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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
11/745,248	05/07/2007	Christopher Jaffe	12729-263 Y02271US00	1447
56020	7590	12/26/2017	EXAMINER	
BGL/Yahoo Holdings P.O. BOX 10395 CHICAGO, IL 60610			SORKOWITZ, DANIEL M	
			ART UNIT	PAPER NUMBER
			3681	
			MAIL DATE	DELIVERY MODE
			12/26/2017	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPEHER JAFFE, RONALD MARTINEZ and
ERIC ALMENBERG

Appeal 2016-006124
Application 11/745,248
Technology Center 3600

Before ALLEN R. MacDONALD, ROBERT E. NAPPI, and
JASON M. REPKO, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 48 and 50 through 56. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

INVENTION

Appellants' disclosed invention is directed to a method for providing advertising to a user of a computer capable of displaying Internet based media. *See* Abstract of Appellants' Specification. Claim 1 is representative of the invention and reproduced below.

1. A method for providing advertising to a user of a computer capable of displaying sequential media played by a media player in a display, the method comprising the steps of:

providing a media object to a computer having a processor, the display being in communication with the processor of the computer, wherein the media object contains sequential media and advertising information;

displaying a persistent banner advertisement in a first part of the display utilized by the media player, the persistent banner advertisement contained within the advertising information of the media object, the persistent banner advertisement being displayed directly adjacent to where the sequential media is to be displayed;

displaying sequential media of the media object in a second part of the display utilized by the media player; and

displaying a rich media advertisement in at least a portion of the second part of the display utilized by the media player where the sequential media was displayed, wherein at least a portion of the rich media advertisement will overlap at least a portion of the sequential media, when prompted by a first user action, the rich media advertisement contained within the advertising information of the media object.

App. Br. 14 (Claims Appendix).

REJECTIONS AT ISSUE¹

The Examiner has rejected claims 1 through 48 and 50 through 56 under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Final Action 2–3.

The Examiner has rejected claims 1 through 5, 7, 8, 10, 11, 13 through 16, 18 through 20, 22, 47, 48, 50 and 51 under 35 U.S.C. § 102(b) as being anticipated by Hayward (US 2004/0015398 A1, pub. Jan. 22, 2004). Final Action 3–9.

The Examiner has rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Hayward and Henry (US 2003/0105848, pub. June 5, 2003). Final Action 10.

The Examiner has rejected claims 9, 12, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Hayward and Tucker (US 2002/0080164, pub. June 27, 2002). Final Action 10–12.

The Examiner has rejected claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Hayward and Cramer (US 2002/0104096, pub. Aug. 1, 2002). Final Action 12–13.

The Examiner has rejected claim 23 through 28, 30, 31, 33, 34, 36 through 39, 41, 43 through 46, and 52 through 56 under 35 U.S.C. § 103(a) as being unpatentable over Hayward and Landsman (US 2003/0028565, pub. Feb. 6, 2003). Final Action 13–20.

¹ Throughout this Decision we refer to the Appeal Brief filed June 17, 2015, Reply Brief filed May 23, 2016, Final Office Action mailed November 13, 2014, and the Examiner’s Answer mailed March 23, 2016.

The Examiner has rejected claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Hayward, Landsman and Henry. Final Action 20–21.

The Examiner has rejected claims 32, 35, and 40 under 35 U.S.C. § 103(a) as being unpatentable over Hayward Landsman and Tucker. Final Action 21–23.

The Examiner has rejected claim 42 under 35 U.S.C. § 103(a) as being unpatentable over Hayward Landsman and Cramer. Final Action 23–24.

Rejection Under 35 U.S.C. § 101

PRINCIPLES OF LAW

Patent-eligible subject matter is defined in § 101 of the Patent Act, which recites:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

There are, however, three judicially created exceptions to the broad categories of patent-eligible subject matter in § 101: laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012). Although an abstract idea, itself, is patent-ineligible, an application of the abstract idea may be patent-eligible. *Alice*, 134 S. Ct. at 2355. Thus, we must 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.* (citing *Mayo*, 566 U.S. at 78–80). The claim must contain elements or a combination of elements that are “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea] itself.” *Id.* (citing *Mayo*, 566 U.S. at 72–73).

The Supreme Court sets forth a two-part “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.

First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. [*Mayo*, 566 U.S. at 76–77]. If so, we then ask, “[w]hat else is there in the claims before us?” *Id.*, at [77–78]. To answer that question, we 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.*, at [77–78]. We have described step two of this analysis as a 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.*, at [71–73].

Id.

ANALYSIS

We have reviewed Appellants’ arguments in the Briefs, the Examiner’s rejections, and the Examiner’s response to Appellants’ arguments. Appellants’ arguments have not persuaded us of error in the Examiner’s determination that the claims are unpatentable.

Appellants argue on pages 5 through 7 of the Brief, that claim 1 is not directed to an abstract idea. Specifically, Appellants argue the claims as a

“whole, relate to a computer-implemented systems and methods to provide advertising to a user of a computer capable of displaying sequential media played by a media player in a display.” App. Br. 9. Appellants argue, “there is nothing immediately apparent about these physical steps that would indicate the claim is directed to an abstract idea.” *Id.* Further, Appellants argue the claims are similar to those considered by the court in *Enfish v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), as it is an improvement in computer technology in that it makes more efficient use of screen space. Reply Br. 4–5.

These arguments have not persuaded us the Examiner erred in determining representative claim 1 recites an abstract idea. The Examiner states:

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). The claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements when considered both individually and as a combination do not amount to significantly more than the abstract idea.... , the claims do not improve upon the underlying computing devices, rather these conventional devices merely perform the abstract ideas. The limitations drawn to a website are simply field of use that attempt to limit the abstract idea to a particular technological environment (i.e. the Internet). The type of information being manipulated does not impose meaningful limitations or render the idea less abstract. The current invention merely applies the same display of web banner advertisements (abstract ideas) and seeks to claim an improvement to a business practice, not underlying technology, hence the judicial exception

Answer 2–3.

We concur with the Examiner. The Federal Circuit has explained that, in determining whether claims are patent-eligible under Section 101, “the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.” *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016). The Federal Circuit also noted in that decision that “examiners are to continue to determine if the claim recites (i.e., sets forth or describes) a concept that is similar to concepts previously found abstract by the courts.” *Amdocs*, 841 F.3d at 1294 n.2 (citation omitted).

In the instant case, representative claim 1 is directed to providing advertising to a computer displaying media, which consists of the steps of providing media with advertising information (data), display a banner advertisement adjacent the media (displaying data), displaying the media (displaying data), and displaying an advertisement in a portion of the display of the media, overlapping the display of the media, when prompted by a user (conditionally displaying data). Our reviewing court has said claims found to “merely recite the abstract idea of ‘offering media content in exchange for viewing an advertisement,’ along with the ‘routine additional steps such as . . . requiring a request from the consumer to view the ad . . . and the use of the Internet” do not render claims patent eligible. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1258 (Fed. Cir. 2014) (citing *Ulramercial, Inc. v. Hulu LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014)). Thus, the claims are similar to claims, which the court has held to encompass an abstract idea. Further, representative claim 1 does not recite a specific computer or change

the operation of or improve upon the underlying computing devices, but rather merely recite displaying data and changing the display in response to user request, which are conventional operations of a computing device. Accordingly, we concur with the Examiner that representative claim 1 recites an abstract idea.

On page 10 of the Appeal Brief, Appellants address the second part of the *Alice* analysis and argue the claims recites significantly more than the abstract idea as:

Encapsulating the sequential media and advertising information within a media object as claimed prevents rogue users from simply stripping away the sequential media from the advertising information. This step the in practice amounts ‘significantly more’ as contemplated in Mayo.
App. Br. 10.

We are not persuaded of error in the Examiner’s rejection by these arguments. We concur with the Examiner that, the additional limitations are directed to generic computer functions and the claims do not recite significantly more. Answer 9 and Final Rej. 3.

“[T]he use of generic computer elements like a microprocessor or user interface do not alone transform an otherwise abstract idea into patent-eligible subject matter.” *FairWarning IP v. Iatric Sys. Inc.*, 839 F.3d 1089, 1096 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014)). *See also Alice Corp.* We disagree with Appellants that claim 1 recites significantly more than the abstract idea. Initially we note that representative claim 1 does not recite “Encapsulating the sequential media and advertising information within a media object” rather that the claim recites that the media object contains the sequential media and

advertising information. As stated by the Examiner, this is merely descriptive of the information contained in the media data. The limitation simply narrows the abstract idea so that it is described at a lower level of abstraction. It does not render the abstract idea to which the claim is directed to any less an abstract idea, as such the recitation of the media object containing sequential media and advertising is not sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the abstract concept of presenting advertisements. Thus, Appellants' arguments have not persuaded us that representative claim 1 recites significantly more than the abstract idea. Therefore, we sustain the Examiner's 35 U.S.C. § 101 rejection of claim 1 and claims 2 through 48 and 50 through 56 grouped with claim 1.

Rejection Under 35 U.S.C. § 102

Appellants argue the Examiner's anticipation rejection of independent claims 1 and 47 is in error as Hayward does not teach that a portion of the rich media advertisement overlaps a portion of the sequential media as claimed. App. Br. 10. Appellants argue that Hayward discloses several media objects being displayed at the same time but does not teach that they overlap. App. Br 11–12. Appellants assert the Examiner has misconstrued the term “overlap” and that in the claims the term “overlap” means visually overlap. App. Br. 12–13.

The Examiner responds to Appellants' arguments stating: Webster's Dictionary was cited to define overlap as to happen at the same time as something else, and the use of this definition has not been shown to be unreasonable. According to plain English, using such broadest reasonable definition of overlap, the user is watching the display screen shown in figure 2 of

Hayward, and sees many advertisements and videos at the same time, all overlapping on the screen, visually and temporally, overlapping in the eyes and mind of the consumer.

Answer 5.

We disagree with the Examiner. Claim 1 states “displaying a rich media advertisement in at least a portion of the second part of the display” and “displaying a rich media advertisement in at least a portion of the second part of the display utilized by the media playerwherein at least a portion of the rich media advertisement will overlap at least a portion of the sequential media.” Independent claim 47 recites similar limitations. Thus, the claims are reciting that rich media is displayed in portion of the second part of the same display that the sequential media is displayed and they overlap. As such, it is clear the term “overlap” is referring to visually overlap and not just temporally overlap as construed by the Examiner. We have reviewed the teachings of Hayward and do not find that Hayward teaches the rich media overlapping the sequential media has claimed. Accordingly, we do not sustain the Examiner’s anticipation rejection of independent claims 1 and 47 and dependent claims 5, 7, 8, 10, 11, 13 through 16, 18 through 20, 22, 48, 50 and 51.

Rejections Under 35 U.S.C. § 103

Appellants argue the Examiner’s rejection of independent claim 23 is in error for the same reasons as discussed with respect to claim 1.

The Examiner’s rejection of independent claim 23 relies upon the same claim interpretation to reject claim 23 and Hayward to teach the disputed limitation. Final Action 12–13.

Claim 23 recites limitations similar to those discussed above with respect to claim 1. As with claim 1, we do not find that Hayward teaches this limitation. The Examiner has not found that Landsman teaches the overlapping as claimed. Accordingly, we do not sustain the Examiner's rejection of independent claim 23 and dependent claims 24 through 28, 30, 31, 33, 34, 36 through 39, 41, 43 through 46, and 52 through 56.

The Examiner's rejections of dependent claims 6, 9, 12, 17, 21, 29 32, 35, 40 and 42 similarly rely upon Hayward's teaching limitation of the independent claims. Accordingly, we do not sustain the Examiner's rejection of dependent claims 6, 9, 12, 17, 21, 29 32, 35, 40 and 42 for the same reasons as claim 1.

DECISION

We affirm the Examiner's rejection of claims 1 through 48 and 50 through 56 under 35 U.S.C. § 101.

We reverse the Examiner's anticipation rejection of claims 1 through 5, 7, 8, 10, 11, 13 through 16, 18 through 20, 22, 47, 48, 50 and 51, and the Examiner's obviousness rejections of claims 6, 9, 12, 17, 21, 23 through 46, and 52 through 56

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