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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TODD LIEBERMAN, ARI JACOBY, JEFF WEISBERG, and
JOHN CAPPIELLO

Appeal 2016-005429
Application 13/411,067
Technology Center 3600

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
NINA L. MEDLOCK, *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 rejection of claims 1–16, 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 generating and managing interactive advertisements. (Spec., para. 2). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A computer-implemented method comprising:
 - receiving, by a computer, a request for content from a user;
 - identifying, by the computer, an advertiser based on a user dataset;
 - providing, by the computer, an interactive advertisement associated with the advertiser comprising:
 - a) a media segment,
 - b) a branding message, and
 - c) a user input segment configured to receive a user response;
 - transmitting, by the computer, the interactive advertisement to a user;
 - receiving, by the computer, the user response;
 - verifying, by the computer, the user response based on at least a portion of the branding message;
 - in response to an acceptable user response, received after at least some of the interactive advertisement is presented, skipping, by the computer, at least a portion of the interactive advertisement being presented;
 - in response to an unacceptable user response, displaying, in its entirety, the interactive advertisement being presented; and
 - providing, by the computer, access to the content.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1–16 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Claims 1–11 are rejected under 35 U.S.C. § 102(e) as anticipated by Jamal (US 2009/0012855 A1, pub. Jan. 8, 2009).
3. Claims 12–16 are rejected under 35 U.S.C. § 103(a) as unpatentable over Jamal and Haumont (US 2011/0238466 A1, pub. Sept. 29, 2011).

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 evidence.¹

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 1 is improper because the claim is not directed to an abstract idea and instead rooted in technology (App. Br. 8-10).

In contrast, the Examiner has determined that rejection is proper (Final Act. 2, 3, Ans. 2, 3).

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).

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 providing customized advertising based on a response. This is a fundamental economic practice long prevalent in our system of commerce or a method of organizing human activities, and is an abstract idea beyond the scope of § 101. *See 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). Note that the Specification at paragraph 2 states that the invention relates to “generating and managing interactive advertisements.”

The Examiner has determined that the claim is directed to the concept of selecting web page advertisements (Final Act. 3) and although our characterization of the abstract idea is slightly different, abstract ideas can be described at different levels of abstraction. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016) (“An abstract idea can generally be described at different levels of abstraction.”).

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 using generic computer components. We conclude that it does not. The Specification at paragraph 25 for instance discloses the invention used with generic computer systems and technology such as a desktop computer, server, and networks.

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 Appellants cite to *DDR Holdings, LLC v. Hotels, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) and argue that the claim is “rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks” (App. Br. 10). We disagree as the Appellants have

not shown how the claimed subject matter is rooted in technology given that the Specification describes only the use of generic computer equipment used in a routine, conventional, and generic manner. As noted above, the Specification at paragraph 25 for instance discloses the invention used with generic computer systems and technology such as a desktop computer, server, and networks used in a generic, conventional, manner.

For these reasons, the rejection of claim 1, and its dependent claims which were not separately argued is sustained. Claims 10–14 are drawn to similar subject matter and the rejection of these claims is sustained as well.

We reach the same conclusion as to independent system claim 6 and its dependent claims. 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).

Rejections under 35 U.S.C. § 102(a) and 35 U.S.C. § 103(a)

Claims 1-10, 15, and 16

The Appellants argue that the rejection of claim 1 is improper because the cited prior art fails to disclose the claim limitation requiring:

receiving ... a request for content from a user.. providing an interactive advertisement [to the user] .. in response to an acceptable user response, received after at least some of the

interactive advertisement is presented, skipping ... at least a portion of the interactive advertisement being presented ... in response to an unacceptable user response, displaying, in its entirety, the interactive advertisement being presented [and] providing ... access to the content.

(App. Br. 12).

In contrast, the Examiner asserts this is shown by Jamal at Figures 1C, 1D (#425), and paragraphs 17 and 27 (Ans. 3, 4).

We agree with the Appellants. Here, Jamal at the above cited portions fails to disclose the cited claim limitation, and the rejection of claim 1 and its dependent claims is not sustained. Jamal at paragraph 27 discloses using the CAPTCHA system but not “*skipping ... at least a portion of the advertisement*” in response to an “acceptable user response” as claimed. Claims 6 and 10 contain a similar limitation and the rejection of these claims and their dependent claims is not sustained as well.

Claims 11-14

The Appellants argue that the rejection of claim 1 is improper because the cited prior art fails to disclose the claim limitation requiring:

receiving, ... a request for content from a user;...
skipping, at least a portion of the advertisement being presented in response to receipt of an acceptable user response to the challenge, wherein the acceptable user response is received after at least some of the advertisement is presented;

(App. Br. 20).

In contrast, the Examiner asserts this is shown by Jamal at Figures 1C, 1D (#425), and paragraphs 17 and 27 (Ans. 3, 4).

We agree with the Appellants. Here, the above citations fail to disclose the cited claim limitation, and the rejection of claim 11 and its dependent claims is not sustained. Jamal at paragraph 27 discloses using the CAPTCHA system but not “*skipping* at least a portion of the advertisement” in response to receipt of an “acceptable user response” as claimed.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting 1–16 are rejected under 35 U.S.C. § 101.

We conclude that Appellants have shown that the Examiner erred in rejecting 1–16 are rejected under 35 U.S.C. § 102(a) and 35 U.S.C. § 103(a) as listed in the Rejections section above.

DECISION

The Examiner’s rejection of claims 1-16 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)(1)(iv).

AFFIRMED