7. Yet, the Examiner characterized the claims as a method of organizing human activity, which is reasonably supported by claims 13 and 19.

Appellants additionally argue that the Examiner erred in determining that the claims are analogous to patent-ineligible claims that recite steps of receiving, presenting, and storing data, determination, because claims 19 and 13 “recite utilization of event notifications as the basis for presenting a stored coupon, a practice that is neither mere receiving, presenting or storing data (but rather utilizing received data as the basis for further action).” Reply Br. 2. Yet, analyzing events or other data as the basis for further action is precisely the sort of activity that the Federal Circuit has held to be abstract. *See, e.g., Accenture Global Services, GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344 (Fed. Cir. 2013) (“generating tasks [based on] rules . . . to be completed upon occurrence of an event” is an abstract idea) (quoting US 7,013,284 B2, iss. Mar. 14, 2006, col. 107, ll. 25, 38–39).

In our view, the claimed method is not meaningfully distinct from claims involving the collecting data, analyzing data, and displaying the results that have been deemed patent-ineligible by the Federal Circuit. 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. Similar to the situation in *Electric Power Group*, the advance Appellants’ 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. *Id.* The claims involve the same general steps of collecting (e.g., receiving incoming event notification, receiving an indication that redemption of the coupon is desired) and processing (e.g., comparing the event notification, presenting the stored coupon upon correlation) information, and providing the results (e.g., providing guidance).

Appellants argue that even if the claims are directed to an abstract idea, the claims are patent eligible because the claims do not tie up the abstract idea and, thus, are patent eligible under the streamlined eligibility analysis set forth in USPTO guidance. App. Br. 6–8 (citing *2014 Interim Guidance on Patent Subject Matter Eligibility*, 79 Fed. Reg. 74618, 74625); *see also* Reply Br. 2–3. However, the 2014 Interim Guidance does not go beyond case law to impose a streamlined eligibility test, as argued by

Appellants. *See* Reply Br. 3 (“unless the Examiner can prove that the claim . . . seeks to tie up a judicial exception . . . then the Examiner has not met the burden with regards to the above test”); *see also* App. Br. 7 (“the accelerated eligibility analysis still applies”). Instead, the 2014 Interim Guidance provides the streamlined analysis as an optional tool for Examiners to use at their discretion. *See 2014 Interim Guidance on Patent Subject Matter Eligibility*, 79 Fed. Reg. 74618, 74625 (Dec. 16, 2014) (“[A] streamlined eligibility analysis *can be used*.” (emphasis added)). Further, “if there is doubt as to whether the applicant is effectively seeking coverage for a judicial exception itself, *the full analysis should be conducted*.” *Id.* (emphasis added). Here, the Examiner’s decision to perform a full § 101 analysis does not constitute error.

Further, to the extent Appellants argue that the claims are patent-eligible because they do not tie up the abstract idea, that argument, too, is unpersuasive. Although the Supreme Court has described “the concern that drives [the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption,” *Alice Corp.*, 134 S. Ct. at 2354, characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption 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*, 134 S. Ct. at 2354). “[P]reemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

We are not persuaded by Appellants’ argument that the claims “improve the field of digital coupon redemption and advertising.” App. Br. 8. Appellants assert, in particular, that adding a trigger-event to the stored coupon provides a “marked improvement over the idea of storing a digital coupon and then having to remember that the coupon was stored” and enables the claimed invention to “automatically represent the saved coupon when a certain stored event . . . occurs.” Reply Br. 3. Yet, an improved abstract idea remains nonetheless abstract. Here, each of the steps in the claims are recited in terms of results-based functionality (e.g., receiving an event notification, comparing the event notification to a stored event) without any technical details on how to achieve the claimed functionality. Likewise, we do not find, and Appellants do not point us to, any description in the Specification showing that these limitations require any innovative programming or technology. Instead, these limitations are described functionally in terms of the results desired. *See, e.g.*, Spec. ¶¶ 48–49. At best, claim 19 applies the abstract idea of providing guidance in redeeming coupons to a particular technical environment involving a “vehicle system” and a “vehicle computing system.” But “the prohibition against patenting abstract ideas cannot be circumvented by attempting to limit the use of [the abstract idea] to a particular technological environment.” *Alice*, 134 S. Ct. at 2358.

Independent Claim 1, and Dependent Claims 2–12

Appellants relies on the same arguments with respect to claim 1 that are advanced with respect to claims 13 and 19. *See* App. Br. 6–8. We are not persuaded by these arguments for the reasons discussed above.

Appellants additionally suggest that the Examiner erred in determining that claim 1 is directed to the abstract idea of “receiving an event notification, comparing the event notification . . . receiving an indication that the coupon is desired and providing guidance in redeeming the coupon,” because claim 1 does not recite some of these elements. *See* App. Br. 7 (quoting Final Act. 5). Appellants’ argument is not persuasive, at least because the portion of the Final Office Action quoted by Appellants is related to the Examiner’s analysis for claims 19 and 13. *See* Final Act. 5. The Examiner separately analyzes claim 1 under 35 U.S.C. § 101 at pages 6–8 of the Final Office Action, and Appellants have not apprised us of legal error in the Examiner’s two-part analysis.

Here, claim 1 recites a “system” comprising a “processor” that is configured to: (1) receive an entertainment media element including an interactive advertisement and coupon, (2) present the interactive advertisement and coupon in a vehicle, (3) receive vehicle occupant acquiescence to store the coupon, (4) store the coupon, and (5) store events digitally assigned as triggers for suggesting redemption of the coupon. Claim 1 thus recites a sequence of steps that results in storing a coupon and events that are triggers for “suggesting redemption of the coupon.” In other words, like claims 13 and 19, claim 1 is directed to organizing human activities related to redemption of the coupon, and is akin to the types of data collection and processing claims that the Federal Circuit has held to be patent ineligible. *See* Final Act. 7. For example, as the Examiner points out, claim 1 does not recite any particular way the abstract steps (i.e., receive, present, store) are performed. *Id.* We agree with the Examiner that claim 1 generally links the use of the abstract idea to a particular technical

environment, and requires no more than generic computers and technology, which is insufficient for conferring an inventive concept under step two. *See id.* at 8 (citing Spec. ¶¶ 20–21).

We are not persuaded, for the reasons outlined above, that the Examiner erred in rejecting independent claims 1, 13, and 19, and their dependent claims, under 35 U.S.C. § 101. Therefore, we sustain the Examiner’s rejection.

Obviousness

Independent Claim 1 and Dependent Claims 2–12

We are persuaded by Appellants’ argument that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 103(a) because French does not disclose or suggest “receiv[ing] vehicle-occupant acquiescence to store the coupon,” as recited in claim 1. *See* App. Br. 8–9; *see also* Reply Br. 4. The Examiner acknowledges that French does not teach this limitation, but concludes that the limitation would have been obvious because French teaches that passengers can disable the play of advertisement messages where regulations require such functionality. *See* Final Act. 10.

French relates to displaying advertisements within a rental vehicle. French, col. 1, ll. 8–11. Customer 180, which is a company maintaining a fleet of rental vehicles, loads combined media into rental vehicles for display on a multimedia (MM) system messaging device 200. *Id.* at col. 5, ll. 33–35, 7, ll. 1–3. In cases where regulations require the capability for a passenger to prevent the display of advertisements, the IMMDS allows the dispatch system to re-enable the advertising unit of the MM system once the trip has ended. *Id.* col. 4, ll. 30–34.

It is not readily apparent, and the Examiner does not adequately explain, why one of ordinary skill in the art would modify French to require acquiescence from the vehicle-occupant in order to store the media into a rental vehicle in light of French's capability to deactivate the stored media, as needed, for particular customers. Stated differently, changing an activation status of stored media as needed for a particular rental customer, as described by French, seems more efficient, for example, than requesting acquiescence from the rental customer to store the media in the rental vehicle in the first instance, as the Examiner's modification requires.

In the Answer, the Examiner further finds that "[t]he printing of the coupon or other message related information requires the customer to acquiesce to the storing of both the user interaction and the requested data." Ans. 7 (citing French col. 10, ll. 42–58, col. 11, ll. 12–17). Yet, the coupon is already stored when the rental car customer requests to print the coupon and, thus, cannot be an acquiescence "to store" the coupon. *See* Reply Br. 4 ("*later print[ing]* the coupon in response to seeing the coupon is also not storage of the coupon").

Therefore, we do not sustain the Examiner's rejection of independent claim 1 and its dependents under 35 U.S.C. § 103(a).

Independent Claim 13 and 19 and Dependent Claims 14–18

We are not persuaded by Appellants' argument that the Examiner erred in rejecting independent claims 13 and 19 under 35 U.S.C. § 103(a) because French and Treyz do not disclose or suggest "compar[ing] the event notification to a stored event, relating to a coupon previously presented to and stored by a vehicle occupant," and "upon a correlation between the event notification and at least one stored event, present[ing] the stored

coupon for redemption,” as recited in claim 13, and similarly recited in claim 19. *See* App. Br. 9–10. The Examiner acknowledges that French does not teach a coupon previously presented to and stored by a vehicle occupant. Final Act. 14. However, the Examiner relies on Treyz to cure the deficiency. *See id.* (citing Treyz ¶¶ 52, 334, 351, 359, Fig. 56).

Treyz relates to handheld computing devices that assist users in shopping and performing wireless transaction. Treyz ¶ 2. With reference to Figure 56, Treyz describes Old Navy promoting \$10 off a minimum \$30 purchase, expiring at 1:00 p.m. *Id.* ¶ 334, Fig. 56. If the user chooses to “respond now,” the handheld computing device displays screen 602. *Id.* ¶ 335. Screen 602 charges the user \$1 to hold the \$10 coupon until 9:30 p.m. *Id.* at Fig. 57. Alternatively, instead of choosing “respond now,” the user may select “remind me later,” which provides the user with a reminder message at a later time. *Id.* ¶ 334, Fig. 56. The reminder message may include promotional material, such as a coupon. *Id.* ¶ 352.

Appellants argue that Treyz “teaches an advertisement to which a user can affirmatively respond *by making a purchase,*” not storing a coupon. App. Br. 9. Yet, Treyz describes with reference to Figure 57 that the offer is a coupon that may be stored for later use. *See* Treyz Fig. 57 (“HOLD MY \$10 COUPON”).

Appellants argue that even if the advertisement is a coupon, Treyz does not teach storing the advertisement with an event notification from a vehicle computing system, but instead ties the reminder to time. App. Br. 9–10. Yet, Appellants’ Specification describes time as an exemplary event notification associated with a coupon. *See, e.g.,* Spec. ¶¶ 46 (“[t]hese events include, but are not limited to, . . . a time-sensitive activation of a coupon

offer”), 48 (“[t]he McDonalds coupon may only be good until 11 AM that day,” and “a user may be notified that a coupon must be used or lost”). As such, we are not persuaded that the Examiner erred in finding Treyz’s coupon reminder based on the event of time meets the claimed limitation for comparing an event notification to a stored event.

Therefore, we sustain the Examiner’s rejection of independent claims 13 and 19, and dependent claims 14 and 16–18 under 35 U.S.C. § 103(a).

Claim 15

Claim 15 depends from claim 13, and further recites that the incoming event notification is received from a vehicle occupant. In the Final Office Action, the Examiner finds that French’s disclosure at column 9, lines 30–35 teaches this limitation, because French teaches that the driver of the vehicle can provide notification of a passenger entering the vehicle. *See also* Ans. 10 (explaining that “[t]he event notifications trigger stored advertisements, as described for claim 13”). However, we agree with Appellants that if French and Treyz are applied such that the claimed incoming event notification is a passenger entering the vehicle, and not time as applied with respect to the rejection of claim 13, then this application of French and Treyz fails to meet each of the limitations required by claim 15. *See App. Br. 10; see also Reply Br. 4–5.* For example, the event notification of the user entering the car is not compared to a stored event relating to a coupon previously stored, as recited in claim 13.

Therefore, we do not sustain the Examiner’s rejection of claim 15 under 35 U.S.C. § 103(a).

DECISION

The Examiner's rejection of claims 1–19 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejection of claims 13, 14, and 16–19 under 35 U.S.C. § 103(a) are affirmed.

The Examiner's rejections of claims 1–12 and 15 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