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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SEAN MICHAEL BRUICH and FREDERICK ROSS LEACH

Appeal 2016-006500
Application 13/713,459¹
Technology Center 3600

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and NINA L. MEDLOCK, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1–3, 8, 10–12, 14, 15, and 21–25. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

¹ Appellant is the Applicant, Facebook, Inc., which, according to the Appeal Brief, is the real party in interest. Appeal Br. 1.

THE INVENTION

Appellant claims a computer-implemented method for generating metrics for one or more advertisements based on ownership of client devices. Spec. 4.

Claim 1 reproduced below, is representative of the subject matter on appeal.

1. A computer-implemented method comprising:
 - receiving communications from one or more client devices, each communication including user information identifying a user of a social networking system and information describing one or more characteristics of a client device;
 - for each received communication,
 - determining a type of the client device based on the information describing one or more characteristics of the client device,
 - determining a frequency with which the user identified by the user information accesses the social networking system through the client device, and
 - determining that the user identified by the user information is the owner of the client device when the frequency is above a threshold;
 - selecting a particular type of client device that is determined to be owned by at least a subset of the users identified by the received communications;
 - identifying one or more exposures of the subset of the users to an advertisement presented in the social networking system; and
 - generating, using a computing device, metrics for the advertisement based on the one or more exposures, the metrics indicating an effectiveness of the advertisement with respect to owners of the particular type of client device.

THE REJECTIONS

The following rejections are before us for review.

Claims 1–3, 8, 10–12, 14–15, and 21–25 are rejected under 35 U.S.C. § 101 as being directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more.

Claims 1–3, 8, 10–12, 14, and 21–25 are rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Nath et al. (US 2011/0258303 A1; publ. Oct. 20, 2011) (“Nath”), in view of Tom Demers, *Google AdWords Quick Wins: Two Reports that Could Save You Thousands*, Internet Marketing Blog, 1–6 (Jan. 4, 2012) (retrieved from <http://www.wordstream.com/blog/ws/2012/01/04/adwords-quick-wins>) (last visited Oct. 24, 2014) (“Tom”), in view of Turpin et al. (US 2008/0189169 A1; publ. Aug. 7, 2008) (“Turpin”), in further view of Toebes et al. (US 2013/0147602 A1; publ. June 13, 2013) (“Toebes”).

Claim 15 is rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Nath in view of Tom, in view of Toebes, in further view of Official Notice.

ANALYSIS

35 U.S.C. § 103(a) REJECTION

Claims 1, 11, and 21 recite, in pertinent part, the steps of,

determining a frequency with which the user identified by the user information accesses the social networking system through the client device, and

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determining that the user identified by the user information is the owner of the client device when the frequency is above a threshold.

(Emphasis added).

The Examiner found that this limitation is disclosed in paragraph 3 of Toebes citing,

the user of a mobile phone is often presumed to be the owner of the account associated with the mobile phone because mobile phones are usually not shared. Based on this presumption, there is generally a single set of user preferences associated with a mobile phone and any services or applications accessed by the phone. In other instances, e.g., on a shared system or device, user identity can be determined based on the user entering login credentials Therefore, Toebes does in fact teach “determining a frequency with which the user identified by the user information accesses the social networking system through the client device” or “determining that the user identified by the user information is the owner of the client device when the frequency is above a threshold[.]”

(Answer 7–8).

Appellant argues:

But these cited portions are silent regarding the use of any “frequency,” let alone the claimed “determining a frequency with which the user identified by the user information accesses the social networking system through the client device” and “determining that the user identified by the user information is the owner of the client device when the frequency is above a threshold,” as recited in the claims. Toebes relies on biometric data to identify a user holding a device, and does not used a “frequency . . . above a threshold” to determine “that the user . . . is the owner of the client device,” as is claimed.

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(Appeal Br. 14).

We agree with Appellant. First, we do not agree with the Examiner's claim construction that the independent claims offer an alternative condition. Each of the independent claims recites, "determining a frequency with which the user identified by the user information accesses the social networking system through the client device, *and* determining that the user identified by the user information is the owner of the client device when the frequency is above a threshold" (emphasis added). As is clear from the claim language, these claims require the word "and" and not the alternative "or," as the Examiner proposes. Thus, the claim limitation of "determining that the user identified by the user information is the owner of the client device when the frequency is above a threshold" is a positive limitation. We fail to see where the Examiner has mapped this limitation as a positive limitation to the prior art. Even looking to paragraph 3, which the Examiner indicates as disclosing this limitation (Answer 7–8), we find nothing in paragraph 3 of Toebes which discloses a "threshold." At best, Toebes in paragraph 3 only discloses a credential based preference application based on identifying a user device, e.g., "[b]ased on the credentials entered, a set of user preferences for the user associated with those credentials can be loaded and the user's identity can also be made available to applications on the computer."

Thus, we will not sustain the rejection of independent claims 1, 11, and 21. Because claims 2, 3, 8, 10, 12, 14, 15, 22, 23, 24, and 25 depend

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from one of claims 1, 11, and 21 we, likewise cannot sustain the rejections of those claims.

35 U.S.C. § 101 REJECTION

We will sustain the rejection of claims 1–3, 8, 10–12, 14–15, and 21–25 under 35 U.S.C. § 101.

The Supreme Court

set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, . . . determine whether the claims at issue are directed to one of those patent-ineligible concepts If so, we then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, . . . 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. . . . [The Court] 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.”

Alice Corp., Pty. Ltd. v. CLS Bank Int’l, 134 S. Ct. 2347, 2355 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 72–73 (2012)).

To perform this test, we must first determine whether the claims at issue are directed to a patent-ineligible concept.

Although the Court in *Alice* made a direct finding as to what the claims were directed to, we find that this case’s claims themselves and the

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Specification provide enough information to inform one as to what they are directed to.

The steps in claim 1 result in: generating, using a computing device, metrics for the advertisement based on the one or more exposures, the metrics indicating an effectiveness of the advertisement with respect to owners of the particular type of client device.

The Specification further states:

Advertisers are frequently interested in measuring the effectiveness of their advertisements on different groups of people. For example, an advertiser may be interested in measuring the effectiveness of its advertisements presented to owners of various client devices. To generate metrics describing the effectiveness of advertising, associations between exposure to advertisements and ownership of the client devices are needed. Determining device ownership and advertisement associations is generally a manual process that is often subject to reporting inaccuracies. Accordingly, conventionally generating advertising metrics based on client device ownership is a laborious task producing imprecise results.

Spec. ¶ 3. The Specification describes,

[i]n one embodiment, the data is obtained based on answers to polls provided to users identified as client device owners 102. For example, a poll includes questions asking for impressions about the advertisements to which a client device user was exposed or asking for impressions about a brand, product, or service associated with the advertisements, or other suitable information.

Spec. ¶ 47. Thus, all this evidence shows that claim 1 is directed to determining effectiveness of an advertisement with respect to owners of the

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particular type of client device. It follows from prior Supreme Court cases, and *Gottschalk v. Benson*, 409 U.S. 63 (1972) in particular, that the claims at issue here are directed to an abstract idea. Determining the effectiveness of an advertisement with respect to owners of the particular type of client device is a fundamental economic practice of a transaction because the more successful an advertisement is, the higher probability the sale will occur. The patent-ineligible end of the 35 U.S.C. § 101 spectrum includes fundamental economic practices. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2355–57. Also, we find the steps of:

- determining a type of the client device based on the information describing one or more characteristics of the client device;

- determining a frequency with which the user identified by the user information accesses the social networking system through the client device, . . .

- determining that the user identified by the user information is the owner of the client device when the frequency is above a threshold;

- selecting a particular type of client device that is determined to be owned by at least a subset of the users identified by the received communications; [and]

- identifying one or more exposures of the subset of the users to an advertisement presented in the social networking system . . .

constitute physical acts by a human and/or “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir.

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2016). *See also buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (claims directed to certain arrangements involving contractual relations are directed to abstract ideas). Thus, determining the effectiveness of an advertisement with respect to owners of the particular type of client device is an “abstract idea” beyond the scope of § 101.

As in *Alice Corp. Pty. Ltd.*, we need not labor to delimit the precise contours of the “abstract ideas” category in this case. It is enough to recognize that there is no meaningful distinction in the level of abstraction between the concept of an intermediated settlement in *Alice Corp. Pty. Ltd.* and the concept of determining effectiveness of an advertisement with respect to owners of the particular type of client device, at issue here. Both are squarely within the realm of “abstract ideas” as the Court has used that term. That the claims do not preempt all forms of the abstraction or may be limited to determining effectiveness of an advertisement with respect to owners of the particular type of client device, does not make them any less abstract. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1360–61 (Fed. Cir. 2015).

Claims 1, 11 and 21, unlike the claims found non-abstract in prior cases, use generic computer technology to perform data reception, transmission, and linkage and do not recite an improvement to a particular computer technology. *See, e.g., McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (finding claims not abstract

because they “focused on a specific asserted improvement in computer animation”).

The introduction of a computer into the claims does not alter the analysis at *Mayo* step two.

the 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. Nor is limiting the use of an abstract idea “to a particular technological environment.” Stating an abstract idea while adding the words “apply it with a computer” simply combines those two steps, with the same deficient result. Thus, if a patent’s recitation of a computer amounts to a mere instruction to “implement[t]” an abstract idea “on . . . a computer,” that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our § 101 jurisprudence. Given the ubiquity of computers, wholly generic computer implementation is not generally the sort of “additional feature[e]” that provides any “practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.”

Alice Corp. Pty. Ltd., 134 S. Ct. at 2358 (alterations in original) (citations omitted).

“[T]he relevant question is whether the claims here do more than simply instruct the practitioner to implement the abstract idea . . . on a generic computer.” *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2359. They do not.

Taking the claim elements separately, the function performed by the computer at each step of the process is purely conventional. Using a computer to take in data, compute a result, and return the result to a user

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amounts to electronic data query and retrieval—some of the most basic functions of a computer. All of these computer functions are well-understood, routine, conventional activities previously known to the industry. In short, each step does no more than require a generic computer to perform generic computer functions.

Considered as an ordered combination, the computer components of Appellant’s method add nothing that is not already present when the steps are considered separately. The sequence of data reception-analysis-access is equally generic and conventional or otherwise held to be abstract. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (sequence of receiving, selecting, offering for exchange, display, allowing access, and receiving payment recited an abstraction); *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (sequence of data retrieval, analysis, modification, generation, display, and transmission); *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017) (sequence of processing, routing, controlling, and monitoring). The ordering of the steps is, therefore, ordinary and conventional.

Viewed as a whole, Appellant’s claims simply recite the concept of determining effectiveness of an advertisement with respect to owners of the particular type of client device. The claims do not, for example, purport to improve the functioning of the computer itself. Nor do they effect an improvement in any other technology or technical field. Instead, the claims

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at issue amount to nothing significantly more than instructions to determine the effectiveness of an advertisement with respect to owners of the particular type of client device. Under our precedents, that is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360.

As to the structural claims, they are no different from the method claims in substance. 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. This Court has long “warn[ed] . . . against” interpreting § 101 “in ways that make patent eligibility ‘depend simply on the draftsman’s art.’” *Alice Corp. Pty. Ltd.*, 134 S. Ct. at 2360 (alterations in original) (citation omitted).

We have reviewed all the arguments (Appeal Br. 4–11) Appellant has submitted concerning the patent eligibility of the claims before us which stand rejected under 35 U.S.C. § 101. We find that our analysis above substantially covers the substance of all the arguments which have been made. But, for purposes of completeness, we will address various arguments in order to make individual rebuttals of same.

Appellant argues:

First, the Office Action errs by failing to explain why the Office Action's proposed abstract idea is considered an exception and does not does not provide any explanation of how ‘generating advertising metrics based on device type’ is a or a fundamental economic practice....

A proper identification of a judicial exception must be similar to

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at least one concept previously identified by the courts. However, the Office Action has not identified how the present claims are similar to fundamental economic practices previously identified by the courts and set forth in the December Guidance and July Update.

Instead, the Office Action's statement itself is the only explanation provided of how the proposed abstract idea is a fundamental economic practice. This conclusory analysis fails to properly establish the reasoning for the rejection and fails to meet the burden under 35 U.S.C. § 132 to provide notice and reasons for the rejection.

(Appeal Br. 6).

We disagree with Appellant. All that is required of the Office to meet its prima facie burden of production is that the examiner “notify the applicant,” “stating the reasons for such rejection,” “together with such information and references as may be useful in judging the propriety of continuing prosecution of his application.” 35 U.S.C. § 132. *See also In re Jung*, 637 F.3d 1356 at 1363(Fed. Cir. 2011). The Examiner has done this here. *See* Final Act. 3, 4.

Also, Appellant’s argument is not persuasive at least because there is no absolute requirement that an examiner provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea.² Although evidence may be helpful, e.g., where facts are in

² *See, e.g.*, MPEP § 2106.07(a)(III) (2018) (“The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a question of law. . . . Thus, the court does not require ‘evidence’ that a

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dispute, it is not always needed. *See Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1325–26 (Fed. Cir. 2016) (“[I]t is also possible, as numerous cases have recognized, that a § 101 analysis may sometimes be undertaken without resolving fact issues”). Appellant’s bare assertion here that evidence is needed, without any supporting reasoning as to why, is insufficient to require the Examiner to provide evidentiary support.

Appellant also argues,

The claims of *DDR Holdings* [and] the claims of this application are similar in that they both recite methods for detecting various forms of data and data objects, processing the data and data objects, and providing a product of the processing to computer users. As explained above, the invention addresses problems with advertising that are specific to the online environment, and it addresses them with a solution that only makes sense in this environment. Consequently, the claims of this application “overcome a problem specifically arising in the realm of computer networks.”

(Appeal Br. 9–10).

We disagree with Appellant. In light of the breadth of the claim, the Appellant’s argument is not persuasive as to error in the rejection because first, for example, claim 1 does not even require an internet connection as was present in *DDR*. Second, in *DDR*, the claims at issue involved, *inter*

claimed concept is a judicial exception, and generally decides the legal conclusion of eligibility without resolving any factual issues” (citations omitted).)

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alia, “web pages displays [with] at least one active link associated with a commerce object associated with a buying opportunity of a selected one of a plurality of merchants” (claim 1 of US 7,818,399 B1). There is no such claim element with this degree of detail here before us. All that is required by the claims before us are generically recited “client devices” and “computing devices.” The Specification supports the view that such devices are conventional. *See, e.g.*, Spec. ¶¶ 4–8, 19, 21.

The question is whether the claims as a whole “focus on a specific means or method that improves the relevant technology” or are “directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016). In this case, claim 1, as a whole, is focused on determining “an effectiveness of the advertisement with respect to owners of the particular type of client device.”

Appellants argue,

On page 4, the Answer further states that ‘The concept of generating advertising metrics based on device type is well-known and conventional in the field of advertising and therefore the abstract idea is deemed fundamental in this field.’ The Answer does not provide any evidence or even an explanation of why ‘generating advertising metrics based on device type’ is fundamental or why it is foundational or basic, and therefore fails to demonstrate that it qualifies as a fundamental economic practice.

Reply Br. 3.

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Again, as stated above, there is no absolute requirement that an examiner provide evidentiary support in every case before a conclusion can be made that a claim is directed to an abstract idea.³

CONCLUSIONS OF LAW

We conclude the Examiner did not err in rejecting claims 1–3, 8, 10–12, 14, 15, and 21–25 under 35 U.S.C. § 101.

We conclude the Examiner did err in rejecting claims 1–3, 8, 10–12, 14, 15, and 21–25 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 1–3, 8, 10–12, 14, 15, and 21–25 is affirmed.

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. § 1.136(a)(1)(iv).

AFFIRMED.

³ *See, supra* note 2.