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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CATALIN GRIGOROSCU, ALEXANDRU COSTIN,
PHILLIP YDENS, MITCH GREEN, DAVID BURKETT, and
MURUGAPPAN PALANIAPPAN

Appeal 2016-006332¹
Application 12/474,341²
Technology Center 3600

Before KALYAN K. DESHPANDE, JON M. JURGOVAN, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

FINAMORE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Our Decision references Appellants' Specification ("Spec.," filed May 29, 2009), Appeal Brief ("Appeal Br.," filed Nov. 11, 2015), and Reply Brief ("Reply Br.," filed June 8, 2016), as well as the Examiner's Final Office Action ("Final Act.," mailed May 14, 2015) and Answer ("Ans.," mailed Apr. 29, 2016).

² Appellants identify Adobe Systems Incorporated as the real party in interest. Appeal Br. 4.

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellants appeal from the Examiner's decision to reject claims 1–27. We have jurisdiction under § 6(b).

We AFFIRM.

SUBJECT MATTER ON APPEAL

The invention relates to systems and methods of selecting advertisements using a local user profile. Spec., Title. Claims 1, 8, 12, 17, 23, and 24 are the independent claims on appeal. Independent claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A computer-implemented method comprising:
 - sending, via a processor of a local computer apparatus, a request for content to play on the local computer apparatus, the local computer apparatus comprising an advertisement selector component, a user profile, and a content player providing instructions embodied in a computer-readable medium which configure the local computer apparatus to play electronic content locally;
 - receiving, at the local computer apparatus, the requested content and information about possible advertisements from a remote source, the remote source remote from the local computer apparatus;
 - the advertisement selector component selecting, via the processor of the local computer apparatus, an advertisement stored in an advertisement database at the remote source, the advertisement selected using the information about possible advertisements received from the remote source and using the user profile that is maintained on the local computer apparatus and not transmitted to the remote source, wherein the information about possible advertisements received from the remote source does not include the selected advertisement;

requesting and receiving, at the local computer apparatus, the selected advertisement from the advertisement database of the remote source; and
playing the requested content and the selected advertisement on the content player of the local computer apparatus.

REFERENCES

The Examiner relies on the following prior art in rejecting the claims on appeal:

Rakavy et al. (“Rakavy”)	US 5,913,040	June 15, 1999
Leeke et al. (“Leeke”)	US 6,587,127 B1	July 1, 2003

REJECTIONS

The Examiner rejects the claims on appeal as follows:

claims 1–27 under 35 U.S.C. § 101 as non-statutory subject matter;³

claims 8–17 and 19–22 under 35 U.S.C. § 102(b) as anticipated by Rakavy; and

claims 1–7, 18, and 23–27 under 35 U.S.C. §103(a) as unpatentable over Rakavy and Leeke.⁴

³ In the Final Office Action, the heading of the rejection lists only claims 1–26 (Final Act. 2), but the “Response to Arguments” section indicates that the Examiner is rejecting claims 1–27 under 35 U.S.C. § 101 (*id.* at 27). In the Answer, the Examiner specifically addresses claim 27 (Ans. 6) and maintains the rejection of claims 1–27 under § 101 (*id.* at 7). Accordingly, we consider the omission of claim 27 from the heading of the rejection to be an oversight.

⁴ In the Final Office Action, the heading of the rejection lists claim 8 (Final Act. 15), but the body of the rejection does not discuss the claim. Furthermore, the Examiner rejects claim 8 under 35 U.S.C. § 102(b) as

ANALYSIS

Non-Statutory Subject Matter

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 implicit exceptions: “[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 Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). To “distinguish[] patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts,” the Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), which, in the first step, considers whether a claim is directed to a patent-ineligible concept, e.g., an abstract idea, and, if so, considers, in the second step, whether the claim recites an inventive concept—an element or combination of elements sufficient to ensure the claim amounts to significantly more than the abstract idea and transform the nature of the claim into a patent-eligible application. *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 132 S. Ct. at 1294, 1296–98).

As an initial matter, we are unpersuaded of error by Appellants’ argument that the Examiner’s rejection does not discuss the entirety of the claimed subject matter, the Specification, or the relevant prior art, and, therefore, does not establish a prima facie case of patent-eligible subject

anticipated by Rakavy. Accordingly, we consider the inclusion of claim 8 in the heading of the rejection to be an oversight.

matter. Appeal Br. 12. The Federal Circuit has held that an examiner establishes a prima facie case by satisfying the notice requirement set forth in 35 U.S.C. § 132. According to the court,

the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in “notify[ing] the applicant ... [by] stating the reasons for [its] rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.”

In re Jung, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (alterations in original) (quoting § 132). All that is required of the Office is to set forth the statutory basis of the rejection in a sufficiently articulate and informative manner. *Id.* at 1363; *see also Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (“Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.”).

Here, in determining that the claims are patent ineligible under 35 U.S.C. § 101, the Examiner analyzes the claims using the *Alice* two-step framework. Final Act. 2–6; Ans. 3–6. Pursuant to the first step, the Examiner determines the claims are directed to the abstract idea of “comparing and organizing information for targeted advertisement and content.” Ans. 4. In doing so, the Examiner determines the concept of “comparing and organizing information for targeted advertisement and content” is a fundamental economic practice and similar to other concepts the courts have held to be abstract ideas. *Id.* at 4, 5. Under the second step, the Examiner determines that the claims do not recite significantly more than the abstract idea because the additional elements are generic computers

performing the generic computer functions of receiving, processing, and playing information. *Id.* at 5.

As such, the Examiner sufficiently informs Appellants that the claims are ineligible. Furthermore, there is no indication that Appellants do not recognize or understand the Examiner's rejection, as Appellants' understanding is manifested in their arguments traversing it. The Examiner's rejection satisfies the notice requirement of 35 U.S.C. § 132 and sets forth a prima facie case of patent-ineligible subject matter. We, therefore, consider Appellants' remaining arguments to determine whether the Examiner erred in rejecting the claims as patent ineligible. *See Ex Parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (explaining that the Board reviews a rejection for error "based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon").

Pursuant to the first step of the *Alice* analysis, Appellants contend that the claims are not directed to an abstract idea, but instead to an Internet-specific problem of keeping user data private in a computing environment used to distribute advertisements electronically. Appeal Br. 12–13; Reply Br. 2–4. Appellants further assert that the claims are not directed to an abstract idea because the recited method of selecting advertisements from a remote database and a local user profile does not exist in the human mind or in paper form. Appeal Br. 14. Appellants' arguments do not apprise us of Examiner error.

We disagree with Appellants that the problem of keeping user data private is unique to the Internet or to the electronic distribution of advertisements. Rather, providing pertinent advertising without compromising the privacy of a user's information is a challenge with

advertising in general. Spec. ¶ 3. Furthermore, regardless of whether selecting advertisements from a remote database and a local user profile does not exist in the human mind, it is nonetheless a way of providing targeted advertising, which is a fundamental economic practice long prevalent in our system of commerce. Appellants, therefore, do not apprise us of error in the Examiner’s determination that the claims are directed to the abstract idea of “comparing and organizing information for targeted advertisement and content.”

Seeing no error in the Examiner’s determination that the claims are directed to an abstract idea pursuant to the first step of the *Alice* analysis, we turn to Appellants’ arguments under the second step. Appellants argue that the claims recite significantly more than the abstract idea because they recite a patent-eligible application of the abstract idea. Appeal Br. 14–15; Reply Br. 4–5. According to Appellants:

[T]he recited elements of “the local computer apparatus comprising an advertisement selector component, a user profile, and a content player . . . which configure the local computer apparatus to play electronic content locally” and “the remote source remote from the local computer apparatus and comprising an advertisement database” specifically show a patent-eligible application of the alleged abstract idea. These elements are directed to this specific invention, which is not disclosed in or suggested by any of the prior art of record, and ensure that the claims do not preempt other possible applications of the alleged abstract idea, thereby satisfying the purpose of the 35 U.S.C. § 101 analysis.

Appeal Br. 14–15. Appellants’ argument is not convincing.

At the outset, Appellants’ assertion that the claims do not preempt all uses of the abstract idea is not persuasive of Examiner error. Although preemption may be the basis for excluding abstract ideas from

patent-eligible subject matter, preemption is not the test for determining whether a claim is patent ineligible. *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability. For this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” (citation omitted)).

Moreover, Appellants’ reliance on the alleged novelty and nonobviousness of the claimed invention does not apprise us of error in the Examiner’s determination that the claims do not recite significantly more than the abstract idea. “It is true that ‘the § 101 patent-eligibility inquiry and, say, the § 102 novelty inquiry might sometimes overlap.’ But a claim for a *new* abstract idea is still an abstract idea.” *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016) (citation omitted) (quoting *Mayo*, 132 S. Ct. at 1304). The question in the second step of the *Alice* analysis is not whether a claim limitation is novel, but rather whether the implementation of the abstract idea involves “more than performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347–48 (Fed. Cir. 2014) (quoting *Alice*, 134 S. Ct. at 2359).

Here, as Appellants point out, the claims recite various computing components, such as “the local computer apparatus comprising an advertisement selector component, a user profile, and a content player . . . which configure the local computer apparatus to play electronic content locally” and “the remote source remote from the local computer apparatus and comprising an advertisement database.” Appeal Br. 14. Although these

components represent the computer implementation of the abstract idea, the Examiner determines, and Appellants do not refute, that the computer implementation requires nothing more than generic computer components performing computer functions that are well-understood, routine, and conventional activities, such as receiving, processing, and playing information. Ans. 5.

Indeed, Appellants' Specification explains that the disclosed applications "may be resident on any suitable computer-readable medium and execute on any suitable processor." Spec. ¶ 15. Moreover, the Specification does not describe an improvement to the computer components or infrastructure, but instead describes an improvement to advertising, i.e., providing targeted advertising while maintaining a user's privacy. *Id.* ¶ 3. As such, the claimed invention is simply the generic computer implementation of the abstract idea, which is insufficient for patent eligibility. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) ("[T]hese claims [of prior cases] in substance were directed to nothing more than the performance of an abstract business practice on the Internet or using a conventional computer. Such claims are not patent-eligible.").

Appellants also assert that the claims amount to significantly more than the abstract idea because, like the claims in *DDR Holdings*, the present claims overcome a problem specifically arising in the realm of computer networks, namely, protecting a user's private information while providing advertisements customized for the user. Appeal Br. 15. As set forth above, however, providing targeted advertising while maintaining the privacy of a user's information is not a problem unique to computer networks, but rather

an issue with advertising generally. Consequently, the present claims are not similar to the claims in *DDR Holdings*.

Appellants further argue that the claims amount to significantly more than the abstract idea because the claimed invention provides improvements to the technical field of providing customized advertisements to a user of a computer. Reply Br. 6. Appellants' argument is not persuasive of error. As set forth above, the claimed invention does not address a technical problem associated with the computer implementation of the advertising method, but instead improves the method of advertising by providing targeted advertising without compromising a user's privacy. Spec. ¶ 3.

In view of the foregoing, Appellants do not apprise us of error in the Examiner's determination that the claims are patent ineligible. Accordingly, we sustain the rejection of claims 1–27 under 35 U.S.C. § 101 as non-statutory subject matter.

Anticipation

Independent claim 8 and dependent claims 9–11

Appellants do not argue the Examiner's rejection of independent claim 8 and claims 9–11 depending therefrom. Accordingly, we sustain summarily the rejection of claims 8–11.

Independent claim 12 and dependent claims 13–16

Independent claim 12 recites

providing, from the computer apparatus to a remote recipient computer apparatus from which the request for content was received, the requested content and information about the possible advertisements in response to the request for content,

wherein the information about the possible advertisements is used by the remote recipient computer apparatus to select, request, and receive an advertisement from the advertisement database of the computer apparatus.

Appeal Br., Claims App. Appellants argue that Rakavy does not disclose the “providing” step of independent claim 12 because Rakavy does not disclose a remote recipient computer apparatus selecting an advertisement stored on another computer apparatus or a remote recipient computer apparatus selecting an advertisement using information about advertisements received from another computer apparatus. Appeal Br. 16–21; Reply Br. 7–9. Appellants’ arguments are convincing.

In finding that Rakavy anticipates independent claim 12, the Examiner relies on Local Computer 500 and Advertising System Server 600 for disclosing the “remote recipient computer apparatus” and “computer apparatus,” respectively. Final Act. 9–10. With respect to the “providing” step, the Examiner finds that Advertisement Display Manager 210 selects advertisements from the User Preference and Advertisements Database 230. *Id.* at 10 (citing Rakavy 7:30–61, Fig. 4). The cited portions of Rakavy, however, disclose that Advertisement Display Manager 210 and User Preference and Advertisements Database 230 are both part of Local Computer 500 such that Advertisement Display Manager 210 does not select advertisements from a database of another computer, as recited in the “providing” step. Furthermore, the cited portions of Rakavy do not disclose that the Advertisement Display Manager 210 uses information received from another computer to select an advertisement, as the “providing” step requires.

The Examiner additionally finds, in regard to the “providing” step, that “Rakavy in column 9, lines 63-67, further discloses the Job Man[a]ger 720 ... matches the user preference and configuration data against the category information (information about possible advertisement) for available advertisements ... advertisement 50 matching the user’s high priority categories and platform capability are selected for downloading ...).” Ans. 8. Even if Rakavy’s Job Manager 720 uses certain information to select an advertisement, the cited portion of Rakavy discloses that Job Manager 720 is on Advertising System Server 600, i.e., the “computer apparatus,” not on Local Computer 500, i.e., the “remote recipient computer apparatus,” as the “providing” step requires. Rakavy 9:63. Furthermore, the cited portion of Rakavy does not disclose selecting an advertisement from another computer’s database, as recited in the “providing” step.

In view of the foregoing, the Examiner has not sufficiently shown that Rakavy discloses the “providing” step of independent claim 12. We, therefore, do not sustain the Examiner’s rejection of independent claim and claims 13–16 depending therefrom.

Independent claim 17 and dependent claims 19–22

Appellants argue Rakavy does not disclose the “updating” step of independent claim 17. Appeal Br. 22–24; Reply Br. 11–12. Appellants’ argument is convincing.

The “updating” step of independent claim 17 recites, *inter alia*, “wherein the user profile is maintained locally on the local computer apparatus and not provided to remote computer devices.” Appeal Br.,

Claims App. As such, independent claim 17 requires that the user profile is not provided to remote computer devices.

In finding that Rakavy discloses the claimed “updating” step, the Examiner relies on Rakavy’s user preferences for disclosing the claimed “user profile.” Final Act. 13; Ans. 9. Rakavy, however, teaches that Local Computer 500 uploads user preference information to the Advertising System Server 600 so that the Advertising System Server 600 can use the information to select the next Advertisement 50 for download to Local Computer 500. Rakavy 5:42–47. Given that Rakavy discloses providing the user preferences to Advertising System Server 600, Rakavy does not disclose a user profile that is not provided to remote computer devices, as recited in the “updating” step.

In view of the foregoing, the Examiner has not sufficiently shown that Rakavy discloses the “updating” step of independent claim 17. We, therefore, do not sustain the Examiner’s rejection of independent claim 17 and claims 19–22 depending therefrom.

Obviousness

Dependent claim 18

Claim 18 depends from independent claim 17. Appeal Br., Claims App. The Examiner does not rely on Leeke in any way that cures the deficiency in the rejection of independent claim 17 discussed above. Accordingly, we do not sustain the rejection of claim 18.

Independent claims 1, 23, and 24 and dependent claims 2–7 and 25–27

Independent claim 1 recites a “user profile that is maintained on the local computer apparatus and not transmitted to the remote source.”

Appeal Br., Claims App. Independent claim 23 similarly recites a “user profile that is maintained locally on the computer apparatus and not provided to the remote computer device,” and independent claim 24 likewise recites a “user profile that is maintained locally on the local computer apparatus and not provided to the remote source.” *Id.* Consequently, like independent claim 17, each of independent claims 1, 23, and 24 requires that the user profile is not provided to the remote source.

As discussed above with respect to independent claim 17, Rakavy does not disclose a user profile that is not provided to a remote source. The Examiner does not rely on Leeke in any manner that cures this deficiency of Rakavy. Accordingly, we do not sustain the Examiner’s rejection of independent claims 1, 23, and 24 and claims 2–7 and 25–27 depending therefrom.

DECISION

The Examiner’s decision to reject claims 1–27 under 35 U.S.C. § 101 is affirmed.

The Examiner’s decision to reject claims 8–11 under 35 U.S.C. § 102(b) is affirmed.

The Examiner’s decision to reject claims 12–17 and 19–22 under 35 U.S.C. § 102(b) is reversed.

The Examiner’s decision to reject claims 1–7, 18, and 23–27 under 35 U.S.C. § 103(a) is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED