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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT ENNALS and PRASHANT GANDHI

Appeal 2016-007535
Application 12/978,125
Technology Center 3600

Before JOHN A. EVANS, CARL L. SILVERMAN, and STEVEN M.
AMUNDSON, *Administrative Patent Judges*.

EVANS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of Claims 29–56. App. Br. 2. Claims 1–28 have been canceled. Final Act. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.²

¹ Appellants identify Intel Corporation as the real party in interest. App. Br. 2.

² Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed December 21, 2015, "App. Br."), the Reply Brief (filed August 2, 2016, "Reply Br."), the Examiner's Answer (mailed June 3, 2016, "Ans."), the Final Action (mailed April 17, 2015, "Final

STATEMENT OF THE CASE

The Invention

The claims relate to location-based filtering and advertising enhancements for merged browsing of network content. *See* Abstract.

Claims 29, 36, 43, and 50 are independent. Claim 29 is illustrative and is reproduced below with some formatting added:

29. A client computing device for merged browsing, the client computing device comprising:
- a processor; and
 - a storage device coupled to the processor and adapted to store instructions for client logic, wherein the client logic is to:
 - determine a geographic location of the client computing device;
 - determine an indicator of first network content to be displayed on a graphical user interface of the client computing device;
 - provide the geographic location and the indicator to a server;
 - receive, from the server and in response to providing the geographic location and the indicator, a visual indicator representative of a fragment of second network content determined by the server to be associated with the geographic location and the indicator,
 - wherein the second network content is available at a second network address different from a first network address at which the first network content is available;
 - display the visual indicator of the fragment of the second network content on the graphical user interface

Act.”), and the Specification (filed December 23, 2010, “Spec.”) for their respective details.

contemporaneously with the display of the first network content;

receive the fragment of the second network content for merged browsing, wherein the fragment of the second network content is less than the entirety of network content available at the second network address;

display, in response to a selection of the visual indicator by a user of the client computing device, the fragment of the second network content on the graphical user interface contemporaneously with the display of the first network content; and

provide, in response to the user's selection of the visual indicator, an indication to the server that the user has selected the visual indicator.

Rejection

Claims 29–56 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. Final Act. 3–7.

ANALYSIS

We have reviewed the rejection of Claims 29–56 in light of Appellants' arguments that the Examiner erred. We consider Appellants' arguments *seriatim*, as they are presented in the Appeal Brief, pages 6–12.

CLAIMS 29–56: NON-STATUTORY SUBJECT MATTER.

Appellants argue claims 29, 31–36, 38–43, and 45–56 generally as a first group. *See* App. Br. 6. Appellants argue claims 30, 37, and 44 as a second group in view of the arguments and authorities set forth for the first

group. *See* App. Br. 11. The Examiner’s answer applies to all claims as a group. *See* Ans. 2–9.

35 U.S.C. § 101.

Section 101 provides that a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has long recognized, however, that § 101 implicitly excludes “laws of nature, natural phenomena, and abstract ideas” from the realm of patent-eligible subject matter, as monopolization of these “basic tools of scientific and technological work” would stifle the very innovation that the patent system aims to promote. *Alice Corp. 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)); *see also Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1294–97 (2012); *Diamond v. Diehr*, 450 U.S. 175, 185 (1981).

The Examiner finds the claims are directed to non-statutory subject matter, specifically the abstract idea of geographically based advertising which, the Examiner finds, is a “fundamental economic practice” and the claimed steps are simply “methods of organizing human activities.” Final Act. 5. The Examiner further finds the claims recite only the abstract idea of performing the method without articulation of concrete steps setting forth a particular implementation of the idea. *Id.*

Appellants contend the claimed method is not directed to an abstract concept. App. Br. 8. Appellants argue there is nothing in any of independent Claims 29, 36, 43, or 50 that recites, or even references,

advertising or any other fundamental economic practice. *Id.* Appellants further argue the Examiner’s finding improperly imports limitations from the Specification into the claims. *Id.* Appellants contend each of the independent claims is directed to providing additional content to a user of a computing device, and specifically doing so in a way that addresses internet-centric challenges raised by the technical environment of the claims. *Id.*

The *Mayo/Alice* Framework

The Supreme Court has instructed us to use a two-step framework to “distinguish[] patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355. At the first step, we determine whether the claims at issue are “directed to” a patent-ineligible concept. *Id.* The Court also cautions that we must “tread carefully in construing this exclusionary principle lest it swallow all of patent law.” *Alice*, 134 S. Ct. at 2354. This is because at some level, “all inventions . . . embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Id.* Thus, an invention is not rendered ineligible for patenting simply because it involves an abstract concept. *See Diamond v. Diehr*, 450 U.S. 175, 187 (1981). “[A]pplication[s]” of such concepts “to a new and useful end,” the Court has said, “remain eligible for patent protection.” *Alice*, 134 S. Ct. at 2354 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

If the claims are directed to a patent-ineligible concept, we “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements” add enough to

transform the “nature of the claim” into “significantly more” than a patent-ineligible concept. *Id.* at 2355, 2357 (quoting *Mayo*, 566 U.S. at 79); *see Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Appellants and the Examiner significantly disagree as to what are considered the elements of the claims. Whereas Appellants contend advertising is not recited in the claims (App. Br. 8), the Examiner finds that despite the confusing language (i.e., merged browsing and content fragment), Appellants are essentially claiming geographically based, targeted advertising. Ans. 3. For example, the Examiner finds independent Claim 36 is directed to geographically based advertising, an abstract idea, by steps including collecting known information (i.e., obtaining a known geographic location and collecting known information (content) associated with the geographic location), comparing the known information (i.e., associating the geographic location and the relevant content associated with the location), and displaying geographically relevant content to a user’s device. *Id.* The Examiner finds the claim merely recites a method of collecting and comparing known information or a method of obtaining and comparing intangible data, each of which has been held to be “[a]n [i]dea [o]f [i]tself.” *Id.* at 3–4 (generally citing *Classen*³ and *CyberSource*⁴)⁵.

³ *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011).

⁴ *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011).

⁵ Because the Examiner does not provide a “pinpoint cite,” it is unclear from where the relied upon language originates.

Appellants reply that the present claims, unlike those of *Classen* and *CyberSource*, cannot be performed mentally. Reply Br. 2. Appellants argue the claims require a client computer to interact with both a server and a user. *Id.* at 14. Appellants contend the Examiner improperly describes the claims at “a high level of abstraction and untethered from the language of the Claims.” *Id.* at 3 (citing *Enfish*). “However, describing the claims at such a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016).

During examination, claim terms are to be given their broadest reasonable interpretation as they would have been understood by one of ordinary skill in the art, taking into account whatever enlightenment may be provided by the Specification. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). However, limitations may not be imported into the claims from the Specification. *See SuperGuide Corp. v. DirecTV Enters., Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

We agree with Appellants that the claims do not recite advertising. Although the Examiner finds “Appellants are essentially claiming geographically based targeted advertising,” the Examiner does not specify which claim recitations, given their broadest reasonable interpretation as they would have been understood by one of ordinary skill in the art and taking into account the enlightenment provided by the Specification, are interpreted as targeted advertising.

The Supreme Court has not established a definitive rule to determine what constitutes an “inventive concept” sufficient to satisfy § 101. Rather, both the Federal Circuit and the Supreme Court have found it sufficient to

compare claims at issue to those claims already found to be patent eligible in previous cases. *Enfish*, 822 F.3d 1334.

The present claims determine first and second geographical locations associated with a client computer and a server and determine first and second “network content” associated with the first and second geographic locations. From the various “network content,” the claims synthesize a webpage. *See* Claim 29. We find these claims are similar to those previously found patent eligible, at step two, in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1248, 1257–59 (Fed. Cir. 2014) (“these patents [are] directed to systems and methods of generating a composite webpage that combines certain visual elements of a ‘host’ webpage with content of a third-party merchant” and “the claimed solution amounts to an inventive concept for resolving [a] particular Internet-centric problem”); *see Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1139, 1151 (Fed. Cir. 2016) (noting that “[i]n *DDR Holdings*, we held that claims ‘directed to systems and methods of generating a composite web page that combines certain visual elements of a ‘host’ website with content of a third-party merchant’ contained the requisite inventive concept”).

We need not decide whether the claims are directed to an abstract idea under step 1 because we find the claims are similar to those previously found to recite patent-eligible subject matter at step two. *See e.g., DDR Holdings.*

DECISION

Appeal 2016-007535
Application 12/978,125

The rejection of Claims 29–56 under 35 U.S.C. § 101 is REVERSED.

REVERSED