



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/829,329	07/27/2007	Christopher Jaffe	12729-279 (Y02324US00)	1938
149109	7590	05/21/2018	EXAMINER	
BGL/Excalibur P.O. Box 10395 Chicago, IL 60610			SORKOWITZ, DANIEL M	
			ART UNIT	PAPER NUMBER
			3681	
			MAIL DATE	DELIVERY MODE
			05/21/2018	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER JAFFE, RONALD MARTINEZ, and
JOSEPH O’SULLIVAN¹

Appeal 2016-006119
Application 11/829,329
Technology Center 3600

Before ROBERT E. NAPPI, JOHNNY A. KUMAR, and CARL L.
SILVERMAN, *Administrative Patent Judges*.

KUMAR, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 18, 20, 22, 26, and 28–30. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Representative Claim

18. A method for providing electronic advertisements on a display device of a remote device of a user, the method by a computer and comprising:

transmitting an initial advertisement and a navigational element to the remote device, the initial advertisement and navigational element being of a specific format type, wherein the format type includes a specified area for

¹According to Appellants, Yahoo!, Inc. is the real party of interest in this application. *See App. Br. 2.*

displaying the initial advertisement and the navigational element on the remote device;

receiving a navigational signal from the remote device, the navigational signal being transmitted when the navigational element is selected by the user of the remote device;

selecting a subsequent advertisement based on the user's interaction with the initial advertisement;

transmitting the subsequent advertisement after the first navigational signal is received;

wherein the initial and subsequent advertisements are at least one of a static media advertisement or a sequential media advertisement;

receiving information relating to the user's interaction with the initial advertisement;

generating a user profile based on the information relating to the user's interaction with the initial advertisement;

selecting and transmitting the subsequent advertisement based on the user profile to the remote device, the subsequent advertisement being of the specific format type of the initial advertisement, wherein the subsequent advertisement is displayed where the initial advertisement was previously displayed on the remote device; and

wherein the user's interaction with the initial advertisement includes a determination if the user selected the initial advertisement on the display device, wherein selection of the initial advertisement is used in selecting a subject matter of the subsequent advertisement.

Rejections

1. Claims 18, 20, 22, 26, and 28–30 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 2–3.
2. Claims 18, 20, 26, 28, and 29 are rejected under 35 U.S.C. § 102(b) as being anticipated by Botelho (US 2002/0069105 A1; published June 6, 2006). Final Act. 4–7.
3. Claims 22 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Botelho and Wong (US 2003/0046149 A1; published Mar. 6, 2003). Final Act. 7–8.

Issues on Appeal

Did the Examiner err in rejecting claims 18, 20, 22, 26, and 28–30 under 35 U.S.C. § 101, as being directed to patent-ineligible subject matter?

Did the Examiner err in rejecting claims 18, 20, 26, 28, and 29 under 35 U.S.C. § 102(b), as being anticipated by Botelho?

Did the Examiner err in rejecting claims 22 and 30 under pre-AIA 35 U.S.C. § 103(a), as being obvious over the cited combinations of references?

Grouping of Claims

Based on Appellants’ arguments (App. Br. 6–10), we decide the appeal on the basis of representative claim 18.

ANALYSIS

We have considered all of Appellants’ arguments and any evidence presented. We disagree with Appellants’ arguments and we adopt as our own the findings, legal conclusions, and explanations, as set forth in the Answer (2–5) in response to Appellants’ arguments. (App. Br. 6–10; Reply Br. 1–7). We highlight and address specific findings and arguments for emphasis in our analysis below.

Rejection of Claims 18, 20, 22, 26, and 28–30 Under 35 U.S.C. § 101

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.” 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) (quoting *Ass’n for Molecular Pathology v. Myriad*

Appeal 2016-006119
Application 11/829,329

Genetics, Inc., 133 S. Ct. 2107, 2116 (2013) (internal quotation marks omitted)). In *Alice*, the Supreme Court set forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71–73 (2012)).

The first step in our analysis is to determine whether the claims at issue are directed to a patent-ineligible concept, such as an abstract idea. *See Alice*, 134 S. Ct. at 2355.

If the claims are directed to a patent-ineligible concept, the second step in the analysis is to “consider the elements of each claim both 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 78).

In other words, the second step is to “search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (quoting *Mayo*, 566 U.S. at 72–73).

***Alice* — Step One**

In the Appeal Brief, Appellants contend:

These claims include the elements of transmitting an initial advertisement and a navigational element to the remote device, receiving a first navigational signal from the remote device, the navigational signal being transmitted when the navigational element is selected by the user of the remote device, selecting a subsequent advertisement based on the user's interaction with the initial advertisement, and transmitting the subsequent advertisement after the navigational signal is

Appeal 2016-006119
Application 11/829,329

received. Additionally defined is that the user's interaction with the initial advertisement includes a determination if the user selected the initial advertisement on the display device, wherein selection of the initial advertisement is used in selecting a subject matter of the subsequent advertisement.

App. Br. 7.

Appellants cite *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) (“*Enfish*”) to clarify specific requirements for properly analyzing whether claims are actually directed to an abstract idea (Reply Br. 3–5) and contend, *inter alia*:

Like the invention claimed in *Enfish*, the claimed invention is directed to a specific improvement in computer technology. In this case, the claimed invention is directed to a systems and method for providing electronic advertisements on an electronic device.

The claimed invention is an improvement in computer technology. One of the drawbacks of prior art solutions is that in order to maximize the amount of revenue received from third party advertisers, remote service providers generally attempt to increase the number of advertisements in their remote services. However, electronic devices have a finite amount of display space, limiting the amount of space for available for advertising, negatively impacting the amount of revenue received from third party advertisers.

(Reply Br. 4–5.)

However, improving electronic advertisements is not an improvement to computer capabilities akin to *Enfish*'s self-referential table for a computer database (*see Enfish* 822 F.3d at 1335–36). Rather, it is an improvement to a process where computers are invoked merely as a tool, which qualifies as an abstract idea.

The Examiner finds, and we agree

the method steps claimed are directed to providing data to display advertisements, based on user selections, an abstract idea, considered an idea in and of itself. The claims as a whole disclose only the abstract idea of providing targeted advertising (i.e. a fundamental economic practice) using the conventional technology available to and relying on information generally available to such conventional technology (web click advertising systems).

Ans. 2.

Likewise, the Examiner determines, and we agree “the method steps claimed, including a user selecting advertisements, do not improve upon the underlying computing devices, but claim an improvement to a business practice of targeting advertisements, not underlying technology.” Ans. 4.

Thus, we conclude claim 18 is directed to a method for providing targeted advertising, a fundamental economic practice. *See Enfish*, 822 F.3d at 1335 (fundamental economic and conventional business practices are often found to be abstract ideas, even if performed on a computer); *OIP Techs., Inc. v. Amazon.com Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015).

For at least these reasons, we conclude representative claim 18 is directed to an abstract idea. (*Alice* — Step One.)

***Alice* — Step Two**

Proceeding to step two of the *Alice* test articulated by the Supreme Court, we further “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.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78).

Regarding step two of the *Alice* analysis, Appellants cite to *DDR Holdings, LLC v. Hotels.com.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014), and contend, *inter alia*:

In *DDR Holdings*, the asserted patents claimed a system and method of generating a composite web page that combined certain visual elements of a "host" website with content of a third-party merchant.

...

Even though the claims involved both the Internet and a computer, they stood "apart because they [did] not merely recite the performance of some business practice known from the pre-Internet world along with the requirement to perform it on the Internet.

App. Br. 7–8.

In *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d at 1259, the subject claim was held patent-eligible because it encompassed “an inventive concept” for resolving a “particular Internet-centric problem.” In contrast, we find Appellants’ method for “providing targeted advertising” does not provide a solution “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *DDR*, 773 F.3d at 1257.

Because we find all claims on appeal merely use a generic computer or processor as a **tool** which is used in the way a computer normally functions, we conclude claim 18 fails to impart any discernible improvement upon the computer or processor, nor do Appellants’ claims solve “a challenge particular to the Internet” as considered by the court in *DDR*, 773 F.3d at 1256–57.

Thus, we conclude none of Appellants’ claims are like the claim held patent-eligible by the court in *DDR*, in which the claimed invention was directed to the “challenge of retaining control over the attention of the customer in the context of the Internet,” such that:

Instead of the computer network operating in its normal, expected manner by sending the website visitor to the third-party website that appears to be connected with the clicked

Appeal 2016-006119
Application 11/829,329

advertisement, the claimed system generates and directs the visitor to the above-described hybrid web page that presents product information from the third-party and visual “look and feel” elements from the host website.

DDR, 773 F.3d at 1258–59.

Regarding step two of the *Alice* test, we find nothing in claims 18, 20, 22, 26, and 28–30 that adds anything “significantly more” to transform the abstract concept of providing targeted advertising into a patent-eligible application. *See Alice*, 134 S. Ct. at 2357. Appellants do not argue that each of the steps or functions recited in claims 18, 20, 22, 26, and 28–30 is individually inventive. Nor have Appellants shown that the claims (directed to providing targeted advertising) improve the functioning of the computer itself and amount to significantly more than the **abstract idea of a fundamental economic practice**. *See, e.g., BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016) (“An abstract idea on ‘an Internet computer network’ or on a generic computer is still an abstract idea.”); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016) (“We have repeatedly held that such invocations of computers and networks that are not even arguably inventive are insufficient to pass the test of an inventive concept in the application of an abstract idea.”) (Internal quotations omitted).

Applying the aforementioned guidance here, we conclude Appellants’ claims are not directed to an **improvement** in computer functionality, or database functionality, or network functionality. Therefore, we conclude that none of the claim limitations, viewed “both individually and as an ordered combination,” amount to significantly more than the judicial exception in order to sufficiently transform the nature of the claims into patent-eligible subject matter. *See Alice*, 134 S. Ct. at 2355 (internal quotations omitted)

Appeal 2016-006119
Application 11/829,329
(quoting *Mayo*, 566 U.S. at 78).

Accordingly, for the reasons discussed above, we sustain the Examiner’s rejection under 35 U.S.C. § 101 of representative claim 18, and grouped claims 20, 22, 26, and 28–30, as being directed to patent-ineligible subject matter in light of *Alice* and its progeny. See *Grouping of Claims*, *supra*.

*Prior Art rejections under 35 U.S.C. § 102(b)/ § 103(a)*²

Based on Appellants’ arguments in the Briefs, the principal and dispositive issue of whether the Examiner erred in rejecting exemplary claim 18 turns on whether Botelho discloses “wherein the user's interaction with the initial advertisement includes a determination if the user selected the initial advertisement on the display device, wherein selection of the initial advertisement is used in selecting a subject matter of the subsequent advertisement.” (hereinafter “the disputed limitations”). App. Br. 8–10; Reply Br. 5–7. Independent claim 26 recites similar subject matter.

We adopt the findings of facts made by the Examiner in the Final Action and Examiner’s Answer as our own. We concur with the decision reached by the Examiner in the Examiner’s Answer. We highlight the following for emphasis.

Appellants contend Botelho does not disclose the disputed limitations. App. Br. 8; Reply Br. 5.

In particular, Appellants contend:

In Botelho, the user essentially picks which categories are of interest to the user. The user can then scroll through these advertisements and provide feedback if they like or do not like the advertisement.

² Appellants did not provide separate arguments for dependent claims 20, 22, and 28–30. App. Br. 10.

However, the user's interaction with the advertisement is not tracked and the user profile is not generated. Conversely, the present claimed invention utilizes the user's interaction with the initial advertisement (not a menu selection device like Botelho) and includes a determination if the user selected the initial advertisement, wherein selection of the initial advertisement is used in selecting a subject matter of the subsequent advertisement.

App. Br. 9 (hereinafter “tracking feature”).

The Examiner has identified the relevant portions of Botelho and has provided sufficient explanation with corresponding citations to various parts of the reference for disclosing the tracking feature of the disputed limitations. In particular, the Examiner finds “Botelho teaches a generated user profile, called user attributes in paragraph 70, tracked by user cookies, and using to target ads in paragraph 71, map the contents of the individual cookies to a specific advertisement or targeted content.” Ans. 5 (citing Botelho ¶¶ 70, 71). In other words, the Examiner equates Botelho’s attributes to the user profile and Botelho’s user cookies to the tracking of the user’s interactions.

The Examiner, giving the claim its broadest reasonable interpretation consistent with the Specification, has properly found that the tracking feature of the disputed limitations reads upon Botelho’s disclosure, as explained above.

It follows that Appellants have not shown error in the Examiner’s rejection of independent claims 18 and 26. Thus, we sustain the rejection of claims 18, 20, 26, 28, and 29 under 35 U.S.C. § 102.

Appellants have provided no separate arguments towards patentability for claims 22 and 30. Therefore, the Examiner’s § 103 rejection of claims 22 and 30 is sustained for similar reasons to those noted *supra*.

Appeal 2016-006119
Application 11/829,329

DECISION

We affirm the Examiner's rejection of claims 18, 20, 22, 26, and 28–30 under 35 U.S.C. § 101.

We affirm the Examiner's § 102(b) rejections of claims 18, 20, 26, 28, and 29 and the Examiner's § 103(a) rejections of claims 22 and 30.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED