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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* HIKARU PHILLIPS and CLAUDIO NATOLI

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Appeal 2016-007516  
Application 12/848,780<sup>1</sup>  
Technology Center 3600

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Before JAMES R. HUGHES, JOHN A. EVANS, and  
JAMES W. DEJMEK, *Administrative Patent Judges*.

DEJMEK, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 1, 4–10, 12–14, 16–21, and 23–25. Appellants have canceled claims 2, 3, 11, 15, and 22. *See* Final Act. 2. We have jurisdiction over the remaining pending claims under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> Appellants identify Accenture Global Services Limited as the real party in interest. App. Br. 3.

## STATEMENT OF THE CASE

### *Introduction*

Appellants' disclosed and claimed invention relates to "a marketing optimization system . . . configured to trigger offline marketing actions based on captured online behavior and customizable trigger events." Spec. ¶ 13. According to the Specification, an offline marketing action includes any action that is performed "off the web site," such as sending marketing information via postal mail, email, or by a text message. Spec. ¶ 14. In a disclosed embodiment, a user interface allows a user (i.e., person running a marketing campaign) to create, modify, and store trigger events. Spec. ¶ 16. The trigger events may include conditions associated with the online behavior of a website user. Spec. ¶ 15.

Claim 1 is representative of the subject matter on appeal and is reproduced below:

1. A system for triggering one or more offline marketing actions based on online behavior, the system comprising:

a processor, and

a storage device coupled to the processor, wherein the processor:

creates and stores, in the storage device, variables describing aspects of captured online behavior of visitors to a web site, wherein to create the variables, the processor generates a graphical user interface that presents predetermined syntaxes describing online behaviors and conditions relating to the variables, and receives, through the graphical user interface, an expression to define each variable that includes at least one of the predetermined syntaxes, wherein the at least one predetermined syntax includes an available operation comprising at least one of Facts-After, Facts-Before, Facts-Matching-Regex [sic], Find-All-Facts-With-Value, Find-Coincident-Facts, and

Remove-Duplicate-Facts, where Facts refer to captured behavior of users;

creates trigger events using the graphical user interface and at least one of the stored variables, wherein each trigger event includes at least one condition for the at least one stored variable and an offline marketing action;

modifies at least one of the trigger events based on a cost of performing the offline marketing action, a probability of achieving a sale in response to executing the offline marketing action for the at least one trigger event, and a value of the sale, wherein to modify the at least one of the trigger event, the processor weights the value of the sale based on the probability of achieving the sale to obtain a result and compares the result to the cost of performing the offline marketing action;

compares the conditions in the trigger events with captured online behavior for the visitors;

determines from the comparison whether all the conditions are satisfied for at least one of the trigger events; and

transmits an instruction to an application to trigger the offline marketing action for each of the visitors to the web site having online behavior that satisfies all the conditions for the at least one trigger event.

*The Examiner's Rejection*

Claims 1, 4–10, 12–14, 16–21, and 23–25 stand rejected under 35 U.S.C. § 101 as being directed to judicially excepted subject matter. Final Act. 10–12.

*Issue on Appeal*

Did the Examiner err in concluding Appellants' claimed invention is directed to an abstract idea and the recited claim limitations do not provide

meaningful limitations to transform the abstract idea into patent-eligible subject matter?

## ANALYSIS<sup>2</sup>

Appellants dispute the Examiner’s conclusion that the pending claims are directed to patent-ineligible subject matter under 35 U.S.C. § 101. App. Br. 9–26; Reply Br. 4–12. In particular, Appellants argue the Examiner’s characterization of the claims as being directed to the concept of modifying a trigger marketing event based on online behavior is (i) dissimilar from the abstract ideas in *SmartGene*, *Cyberfone*, and *Digitech*;<sup>3</sup> and (ii) fails to consider the claims as a whole. App. Br. 12–20; Reply Br. 4–9. Further, Appellants assert the claims are directed to significantly more than the alleged abstract idea because the claims are necessarily rooted in computer technology and recite other than what is well-understood, routine, and conventional in the field. App. Br. 21–23; Reply Br. 9–11. For the reasons discussed *infra*, Appellants have not persuaded us of error.

The Supreme Court’s two-step framework guides our analysis. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). If a claim falls within one of the statutory categories of patent eligibility (i.e., a

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<sup>2</sup> Throughout this Decision, we have considered the Appeal Brief, filed December 28, 2015 (“App. Br.”); the Reply Brief, filed August 1, 2016 (“Reply Br.”); the Examiner’s Answer, mailed June 3, 2016 (“Ans.”); and the Final Office Action, mailed August 27, 2015 (“Final Act.”), from which this Appeal is taken.

<sup>3</sup> *SmartGene, Inc. v. Advanced Biological Labs., SA*, 555 F. App’x 950 (Fed. Cir. 2014); *Cyberfone Sys. v. CNN Interactive Grp.*, 558 F. App’x 988 (Fed. Cir. 2014); and *Digitech Image Tech., LLC v. Elecs. For Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014), respectively.

process, machine, manufacture or composition of matter) then the first inquiry is whether the claim is directed to one of the judicially recognized exceptions (i.e., a law of nature, a natural phenomenon, or an abstract idea). *Alice*, 134 S. Ct. at 2355. If so, the second step is to determine whether any element, or combination of elements, amounts to significantly more than the judicial exception. *Alice*, 134 S. Ct. at 2355.

Although the independent claims each broadly fall within the statutory categories of patentability, the Examiner determines the claims are directed to a judicially recognized exception—i.e., an abstract idea. Final Act. 10. In particular, the Examiner finds the claims are directed to the abstract idea of “modifying a trigger marketing event based on online behavior,” which the Examiner concludes is a series of organizing human activities and mathematical relationships. Final Act. 10.

Instead of using a definition of an abstract idea, “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 (Isr.) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (citing *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016)); accord United States Patent and Trademark Office, *July 2015 Update: Subject Matter Eligibility 3* (July 30, 2015), <https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf> (instructing Examiners that “a claimed concept is not identified as an abstract idea unless it is similar to at least one concept that the courts have identified as an abstract idea.”). As part of this inquiry, we must “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., LLC v. DirecTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Here, Appellants’ claims generally relate to a system for triggering one or more marketing actions based on online behavior. *See e.g.*, claim 1. The claimed system (and commensurately recited method and computer readable medium) allows a system user to create and store variables related to aspects of captured online behavior of website visitors. The creation of variables is accomplished via a graphical user interface (GUI) allowing the user to define an expression from predefined syntaxes. Additionally, using the GUI and at least one of the stored variables, a trigger event is created that includes an offline marketing action. At least one of the created trigger events is modified based on a cost analysis determination. When captured online behavior satisfies the conditions associated with a trigger event, the system transmits an instruction to an application indicative of the trigger event.

Our reviewing court has concluded that abstract ideas include the concepts of collecting data, recognizing certain data within the collected data set, and storing the data in memory. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). Additionally, the collection of information and analysis of information (e.g., recognizing certain data within the dataset) are also abstract ideas. *Elec. Power*, 830 F.3d at 1353. Similarly, “collecting, displaying, and manipulating data” is an abstract idea. *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017). Further, a process that employs mathematical algorithms to manipulate existing information to generate additional information is abstract. *Digitech Image*

*Techs., LLC v. Elec. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014). Also, more recently, our reviewing court has also concluded that acts of parsing, comparing, storing, and editing data are abstract ideas. *Berkeimer v. HP Inc.*, No. 2017-1437, 2018 WL 774096, at \*5 (Fed. Cir. 2018).<sup>4</sup>

Further, merely combining several abstract ideas does not render the combination any less abstract. *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“Adding one abstract idea (math) to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas).

As an initial matter, we note in attempting to distinguish the pending claims from other ideas that had been concluded to be abstract, Appellants identify various limitations not present in the claims. *See, e.g.*, App. Br. 14, 16; Reply Br. 4–5. Nonetheless, we agree with the Examiner that as a whole, the claims are directed to triggering an offline marketing action based on online behavior, which is a combination of methods for organizing human activities as well as the application of mathematical relationships. Final Act. 10; Ans. 5–6. In particular, the steps of creating, editing, and storing variables via a user interface are similar to ideas previously

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<sup>4</sup> Still further, the Federal Circuit recently affirmed a District Court’s conclusion that claims reciting the concepts of surveying and compiling survey data were ineligible abstract ideas as they were methods of organizing human activities that could be completed by the human mind. *SkillSurvey, Inc. v. Checkster LLC*, 178 F. Supp. 3d 247, 255–57 (E.D. Pa. 2016), *aff’d*, 683 F. App’x 930 (Fed. Cir. 2017).

concluded by our reviewing court to be abstract. *See e.g., Content Extraction*, 776 F.3d at 1347, *Elec. Power*, 830 F.3d at 1353, *Intellectual Ventures*, 850 F.3d at 1340. Additionally, the monitoring of online behavior and determination that the conditions for a trigger event have been satisfied are similar to the abstract ideas of collecting, analyzing, and comparing information. *See e.g., Content Extraction*, 776 F.3d at 1347, *Elec. Power*, 830 F.3d at 1353, *Intellectual Ventures*, 850 F.3d at 1340. Further, we agree with the Examiner that the modification of an event based on a determination of cost, probabilities, and value is the performance of a series of mathematical relationships. Final Act. 10; *see also Digitech*, 758 F.3d at 1351, *RecogniCorp*, 855 F.3d at 1327.

Because we determine the claims are directed to an abstract idea, we analyze the claims under step two of *Alice* to determine if there are additional limitations that individually, or as an ordered combination, ensure the claims amount to “significantly more” than the abstract idea. *Alice*, 134 S. Ct. at 2355 (*citing Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294, 1297–98 (2012)). The implementation of the abstract idea involved must be “more than [the] performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction*, 776 F.3d at 1347–48 (quoting *Alice*, 134 S. Ct. at 2359) (alteration in original).

Despite characterizing the claimed invention as using computer technology to overcome a problem specific to computer networks and addressing a business challenge particular to the Internet, Appellants do not present sufficient persuasive evidence or argument that the claims are directed to an improvement specific to a computer network or the Internet

*itself* (e.g., improving the network’s operation or configuration, or retaining website visitors). *See* App. Br. 21–22; Reply Br. 9–11. Rather, the focus of the claims is on triggering offline actions based on detected online behavior using a computer and the Internet as tools, not on an improvement in a computer or the Internet as a tool. *Compare, e.g., Elec. Power*, 830 F.3d at 1354, *with DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014).

“[T]argeted advertising is [a well-known] concept, insofar as matching consumers with a given product or service ‘has been practiced as long as markets have been in operation.’” *Morsa v. Facebook, Inc.*, 77 F. Supp. 3d 1007, 1013 (C.D. Cal. 2014), *aff’d*, 622 F. App’x 915 (Fed. Cir. 2015) (quoting *Tuxis Techs., LLC v. Amazon.com, Inc.*, No. CV 13-1771-RGA, 2014 WL 4382446, at \*5 (D. Del. Sept. 3, 2014)). In other words, “[t]he concept of gathering information about one’s intended market and attempting to customize the information then provided is as old as the saying, ‘know your audience.’” *Morsa*, 77 F. Supp. 3d at 1013 (quoting *OpenTV, Inc. v. Netflix Inc.*, 76 F. Supp. 3d 886, 893 (N.D. Cal. 2014)).

Further, we disagree with Appellants that the claims add a specific limitation that was not well-understood, routine, or conventional. *See* App. Br. 22–23; Reply Br. 11. Rather, we agree with the Examiner that the claims recite generic computer components (e.g., a processor, a display, a graphical user interface) and perform basic computer functions. Ans. 7; *see also BuySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1355 (Fed. Cir. 2014) (“a computer [that] receives and sends information over a network . . . is not even arguably inventive”); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714–15 (Fed. Cir. 2014). We also note that, in the Specification Appellants

describe the computer in generic terms as comprising one or more I/O devices memory, and a network interface. Spec. ¶ 56. Additionally, Appellants state “that other known [ ] components may be added or substituted” to the computer system. Spec. ¶ 56. In other words, the Specification describes the use of generic computing components and functionality and is not limited to specific computing components or the performance of specific computing functions. Accordingly, we do not find that the claims recite “significantly more” to transform the abstract idea into a patent-eligible application.

Further, to the extent Appellants are asserting a lack of rejection under Sections 102 and/or 103, suggests the instant claims do not recite well understood, routine, or conventional activities (*see* App. Br. 23–24; *see also* Reply Br. 11), we are not persuaded. Subject-matter eligibility under 35 U.S.C. § 101 is a requirement separate from other patentability inquiries. *See Mayo*, 566 U.S. 66, 90 (2012) (recognizing that the § 101 inquiry and other patentability inquiries “might sometimes overlap,” but that “shift[ing] the patent-eligibility inquiry entirely to these [other] sections risks creating significantly greater legal uncertainty, while assuming that those sections can do work that they are not equipped to do”); *see also Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (“[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter”); *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017) (“[e]ligibility and novelty are separate inquiries”).

Appellants also argue “the recited features act to narrow, confine, and otherwise tie down the claim so as not to preempt the entire field of modifying a trigger marketing event based on online behavior.” App. Br. 24–25; *see also* Reply Br. 12.

“[W]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *FairWarning IP*, 839 F.3d at 1098 (quoting *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract.”). Further, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

For the reasons discussed *supra*, we are unpersuaded of Examiner error. Accordingly, we sustain the Examiner’s rejection of independent claim 1. For similar reasons, we also sustain the Examiner’s rejection of independent claims 10 and 20, which recite similar limitations and were not argued separately. *See* App. Br. 26. Additionally, we sustain the Examiner’s rejection of claims 4–9, 12–14, 16–19, 21, and 23–25, which depend therefrom and were not argued separately. *See* App. Br. 26; 37 C.F.R. § 41.37(c)(1)(iv)(2015).

Appeal 2016-007516  
Application 12/848,780

DECISION

We affirm the Examiner's decision rejecting claims 1, 4–10, 12–14, 16–21, and 23–25 under 35 U.S.C. § 101.

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