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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MADHUSUDAN RAMAN and PETER STEVEN TIPPETT

Appeal 2016-006049
Application 13/593,651
Technology Center 3600

Before ERIC B. CHEN, KARA L. SZPONDOWSKI, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's
Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C.
§ 6(b).

We AFFIRM.

STATEMENT OF THE CASE

Appellants' invention is directed to presenting offers in an augmented reality environment. Spec. ¶ 11. Claim 1, reproduced below with the disputed limitations in *italics*, is representative of the claimed subject matter:

1. A method, comprising:

storing, by a user device, user preferences for advertising categories of a set of standardized advertising categories, wherein the user preferences include a ranking of a user's level of interest in the advertising categories;

sending, from the user device to a service provider network, an indication of a location of the user device;

receiving, by the user device from the service provider network, a default offer set, wherein the default offer set includes offers in a proximity of the location, and wherein each of the offers in the default offer set includes category information to indicate at least one of the advertising categories;

selecting, by the user device and by applying the user preferences, top advertising categories from one or more of the offers in the default offer set, wherein the selecting identifies the top advertising categories from the ranking of the user's level of interest in the advertising categories;

presenting, by the user device, a reality image associated with the location;

displaying, by the user device, an offer icon representing one of the advertising categories in the top advertising categories, wherein the offer icon is overlaid on a portion of the reality image, and wherein the offer icon includes a rating indication of the user's level of interest for the one of the advertising categories;

receiving, by the user device, a user's selection of the offer icon; and

presenting, by the user device and in response to the user's selection of the offer icon, one or more offers from the one of the advertising categories in the top advertising categories.

REJECTIONS¹

Claims 1–20 stand rejected under 35 U.S.C. § 101 as directed to a judicial exception to statutory subject matter.

Claims 1–20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Altman et al. (US 2012/0220314 A1; published Aug. 30, 2012) (“Altman”).

ANALYSIS

35 U.S.C. § 101 Rejections

To determine whether a claim is eligible under § 101, “[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). If it is, we then “consider the elements of each 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.” *Id.* (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 78–79 (2012)).

In the first step of the *Alice* analysis, the Examiner determines the claims are directed to the abstract idea of “informed advertising.” Final Act. 22. In the second step of the *Alice* analysis, the Examiner determines

¹ The Examiner withdrew 35 U.S.C. § 112(b) rejections of claims 1–20. Ans. 4.

the additional recitations of a “user,” “user device,” “icon,” and “rating,” “amounts to merely conventional, insignificant, pre-solution, post-solution, token-extra-solution, basic, obvious, well-understood, long-prevalent, already-in-use, purely conventional, unsubstantial, and/or routine step(s), activitie(s), function(s) and/or action(s)” that are “insufficient to transform the claimed abstract idea . . . into a patent-eligible application.” Final Act. 23.

With respect to the first step of the *Alice* analysis, Appellants argue claim 1 “does not recite a basic concept that is similar to a law of nature, a natural phenomenon, or any abstract idea previously identified by the courts.” App. Br. 19. Appellants further argue “the claimed method is necessarily rooted in computer technology to overcome a problem specifically arising in an augmented reality environment, and not an abstract idea.” *Id.* According to Appellants, the Examiner failed to consider the claim as a whole and the claims “clearly do not seek to monopolize any judicial exception.” *Id.* at 17–18. With respect to the second step of the *Alice* analysis, Appellants argue

claim 1 adds unconventional steps that confine the claim to a particular useful application and adds meaningful limitations that amount to more than generally linking the use of the abstract idea to a particular technological environment (i.e., associating an advertising category within a portion of a reality image and indicating a user’s potential level of interest in the advertising category.)

App. Br. 19.

We are not persuaded by Appellants’ arguments. As such, we adopt the Examiner’s findings and conclusions as set forth in the Answer. *See* Final Act. 20–24; Ans. 4–12. As to step one of the *Alice* analysis,

Appellants admit “the claimed method relates to identifying and presenting advertising of interest to a user within a reality image.” App. Br. 18. We agree with the Examiner that the claims are directed to informed advertising, and are, therefore, directed to a fundamental economic or commercial practice. *See Affinity Labs. of Texas, LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1269 (Fed. Cir. 2016) (“we hold that the concept of delivering user-selected media content to portable devices is an abstract idea”); *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369–70 (Fed. Cir. 2015) (the practice of tailoring advertising to individual customers is a “fundamental . . . practice long prevalent in our system”); *Ultramerical, Inc. v. Hulu, LLC*, 772 F.3d 709, 714–715 (Fed. Cir. 2014) (“showing an advertisement before delivering free content” is an abstract idea).

Although Appellants argue “the claimed method is necessarily rooted in computer technology to overcome a problem specifically arising in an augmented reality environment, and not an abstract idea,” Appellants do not elaborate upon this argument to address *what problem* “specifically arising in an augmented reality environment” is addressed by claim 1. App. Br. 19; *see* Ans. 8–9. Appellants, therefore, have not provided persuasive supportive evidence for such arguments. We note that attorney argument in a brief cannot take the place of evidence. *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

Appellants’ preemption argument is likewise unpersuasive of Examiner error. We find that this argument is adequately addressed by the remainder of the *Alice* analysis. *See Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the Mayo

framework, as they are in this case, preemption concerns are fully addressed and made moot.”); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”).

Turning to the second step of the *Alice* analysis, Appellants’ arguments that certain limitations, i.e., associating an advertising category within a portion of a reality image and indicating a user’s potential level of interest in the advertising category, add meaningful limitations are not persuasive. The storing, sending, receiving, selecting, presenting, displaying, receiving, and presenting steps of claim 1 are all routine and conventional computer functions, performed by the “user device.” The receiving, generalizing, forwarding, identifying, scoring, sending, receiving, selecting, displaying, and receiving steps of claim 9 are likewise routine and conventional computer functions performed by either a “network device” or the “user device.” Claim 15 recites a “user device,” “display,” “memories,” and “processors.” The Specification describes generic computers and computer components for these devices. *E.g.*, Spec. ¶¶ 16, 17 (describing that user device may include, for example, a tablet computer, smartphone, laptop computer, gaming console, GPS device, etc.); ¶ 18 (“[s]ervice provider network 205 may include network devices to provide backend services to user devices 100”); ¶ 29 (“[p]rocessing unit 320 may include one or more processors or microprocessors that interpret and execute instructions”); ¶ 30 (“[m]emory 330 may include a random access memory (RAM) . . . a read only memory (ROM)”); ¶ 35 (functional components of the user device may be implemented by, for example, “processing unit 320

in conjunction with memory 330”). Appellants do not adequately show how the claimed steps are technically performed such that they are not routine, conventional functions of a generic computer, nor do Appellants provide evidence why the steps are not routine and conventional functions of a generic computer. The claims when viewed as a whole are nothing more than performing conventional processing functions that courts have routinely found insignificant to transform an abstract idea into a patent-eligible invention. As such, the claims amount to nothing significantly more than an instruction to implement the abstract idea on a generic computer -- which is not enough to transform an abstract idea into a patent-eligible invention. *See Alice*, 134 S. Ct. at 2360.

In view of the foregoing, we sustain the Examiner’s 35 U.S.C. § 101 rejection of claims 1–20.

35 U.S.C. § 102 Rejections

Appellants argue Altman does not disclose “displaying, by the user device, an offer icon representing one of the advertising categories in the top advertising categories, wherein the offer icon is overlaid on a portion of the reality image, and wherein the offer icon includes a rating indication of the user’s level of interest for the one of the advertising categories,” “receiving, by the user device, a user’s selection of the offer icon,” and “presenting, by the user device and in response to the user’s selection of the offer icon, one or more offers from the one of the advertising categories in the top advertising categories,” as recited in independent claim 1. App. Br. 21–24.

Specifically, Appellants argue “nothing in [Altman] discloses or even suggests that an offer icon, representing one of the advertising categories in

the top advertising categories, is overlaid on a portion of the reality image” and “[Altman] certainly does not disclose or suggest that the offer icon includes a rating indication of the user’s level of interest for the one of the advertising categories.” App. Br. 22. Appellants further argue “to assert a selection of the offer icon, the Examiner relies on a completely different embodiment of [Altman], namely coupons that are delivered . . . [and] the coupons of [Altman] do not represent an offer category and are not presented in response to the user’s selection of the offer icon.” App. Br. 23.

We are persuaded by Appellants’ arguments. Altman generally describes capabilities for presenting locations of mobile communication devices operated by a user on a map representation of an area. Altman Abstract. In addition, Altman discusses tools for an advertiser to create and transmit relevant ad messages to a user based on a specific location, where the ad messages can be in the form of a text message, coupon, or graphic element. Altman Abstract. The Examiner identifies paragraphs 52, 53, 55, 56, 74, and 82 of Altman as teaching “that displayable information/data (e.g. an icon) is interactive” and “receiving a selection . . . and in response to the selection . . . offering information.” Ans. 19, emphasis omitted. The Examiner finds Altman is “at least fully capable . . . of [receiving a selection] and . . . presenting one offer.” Ans. 20, emphasis omitted. The Examiner also cites to Figures 2B, 15A, 15B, and paragraphs 103 and 104 as “example(s) of making available (i.e. presenting) offer(s) and of selection(s) of actionable icon(s).” Final Act. 27.

None of paragraphs 52, 53, 55, 56, 74, and 82 describe the selection or display of information pertaining to offers or advertisements. *See* Altman ¶ 52 (describing display of user information “when the icon associated with

the user is selected on the display” and displaying “names and status of friends and/or places of interest or events”); ¶ 53 (describing displaying user information in a pop-up display activated by a toggle switch or command); ¶ 55 (describing displaying a set of groups of friends); ¶ 55 (describing displaying information relating to friends); ¶ 74 (describing displaying description of an event); ¶ 82 (describing use of icons to specify the identity and status of users and friends, places, and events).

In a separate embodiment, Altman describes the ability of an advertiser to “directly tie an ad message with a user based directly on the user’s activity in a location and time-based context.” Altman ¶ 100. Such advertisements may be in the form of “banner ad messages, advertisement screens, sponsored maps, and the like” and the messages may be in the form of “text, graphics, animation, logo, trademark or any other suitable format.” Altman ¶ 100. Altman describes that “[t]he advertising message or logo for a product or service can also be incorporated into the map display provided by the mobile application.” Altman ¶ 101. Altman goes on to describe various embodiments for the advertisement, including advertising messages or logos, a banner ad displayed over a portion of the map display, or a particular logo or graphic displayed when the point of interest corresponding to the advertiser is present in the map. Altman ¶ 101, Fig. 14B.

Even assuming the banner, advertising message, logo, or graphic constitutes the claimed “offer icon,” the claim requires “a user’s selection of the offer icon” and in response to that selection, “presenting . . . one or more offers.” We do not see, and the Examiner has not directed us to, any indication in Altman that any of the described advertising banners or graphics may be selected by a user, and in response to that selection,

presenting one or more offers. In another embodiment, cited by the Examiner as an example of presenting an offer (Final Act. 27), Altman describes a mechanism for an advertiser to deliver coupons, however Altman describes that coupons are delivered in response to a user search, as an SMS or alert when the user is near the merchant location, or as interstitial coupons that are delivered during the loading screen of the mobile application.

Altman ¶ 104. Therefore, Altman's coupons do not appear to be delivered based upon a user selection of any of the described advertising messages in Altman.

To anticipate, a reference must disclose “within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). Here, the Examiner has combined multiple embodiments from Altman in formulating the anticipation rejection. *See id.* (For anticipation, “[t]he [prior art] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” (parenthetically quoting *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972))). Specifically, the Examiner relies on embodiments relating to the display of user, friends, events, and location information to teach or suggest that certain elements may be selected by the user in order to display further information, but relies on the embodiments pertaining to advertisements and coupons to disclose presentation of the offer. While “[s]uch picking and choosing may be entirely proper in the making of a 103, obviousness rejection . . . it has no

place in the making of a 102, anticipation rejection.” *In re Arkley*, 455 F.2d at 587–588.

Accordingly, based on the record before us, we do not sustain the Examiner’s 35 U.S.C. § 102 rejection of independent claim 1, and independent claims 9, 15, and 18 which recite commensurate limitations as those discussed above, and, for the same reasons, dependent claims 2–8, 10–14, 16, 17, 19, and 20.

DECISION

We affirm the Examiner’s 35 U.S.C. § 101 rejection of claims 1–20.

We reverse the Examiner’s 35 U.S.C. § 102 rejection of claims 1–20.

Because we affirm at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner’s decision to reject all of the pending claims.

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