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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DENNIS L. DOUGHTY, BENJAMIN M. GORDON,
SHRIKANTH B. MYSORE, and MATTHEW A. TENGLER

Appeal 2016-005247
Application 13/691,054
Technology Center 3600

Before BIBHU R. MOHANTY, JAMES A. WORTH, and
BRUCE T. WIEDER, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 1 and 3–9 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to a system for targeted advertising to mobile and non-mobile communication facilities accessed by the same user (Spec., para. 3). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A system for identifying a same user of multiple communication devices, the system comprising one or more computers having computer readable media 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 data corresponding to a first application use-pattern from a first communication device operated by a user, wherein the first application use-pattern is an order in which applications are used at a first time of day on the first communication device;
 - (b) receiving data corresponding to a second application use-pattern from a second communication device operated by a user, wherein the second application use pattern is an order in which applications are used at a second time of day on the second communication device, wherein the first application use-pattern is the same as the second application use-pattern and the first and second time of day are substantially the same;
 - (c) determining that the user of the first communication device is the user of the second communication device based on identifying that the first application use-pattern is the same as the second application use-pattern; and
 - (d) creating a universal profile for the user containing data corresponding to the first and second communication devices, wherein the universal profile includes data that identifies the first and second communication devices as being operated by the user.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1 and 3–9 are rejected under 35 U.S.C. § 112, first paragraph, as failing to show possession of the claimed invention.

2. Claims 1 and 3–9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

3. Claims 1 and 3–9 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

4. Claims 1, 3 and 4 are rejected under 35 U.S.C. § 103(a) as unpatentable over Shockley et al. (US 5,534,855; iss. July 9, 1996) and Eisen (US 2010/0004965; pub. Jan. 7, 2010).

5. Claims 5–9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Shockley, Eisen, and Sinn et al. (US 2010/0070962 A1; pub. Mar. 18, 2010).

FINDINGS OF FACT

We have determined that the findings of fact in the Analysis section below are supported at least by a preponderance of the evidence¹.

ANALYSIS

Rejection under 35 U.S.C. § 112 first and second paragraph

The Appellants have not provided any arguments in response to these rejections and these rejections are therefore both summarily affirmed.

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of the claims under 35 U.S.C. § 101 is improper (App. Br. 4–6, Reply Br. 4–6). The Appellants argue that the claim is rooted in technology (Reply Br. 4).

In contrast, the Examiner has determined that rejection is proper (Final Rej. 3–5, Ans. 3, 4).

We agree with the Examiner. 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: “laws 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).

In judging whether claim 1 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. If so, we then consider the elements of the claim both individually and as “an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application of the abstract idea. *Id.* 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.* The Court also stated that “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* at 2358.

Here, we determine that the claim is directed to the concept of identifying a person based on their particular patterns and creating a profile of them. This is a method of organizing human activities and fundamental economic practice long prevalent in our system of commerce and an abstract idea beyond the scope of 35 U.S. C. § 101. Further, Courts have found similar claims directed to collecting, recognizing, and storing data in a computer memory to be directed to an abstract idea. *Content Extraction and Transmission LLC v. Wells Fargo Bank, National Association*, 776 F.3d 1343 (Fed. Cir. 2014); *see also Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016) where collecting information, analyzing it, and displaying results from certain results of the collection and analysis was held to be an abstract idea.

We next consider whether additional elements of the claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application of the abstract idea, e.g., whether the claim does more than simply instruct the practitioner to implement the abstract idea over the using generic computer components. We conclude that it does not.

Considering each of the claim elements in turn, the function performed by the computer system at each step of the process is purely conventional. Each step of the claimed method does no more than require a generic computer to perform a generic computer function. The Specification at paragraphs 31 and 100 states that generic cell phones and computer components may be used in the system.

Further, here, as in *Alice*, “the system claims are no different in substance from the method claims. The method claims recite the abstract

idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea.” *Alice* 134 S. Ct. at 2351. “[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea ‘while adding the words ‘apply it’ is not enough for patent eligibility.” *Id.* at 2358 (quoting *Mayo*, 132 S. Ct. at 1294).

For these reasons the rejection of claim 1 is sustained. The remaining claims are directed to similar subject matter and the rejection of these claims is sustained as well.

Rejections under 35 U.S.C. § 103(a)

The Appellants argue that the rejection of claim 1 is improper because Shockey fails to disclose claim limitations that the “system determines that the user is that same user on various devices by the order of the applications he accesses and when he accesses them” (App. Br. 6).

In contrast, the Examiner has determined that the cited claim limitation is found in Shockey at col. 10:4–13 and Eisen at paragraph 107 and that the rejection is proper (Final Rej. 7, 8, Ans. 4, 5).

We agree with the Appellants. Here, the claim requires in part:

(b) receiving data corresponding to a second application use-pattern from a second communication device operated by a user, wherein *the second application use pattern is an order in which applications are used at a second time of day on the second communication device, wherein the first application use-pattern is the same as the second application use-pattern and the first and second time of day are substantially the same.*

(Claim 1, emphasis added). The citation to Shockey at col. 10:4–13 and Eisen at paragraph 107 both fail to disclose this claim limitation individually. Further, there is no articulated reasoning with rational underpinnings to combine and modify the references to meet the requirements of claim limitation “b” identified above. Here the cited claim limitation requires that the “the second application use pattern is *an order in which applications are used at a second time of day* on the second communication device” the cited combination fails to disclose or suggest this. For these reasons this rejection of claim 1 and its dependent claims is not sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1 and 3–9 under 35 U.S.C. § 112, first and second paragraphs as listed in the Rejection section above.

We conclude that Appellants have not shown that the Examiner erred in rejecting the claims 1 and 3–9 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

We conclude that Appellants have shown that the Examiner erred in rejecting the claims 1 and 3–9 are rejected under 35 U.S.C. § 103(a) as listed in the Rejections section above.

Appeal 2016-005247
Application 13/691,054

DECISION

The Examiner's rejection of claims 1 and 3–9 is sustained.

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

AFFIRMED