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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JORDAN IAN GROSSMAN

Appeal 2016-007058
Application 12/133,357¹
Technology Center 3600

Before ST. JOHN COURTENAY III, JUSTIN BUSCH, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Final Rejection of claims 20–28 and 30–41, which constitute all of the claims pending in this application. Claims 1–19 and 29 have been cancelled. App. Br. 20, 21 (Claims App’x.). We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellant is the Applicant, Jordan Ian Grossman, and is identified in the Appeal Brief as the real party in interest. App. Br. 1.

THE INVENTION

The disclosed and claimed invention is directed “to target[ed] advertising, and in particular, the invention relates to presenting advertisements based on viewing patterns.” Spec. 1:3–4.

Claim 20, reproduced below, is illustrative of the claimed subject matter:

20. A method in a data processing system having at least one processor and memory coupled with the at least one processor for targeting advertisements to a plurality of recipients, the method comprising the steps of:

selecting for presentation to a particular one recipient of the plurality of recipients, by the data processing system, at least one advertisement from a plurality of advertisements in accordance with a presentation alteration history of the plurality of advertisements;

detecting, by the data processing system, a presentation alteration event associated with the selected advertisement, the presentation alteration event originating from the particular one recipient of the plurality of recipients upon a presentation of the selected advertisement to the particular one recipient;

in response to the detection, selecting for at least one other recipient of the plurality of recipients at least another one advertisement of the plurality of advertisements as an advertisement to be subsequently presented to the at least one other recipient of the plurality of recipients; and

presenting the at least another one advertisement of the plurality of advertisements to the at least one other recipient of the plurality of recipients.

REFERENCES

The prior art relied upon by the Examiner as evidence in rejecting the claims on appeal is:

Plotnick	US 2002/0178447 A1	Nov. 28, 2002
Swix	US 6,718,551 B1	Apr. 6, 2004

REJECTIONS

Claims 20–28 and 30–41 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 5–6.

Claims 20–28 and 30–41 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Swix in view of Plotnick. Final Act. 6–12.

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellant’s arguments that the Examiner erred. In reaching this decision, we have considered all evidence presented and all arguments made by Appellant. We are not persuaded by Appellant’s arguments regarding claims 20–28 and 30–41, and, instead, we incorporate herein and adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken (Final Act. 5–12), and (2) the reasons and rebuttals set forth in the Examiner’s Answer in response to Appellant’s arguments (Ans. 10–12). We incorporate such findings, reasons, and rebuttals herein by reference unless otherwise noted. However, we highlight and address specific findings and arguments for emphasis as follows.

Section 101 Rejection

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, 70–71 (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*, 132 S. Ct. at 1297–98). 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*, 132 S. Ct. at 1294).

The Supreme Court set 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*,] 132 S. Ct., at 1296–1297. If so, we then ask, “[w]hat else is there in the claims before us?” *Id.*, at —, 132 S. Ct., at 1297. 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 —, 132 S. Ct., at 1298, 1297. 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 —, 132 S. Ct., at 1294.

Id.

“The ‘abstract idea’ step of the inquiry calls upon us to look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Tex. v. DirectTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016)); *see also Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). There is no definitive rule to determine what constitutes an “abstract idea.” Rather, the Federal Circuit has explained that “both [it] and the Supreme Court have found it sufficient to compare claims at issue to those claims already found to be directed to an abstract idea in previous cases.” *Enfish*, 822 F.3d at 1334; *see also Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (explaining that, in determining whether claims are patent eligible under § 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”).

The Examiner concludes claim 20 is directed to the abstract idea of “targeting advertisements to a recipient” and the “claims do not effect an improvement to another technology or technical field” and “do not amount to an improvement to the functioning of a computer itself.” Final Act. 6; *see also* Ans. 10. The Examiner further concludes that “[t]he creation of target[ed] advertisements to a recipient, as recited in the independent claims, is similar to an idea of itself found by the courts to be abstract ideas (*e.g.*,

comparing new and stored information and using rules to identify options in *SmartGene*^[2].” Ans. 10

Appellant argues the Examiner erred in finding claim 20 is directed to an abstract idea. App. Br. 5–10; Reply Br. 1–7. According to Appellant, “claim 20 encompasses more than just a mere statement of a concept, and describes a specific application and implementation rather than just an abstract idea itself.” App. Br. 5. Appellant argues claim 20 “is directed to targeting advertising to a plurality of recipients employing the data processing unit’s ability to generate the target advertisement for a particular one recipient as a function of a prior presentation alteration event of another — different — recipient” and, as such, is not one of the examples of an abstract idea set forth in *Alice*. *Id.* at 5–6.

Appellant further argues because claim 20 “provides novel and non-obvious improvements that go well beyond simply retrieving and combining data using a computer,” the claims are not directed to the use of an abstract idea. *Id.* at 8–9.

In the Reply Brief, Appellant also asserts the claims at issue are like those found not to be directed to an abstract idea in *Enfish*. Reply Br. 3–7. Specifically, Appellant argues that, similar to the claims in *Enfish*, the pending claims are directed to an improvement in computer technology:

As noted above, the pending claims are directed to embodiments for targeting advertising to a plurality of recipients employing the data processing unit’s ability to generate the target advertisement for a particular one recipient as a function of a prior presentation alteration event of another — different — recipient. Importantly, the claimed

² *SmartGene Inc. v. Adv. Bio. Labs. SA*, 555 Fed. Appx. 950 (Fed. Cir. 2014).

embodiments recite a number of selecting and detecting operations performed by the data processing system (e.g., provider system 110, as shown in FIGs. 1 and 3) where the operations utilize a central processing unit (e.g., CPU 302), a memory (e.g., memory 306 storing provider program 320) and a data storage device (e.g., data storage device 308 storing advertisement database 330 and recipient database 332). **The interplay between the CPU and the respective databases/memories, in accordance with the claimed embodiments, serve to demonstrate a similar improvement to computer functionality itself as in *Enfish* that is similarly bolstered by the teachings of Applicant’s Specification in support of the claimed embodiments.**

Id. at 4–5 (emphasis added).

We are not persuaded by Appellant’s argument that the Examiner erred. To the contrary, we agree with the Examiner that the claim is directed to targeted advertising which controls the content provided to users.³ As our reviewing court has held, “tailoring of content based on information about the user” is an abstract idea. *Affinity*, 838 F.3d at 1271 (citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369 (Fed. Cir. 2015)); *see also Morsa v. Facebook, Inc.*, 77 F. Supp.3d 1007, 1013–14 (C.D. Cal. 2014) (concluding that targeted advertising is an abstract idea). Although Appellant states the various steps of the claims encompass more than an abstract idea, we determine that, like limitations in *Ultramercial*, those steps “recite an abstraction—an idea, having no particular concrete or

³ We note this is substantially the same as Appellant’s identification of what the claims are directed to. *Compare with* App. Br. 5 (arguing that “the claim is directed to targeting advertising to a plurality of recipients employing the data processing unit’s ability to generate the target advertisement for a particular one recipient as a function of a prior presentation alteration event of another — different — recipient”).

tangible form,” namely that of “showing an advertisement.” *Ultramercial Inc. v. Hulu LLC*, 722 F.3d 1335, 1346 (Fed. Cir. 2013), *vacated and remanded*, *Wildtangent, Inv. v. Ultramercial LLC*, 134 S. Ct. 2870 (2014) (remanding for consideration in light of *Alice*, 134 S. Ct. 2347). And, although certain additional limitations add particularity to the claims, they do nothing to change the underlying idea.

We are also not persuaded by Appellant’s argument that the claimed invention is not abstract because it is novel and non-obvious. First, a novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304. Second, as discussed below, we sustain the Examiner’s rejection of the claims as unpatentable as obvious.

We are also not persuaded by Appellant’s comparison of the claims in the pending application to those in *Enfish*. In *Enfish*, the Federal Circuit relied on the distinction made in *Alice* between computer functionality improvements and uses of existing computers as tools in aid of processes focused on “abstract ideas.” *See Enfish*, 822 F.3d at 1335–36 (“[T]he first step in the *Alice* inquiry in this case asks whether the focus of the claims is on the specific asserted improvement in computer capabilities (i.e., the self-referential table for a computer database) or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.”); *see also Alice*, 134 S. Ct. at 2358–59.

The present case is different from *Enfish* because the focus of the claims here is not on an improvement in computers as tools or upon an innovative way to use computers or other devices, but is focused on an independently abstract idea that uses generic and routine equipment as tools;

that abstract idea being collecting and processing data relating to presentation alteration events. That is, here the arguably innovative technique of the appealed claims is inextricably a part of the abstract idea of manipulating data itself to decide which targeted advertisements to show. Moreover, nothing in the claims, understood in light of the Specification, requires anything other than an off-the-shelf, conventional computer used for collecting and processing/analyzing various information/data. Therefore, unlike in *Enfish*, the claims are directed not to improvement in computer capabilities, but to the results of applying an abstract idea.

The Examiner further concludes that “the claims, when considered as a whole, are nothing more than the instruction to implement the abstract idea (i.e., targeting advertisements to a recipient) in a particular, albeit well-understood, routine and conventional technological environment.” Final Act. 6.; *see also* Ans. 10–11. More specifically, the Examiner determines that the claims “merely amount to the application or instructions to apply the abstract idea of targeting advertisements to a recipient on a computer, and is considered to amount to nothing more than requiring a generic computer system to merely carry out the abstract idea itself.” Ans. 10–11.

Appellant argues claim 20 “recites meaningful limitations that go well beyond merely providing instructions to apply the abstract idea on a generic computer.” App. Br. 7; *see also id.* at 9 (“Independent claim 20 has meaningful limitations that elevate the claim beyond any reasonable interpretation of a generic computer performing generic/routine/conventional activities.”). Appellant contends the steps in claim 20 “are meaningful limitations and when viewed either individually or

as an ordered combination together with the other recited method steps, amount to significantly more than the abstract idea.” *Id.* at 9.

Although Appellant asserts that the claims recite something more than the abstract idea, Appellant does no more than recite or summarize the claim limitations without explaining how those limitations, either individually or in combination, result in something more. It is well settled that mere attorney arguments and conclusory statements, which are unsupported by factual evidence, are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) (attorney argument is not evidence). Accordingly, we are not persuaded by Appellant’s argument that the Examiner erred. Instead, we agree with the Examiner that claim 20 does not recite sufficient additional elements beyond the recitation of the abstract idea to transform the nature of the claim into a patent-eligible application.

Accordingly, we sustain the Examiner’s rejection of representative claim 20 as directed to patent-ineligible subject matter, along with the rejections of claims 31 and 41, which are argued based on the same reasons (App. Br. 10, 11), and claims 21–30 and 32–40, which are not separately argued (*id.* at 11–12). *See* 37 C.F.R. § 41.37(c)(1)(iv).

Section 103 Rejection

Appellant argues the Examiner erred in finding Swix teaches using a presentation alteration history to select content, such as an advertisement. App. Br. 13–15. More specifically, Appellant argues “Swix employs a ‘static’ advertising population and selection process that is focused on a particular viewer, that viewer’s activity (e.g., pay-per view activity) and an

associated demographic group.” *Id.* at 14. Appellant further argues that the Examiner erred in equating “Swix’s ‘an event list of every viewing selection made by the subscriber up to the ordering of the movie’ with the claimed ‘presentation alteration event’ in the rejection of the claims.” *Id.*

The Examiner finds Swix teaches selecting an advertisement based on a presentation alteration history of the plurality of advertisements. Final Act. 7 (citing Swix 12:25–31, 12:37–53); *see also id.* at 4; Ans. 11–12. More specifically, the Examiner finds:

Swix . . . teaches that the presentation alteration data of a one recipient (i.e., “an event list of every viewing selection made by the subscriber up to the ordering of the movie . . . includ[ing] commercials turned off”) is an indicator for the likelihood that other recipients will exhibit the same or substantially the same interest to that advertisement (i.e., “profile processor 104 analyzes the event data and additional data, classifies the viewer in a certain demographic group, and delivers a commercial targeted for that group.”).

Ans. 11–12.

During examination of a patent application, a claim is given its broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quotations omitted). There is a presumption that a claim term carries its ordinary and customary meaning. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An applicant may rebut this presumption, however, by acting as his own lexicographer, providing a definition of the term in the specification with “reasonable clarity, deliberateness, and precision.” *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from

common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *see also Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008) (“A patentee may act as its own lexicographer and assign to a term a unique definition that is different from its ordinary and customary meaning; however, a patentee must clearly express that intent in the written description.”).

In the absence of such a definition, limitations are not to be read from the specification into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). “[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. . . . [C]laims may embrace ‘different subject matter than is illustrated in the specific embodiments in the specification.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc) (citations omitted).

Although the term “presentation alteration” is not used in the Specification, the Specification provides examples of alterations in the presentation. For example, the Specification states that “the provider identifies when recipients alter the normal presentation of advertisements, *such as by fast-forwarding through or interrupting advertisements*. If a recipient fast-forwards or interrupts through an advertisement, it is likely that the advertisement is ineffective to the respective recipient.” Spec. 9:1–4 (emphasis added). Similarly, in describing Figure 6, the Specification states that “if the provider program receives a message that the program presentation has been altered (*e.g., by fast-forwarding or interruption*) in step 606, then the provider program uses this information to determine one

or more subsequent advertisements (step 610).” Spec. 13:5–7 (emphasis added); *see also* Fig. 6, step 606 (“INTERRUPT OR FAST-FORWARDED?”).

Although the Specification discusses interruptions and fast-forwarding as examples of alterations to the presentation, it does not use language that denotes an exclusive list. For example, the Specification qualifies the discussion by using “such as” and “e.g.,” which is exemplary, non-limiting language. Therefore, although the broadest reasonable interpretation of presentation alteration encompasses interrupting and fast-forwarding, it is not limited to those two examples. Instead, it is broad enough to encompass any type of alteration in the presentation of a commercial.⁴

Swix teaches creating an event list which includes information such as “commercials viewed[] and *commercials turned off*.” Swix 12:25–31. Swix further teaches that the “profile processor **104** analyzes the event data . . . and delivers a commercial targeted for that group.” *Id.* at 12:37–53. Stated differently, Swix teaches choosing a commercial to be shown to a group based on data that includes which commercials are turned off. Because the claim limitation “presentation alteration” is broad enough to encompass interrupting the presentation of a commercial by turning it off, we are not persuaded by Appellant’s argument that the Examiner erred.

Appellant further argues “Plotnick is focused on a single subscriber and that subscriber’s behavior for targeting ads thereto – not to another subscriber.” App. Br. 15. Therefore, according to Appellant, Plotnick does

⁴ Because “applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee.” *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007) (citation omitted).

not teach or suggest using information relating to one person as an “indicator for the likelihood that other recipients will exhibit the same or substantially the same interest to that advertisement and/or advertisements similar in nature” and selecting an advertisement for another person based on a presentation alteration by the first person. *Id.*

Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). The test for obviousness is not whether the claimed invention is expressly suggested in any one or all of the references, but whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the *combined teachings* of those references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Because the Examiner relies on Swix, not Plotnick, for teaching selecting advertisements to be shown to another member of the group (Final Act. 7), Appellant is improperly arguing the references individually. Therefore, we are not persuaded by Appellant’s argument that the Examiner erred.

Accordingly, we sustain the Examiner’s rejection of representative claim 20 as unpatentable over Swix in view of Plotnick, along with the rejections of claims 31 and 41, which are argued based on the same reasons (App. Br. 17, 18), and claims 21–30 and 32–40, which are not separately argued (*id.* at 18). *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appeal 2016-007058
Application 12/133,357

DECISION

For the above reasons, we affirm the Examiner's decisions rejecting claims 20–28 and 30–41.

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