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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DALE W. MALIK and RICHARD A. ANDERSON

Appeal 2016-007779¹
Application 13/687,068
Technology Center 3600

Before JOSEPH L. DIXON, ELENI MANTIS MERCADER, and
ALEX S. YAP, *Administrative Patent Judges*.

YAP, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–23, which are all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ According to Appellants, the real party in interest is Facebook, Inc. (App. Br. 2.)

STATEMENT OF THE CASE

Introduction

Appellants' Specification states that their "inventions relate to the provision of information on communication devices and services."

(Specification (filed Nov. 28, 2012) ("Spec.") 2.) Claim 1 is illustrative and is reproduced below:

1. A method, comprising:
 - identifying, using at least one processor, a communication from an origination device to a destination device;
 - retrieving, using the at least one processor, a descriptor of the origination device from memory; and
 - causing, using the at least one processor and in conjunction with the communication, the descriptor of the origination device to be presented to a user associated with the destination device by way of the destination device.

Prior Art and Rejections on Appeal

The following table lists the prior art relied upon by the Examiner in rejecting the claims on appeal:

Bado et al. ("Bado")	US 4,703,423	Oct. 27, 1987
Hidary	US 5,852,775	Dec. 22, 1998
Meier et al. ("Meier")	US 2001/0027478 A1	Oct. 4, 2001

Claims 1–23 stand rejected under 35 U.S.C. § 101 because the claims are not directed to patent eligible subject matter. (*See* Final Office Action (mailed June 24, 2015) ("Final Act.") 2–3, 14–16.)

Claims 1–5, 7–12, and 14–23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary in view of Bado. (*See id.* at 3–12.)

Claims 6 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hidary, in view of Bado, and in further view of Meier. (*See id.* at 12–13.)

ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments that the Examiner has erred. We are not persuaded that the Examiner erred in rejecting claims 1–23 under 35 U.S.C. §§ 101 and 103.

103 Rejections

With respect to independent claims 1, 8, and 15, the Examiner finds the combination of Hidary and Bado teaches or suggests the limitations of these claims. (Final Act. 3–13.) Specifically, according to the Examiner, the combination teaches or suggests “*retrieving, using the at least one processor, a descriptor of the origination device from memory*” of claim 1. (Emphases added.) Independent claims 8 and 15 contain a similar limitation. According to the Examiner, “Hidary discloses an advertisement system where individuals may receive targeted advertisements related to a service subscription . . . [and] Bado discloses a method of providing targeted advertisements related to a brand[.]” (Final Act. 5.) Therefore, the Examiner finds that “[i]t would have been obvious to a person of ordinary skill in the art at the time of the invention to include in the advertisement delivery system of Hidary the ability to present the brand of device during a call to the user as detailed in Bado.” (*Id.*) The Examiner also notes that

[a]lthough Hidary does not appear to specify a descriptor of the device from the device displayed on the destination device[,] Hidary describes calls between users and caller ID is old and well known and gives a descriptor of the originating device (phone number) and display it on the destination device.

(*Id.* at 6.) Appellants contend that neither brand name nor caller ID is “a descriptor of the origination device from memory.” (App. Br. 15–17.) The Examiner explains that:

Appellant[s’] specification (US Patent Application Publication No. 2013/0138513A1) offers no definition of exactly what is a descriptor of a device. After reviewing the specification further, paragraphs 0066 and 0072-0075 offer[] a few examples and suggests the descriptor can be anything related to the device where it mentions, “[i]nformation about the communication device, e.g., brand name, features, functions, specifications, features, or other information.” As such by the Broadest Reasonable Interpretation (BRI), *the Examiner has interpreted that caller ID provides a description of the originating device (features, functions, specifications, features, or other information).*

(Ans. 2, italics added.) In other words, both brand name and caller ID can be “a descriptor of the origination device.” Appellants contend that “‘a descriptor of the origination device’ does not include the concept of a caller ID phone number.” (Reply 3.) Appellants proceed to argue that various “examples of device descriptions” in the Specification describes “a descriptor of the origination device [a]s fundamentally different than ‘caller ID’” and that the Examiner “errs by improperly stating that Appellant[s’] Specification offers no description about a descriptor of a device.” (*Id.* at 2–4.)

Appellants have not persuaded us of Examiner error. We agree with the Examiner that the Specification “offers *no definition of exactly* what is a

descriptor of a device” but rather “offers a few examples and suggests the descriptor can be anything related to the device where it mentions.” (Ans. 2 *italics added.*) The evidence cited by Appellants at most point to other examples of device descriptions rather than a definition of the term “a descriptor of the origination device.” During examination of a patent application, pending claims are given their broadest reasonable construction in light of the Specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). To read a claim in light of the Specification, one must interpret limitations explicitly recited in the claim, without reading limitations from the Specification into the claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations that are not recited in the claim. *In re Prater*, 415 F.2d 1393, 1404–05 (CCPA 1969). Here, we decline Appellants’ invitation to exclude caller ID or brand name as “a descriptor of the origination device” because Appellants have not persuaded us that the Examiner’s interpretation of the claim language is either unreasonable or overly broad. Importantly, we agree with the Examiner’s finding that “paragraphs 0066 and 0072-0075 [of the published application] offer[] a few examples and suggests the descriptor can be anything related to the device where it mentions.” (Ans. 2.)

Appellants next contend that neither Hidary nor Bado teaches or suggests the limitation at issue. (App. Br. 14–17; Reply 2–3.) However, Appellants have not persuaded us of Examiner error because nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior-art disclosures. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Finally, Appellants contend that Bado “is not analogous prior art” because “Bado is not reasonably pertinent to the problem faced by the inventor of the current claims, or, more specifically, Bado would not have ‘logically’ commended itself to the inventor’s attention in considering the presently claimed invention.” (App. Br. 17–18, emphasis omitted; Reply 2–3.) Appellants have not persuaded us of Examiner error because we agree with the Examiner’s finding that both Hidary and Bado “teach [how to] solv[e] the problem of which advertisement to target[a] user . . . , therefore[,] Hidary and Bado [are] analogous art and it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine these two pieces of art.” (Ans. 3.)

For the foregoing reasons, we are not persuaded of Examiner error in the obviousness rejection of independent claims 1, 8, and 15, and do not sustain the 35 U.S.C. § 103 rejection of these claims. We are also not persuaded of Examiner error in the rejection of dependent claims 2–7, 9–14, and 16–23, which depend from either claim 1, 8, or 15, and therefore, sustain the 35 U.S.C. § 103 rejections of these claims for the same reasons.

Patent Eligibility

The Examiner rejects claims 1–23 under 35 U.S.C. § 101 because the claims are not directed to patent eligible subject matter. (Final Act. 2–3.)

According to the Examiner:

The claims are directed to the abstract idea of the fundamental business practice of marketing. The additional elements or combination of elements in the claims other than the abstract idea per se amount to no more than the application of the abstract idea to the particular environment of telephony communications and the implementation of the abstract idea by a general purpose computer. Viewed as a whole, these

additional claim elements do not provide meaningful limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claims amount to significantly more than the abstract idea itself. The claim limitations do not improve upon the technical field that the abstract idea is applied nor do they improve upon any other technical field. The claimed limitations do not improve upon the functioning of the computer itself. Therefore, the claims are rejected under 35 U.S.C. [§] 101 as being directed to non-statutory subject matter.

(*Id.*) Appellants contend that (1) the Examiner has not established a *prima facie* case; (2) the claims are not directed to an abstract idea; and (3) even if they were, the claims include “limitations that are significantly more than the abstract idea.” (App. Br. 19–25.) Appellants, however, have not persuaded us that the Examiner erred.

Whether an invention is patent-eligible is an issue of law, which we will review *de novo*. 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: “[I]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g., Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See id.* at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *Bilski v.*

Kappos, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter.”); *Parker v. Flook*, 437 U.S. 584, 594–95 (1978) (“Respondent’s application simply provides a new and presumably better method for calculating alarm limit values.”); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.”).

The patent-ineligible end of the spectrum includes fundamental economic practices (*Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611); mathematical formulas (*Flook*, 437 U.S. at 594–95); and basic tools of scientific and technological work (*Gottschalk*, 409 U.S. at 67). On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber (*Diamond*, 450 U.S. at 184 n.8), “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour (*Gottschalk*, 409 U.S. at 69).

If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an “inventive concept”—an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.*

As discussed above, the Examiner rejects claims 1–23 under 35 U.S.C. § 101 because the claims are not directed to patent eligible subject matter. (Final Act. 2–3, 14–17.) Appellants contend that the Examiner has failed to “clearly articulate the reasons why the claimed invention is ineligible because the *Final Office Action* fails to clearly articulate *why* the claims are considered an abstract idea” and “explain why [the claims] do not amount to significantly more than the identified judicial exception.” (App. Br. 20–21.) Appellants, however, have not persuaded us that the Examiner erred. In patent prosecution, a burden-shifting procedure occurs between the Examiner and the Applicant, which is “merely a procedural device that enables an appropriate shift of the burden of production.” *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (citation omitted). The Examiner carries the initial burden of establishing a prima facie case of unpatentability “by ‘adequately explain[ing] the shortcomings it perceives so that the applicant is properly notified and able to respond.’” *Id.* The statement of the prima facie case, however, “need not be a full exposition on every conceivable deficiency of a claim. . . . Rather, its purpose is simply to provide sufficient notice to the applicant to facilitate his effective submission of information.” *Hyatt v. Dudas*, 492 F.3d 1365, 1370 (Fed. Cir. 2007). Here, the Examiner performed the two-part *Alice* test by identifying the abstract idea (*i.e.*, “accessing data, inferring data, accessing more data, assembling data for marketing purposes”) and determining whether the claims amount to significantly more than abstract idea itself (*i.e.*, “[t]he claim limitations do not improve upon the technical field that the abstract idea is applied nor do they improve upon any other technical field. The claimed limitations do not improve upon the functioning of the computer itself.”). (Final Act. 2–3,

16.) For these reasons, we find that the Examiner has established a *prima facie* case.

With regard to the first step of *Alice*, the Examiner finds the “claims are directed to the abstract idea of the fundamental business practice of marketing.” (Final Act. 2–3.) Specifically, according to the Examiner:

Similar claims directed to comparing new and stored information and using rules to identify options in *S[m]artGene v. Advanced Biological Labs*, organizing information through mathematical correlations in *Digitech v. Electronics for Imaging*, and using categories to organize, store and transmit information in *Cyberfone v. CNN* have all been found by the courts to be abstract ideas. Further several additional court decisions have identified fundamental economic practices as abstract ideas as well (*Alice*, *Bilski*, *BuySAFE* and *Ultramercial*). Because Applicants claims are directed to similar steps of retrieving and manipulating data, the claims are likewise directed to abstract ideas. Further the claims detail steps toward marketing, which is a fundamental economic practice and[,] therefore[,] the claims disclose a patent ineligible abstract idea.

(*Id.* at 16; Ans. 6–7.) Appellants contend that the claims are not abstract because

the current claims are directed to subject matter that is significantly different compared to cases that have been held to be directed to “advertising” or “marketing” . . . [and that] the Examiner errs in asserting that independent claims 1, 8 and 15 are directed to the abstract idea of the fundamental business practice of marketing.

(App. Br. 22–23; Reply 7.) We are not persuaded by Appellants’ contention, and we agree with the Examiner that the claims, “when viewed as a whole[,] are directed to the abstract idea of marketing (targeted advertising in the dependent claims).” (Ans. 6.) For example, dependent claim 7 recites “retrieving . . . advertising associated with the origination

device; and providing the advertising. . . to the destination device.” Claims 14 and 20, which depend on claims 8 and 15, respectively, also recite a similar limitation. Moreover, the Specification confirms that “information [sent to devices] may include advertising, marketing . . . , etc.” (Spec. 14.) In addition, the Specification states, in the Summary section, that the purpose of “the invention”:

In sum, the inventions described herein allow for the targeted contextual advertisement of communication devices and services. Further, the inventions implement the targeted contextual advertisement of communication devices and services so the information is delivered in an appropriate contextual manner.

(Spec. 6, emphases added.) Furthermore, the Examiner also provided other reasons (*e.g.*, the use of computer-related technology for “accessing data, inferring data, accessing more data, assembling data” or “retrieving and manipulating data”) for why the claims are abstract. (Final Act. 16.) Appellants do not address this in their Appeal Brief.

Regarding step two of *Alice*, Appellants argue that, “the claims of the present application are still directed toward eligible subject matter because they include limitations that are significantly more than an abstract idea.” (App. Br. 23.) According to Appellants, “the claimed invention resolves a particular network-centric problem.” (*Id.* at 24–25; Reply 8.) Appellants contend that:

[c]ausing . . . the destination device in conjunction with a communication sent from the origination device to the destination device, as presently claimed, is not part of any “business practice known from the pre-Internet world.” Rather, causing such a presentation to a user of a device in the manner claimed is a solution to a problem that, *per se*, arose in the realm of computer networks.

(App. Br. 25.) Appellants, however, do not provide persuasive evidence that the claim amounts to “significantly more” than the abstract idea itself and we agree with the Examiner’s finding that nothing in the claims adds an inventive concept that transforms the nature of the claim into a patent-eligible application of the abstract idea. (Final Act. 3, 15–16; Ans. 7–8.) We agree with the Examiner that “[t]here is no indication that” the alleged improvement (*i.e.*, “causing such a presentation to a user of a device in the manner claimed is a solution to a problem that, *per se*, arose in the realm of computer networks” (App. Br. 25)) “improves the functioning of a computer or improves any other technology.” (Ans. 7.) Moreover, the alleged improvement is mere attorney argument and a conclusory statement, which is unsupported by factual evidence and, thus, is entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984).

For the foregoing reasons, because claims 1–23 are directed to an abstract idea and nothing in the claims adds an inventive concept that transforms the nature of the claim into a patent-eligible application of the abstract idea, the claims are not patent-eligible under § 101. Therefore, we sustain the 35 U.S.C. § 101 rejection of claims 1–23.

DECISION

We affirm the decision of the Examiner to reject claims 1–23 under 35 U.S.C. §§ 101 and 103(a).

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).

AFFIRMED