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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SERVERIUS PETRUS PAULUS PRONK
and MAURO BARBIERI

Appeal 2016-006191
Application 13/382,963
Technology Center 3600

Before BIBHU R. MOHANTY, NINA L. MEDLOCK, and
BRADLEY B. BAYAT, *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 1–6 and 8–13, 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 method and apparatus for the selection of ancillary information to be inserted into content (Spec., page 3, lines 20–23). Claim 10, reproduced below, is representative of the subject matter on appeal.

10. A method of selecting an ancillary information stored in an ancillary information data base to be inserted to a content accessed by a user, said method comprising:
- providing user-specific information regarding user ratings inputs via a user interface;
 - calculating by a computing device, based on the provided user-specific information, a degree of involvement of said user in each product category of ancillary information out of a number of product categories of ancillary information;
 - classifying said calculated degree of involvement, wherein said classifying comprises determining an estimate of the degree of the user's involvement for said number of product categories, in that said classifying comprises:
 - determining the number of times ancillary information from each of said number of product categories has been rated positive and to determine the number of times ancillary information from each of said number of product categories has been rated negative, respectively, according to user rating inputs via the user interface,
 - determining the total positive and negative counts summed over all of said number of product categories,
 - estimating for each of said number of product categories
 - (i) a first conditional probability that said user likes the product category by dividing said number of times an ancillary information from each of said number of product categories has been rated positive by said total positive counts summed over all of said number of product categories, and
 - (ii) a second conditional probability that said user dislikes the product category by dividing said number of times an ancillary information from each of said number

of product categories has been rated negative by said total negative counts summed over all of said number of product categories, and

- classifying said degree of involvement of said user in said product category based on a required difference between said first and second conditional probabilities; and
- selecting said ancillary information stored in said ancillary information data base based on the result of the classification.

THE REJECTIONS

The following rejections are before us for review:

1. Claims 1–6 and 8–13 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.
2. Claims 1–6, 8, 9, and 13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.
3. Claims 1–6 and 8–13 are rejected under 35 U.S.C. § 103(a) as unpatentable over Raghunandan (US 2008/0300964 A1; pub. Dec. 4, 2008), Graham (US 6,804,659 B1; iss. Oct. 12, 2004), Dunk (US 2011/0060649 A1; pub. Mar. 10, 2011), and Amento (US 2008/0306807 A1; pub. Dec. 11, 2008).

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

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).

ANALYSIS

Rejection under 35 U.S.C. § 101

The Appellants argue that the rejection of claim 10 is improper because it is not directed to an abstract idea (App. Br. 8–12, Reply Br. 2–4). The Appellants also argue that the claim is “significantly more” than the alleged abstract idea (App. Br. 10–12, Reply Br. 2–4).

In contrast, the Examiner has determined that the rejection is proper (Final Act. 2, 3, Ans. 6–8).

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 10 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.*, 566 U.S. 66 (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 selecting information to be inserted into content accessed by a user. This is directed to a method of organizing human activities, or an idea in itself, and is an abstract idea beyond the scope of § 101. *See Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (in which “collecting information, analyzing it, and displaying certain results of the collection and analysis” was held to be an abstract idea). *See also In re TLI Comm. LLC Patent Litig.*, 823 F.3d 607, 612 (Fed. Cir. 2016) (in which “classifying and storing digital images in an organized manner” was held to be an abstract concept). The Specification at page 1, lines 2–5 states that the “present invention relates to ...selecting ... ancillary information, e. g. an advertisement...to be placed or inserted in a medium.” The preamble of claim 10 states that the claim is a method of “selecting an ancillary information stored in an ancillary information data base to be inserted to a content accessed by a user.” Although the Appellants in their Reply Brief at pages 2–4 make reference to *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016) that decision dealt with a self-referential data table. In contrast, claim 10 here is directed to the concept of selecting information to be inserted into content accessed by a user.

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 using generic computer components. We conclude that it does not.

Considering each of the claim elements in turn and as an ordered combination, the function performed by the computing device 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. For example, the Specification at page 6, lines 7–22, discloses using generic components in a conventional manner for their known functions.

For these above reasons the rejection of claim 10 is sustained. Claims 11–13 are drawn to similar subject matter and not argued separately, thus, the rejection of these claims is sustained as well.

We reach the same conclusion as to apparatus claims 1–6, 8, and 9. These claims do not specifically require a computer or processor. Regardless, even considering the “classifier” to be a computer or processor does not change what claim 1 is directed to. Here, the apparatus claims are directed to the same subject matter as claim 10 discussed above. In *Alice*, the Court noted that despite their format, “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*, 566 U.S. at 73).

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 1–6, 8, 9, and 13 asserting that the claim limitations for “a classifier....for calculating...” invoke 35 U.S.C. § 112, sixth paragraph, and fail to provide support for specific structure to support the limitations (Final Act. 4, 27, Ans. 9).

In contrast, the Appellants argue that the rejection is improper and cite to the Specification at for instance pages 7:11–8:13 as providing support in an algorithm (App. Br. 14, 15, Reply Br. 4–6).

We agree with the Appellants. Here, the Examiner in the rejection has failed to establish that the Specification does not provide sufficient subject matter to support the claim language. For this reason, this rejection of record is not sustained.

Rejection under 35 U.S.C. § 103(a)

The Appellants argue at page 17 of the Appeal Brief that the rejection of claim 1 is improper because the cited prior art fails to disclose the claim limitation for estimating for each of said number of product categories:

- (i) a first conditional probability that said user likes the product category by dividing said number of times an ancillary information from each of said number of product categories has been rated positive by said total positive counts summed over all of said number of product categories, and
- (ii) a second conditional probability that said user dislikes the product category by dividing said number of times an ancillary information from each of said number of product categories has been rated negative by said total negative counts summed over all of said number of product categories.

(Claim 1).

In contrast, the Examiner has determined that the cited claim limitations are shown by Dunk at paragraphs 115–121, 126–128, and Amento at paragraphs 15 and 19 (Ans. 3–8).

We agree with the Appellants. Dunk at paragraphs 115–121, for instance, discloses using a relevance engine but not with the conditional probabilities in the claimed specific manner to include the “positive counts summed over all of said number of product categories.” For this reason, the rejection of claim 1 and its dependent claims is not sustained. The remaining claims contain a similar limitation and the rejection of these claims is not sustained as well.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1–6 and 8–13 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 1–6, 8–9, and 13 under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 103(a) as listed in the Rejections section above.

DECISION

The Examiner’s rejection of claims 1–6 and 8–13 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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED