UNITED STATES PATENT AND TRADEMARK OFFICE

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12/147,620	06/27/2008	Xiaofeng Fan	323033.01	7245

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte XIAOFENG FAN, JOHN D. DUNAGAN, and HELEN J. WANG

Appeal 2016-008168
Application 12/147,620[1]
Technology Center 3600

Before JOHNNY A. KUMAR, JOHN A. EVANS, and JOYCE CRAIG,
Administrative Patent Judges.

KUMAR, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) from the
Examiner's Non-final rejection of claims 1–20, which are all the claims
pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.[2]

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[2] Our Decision refers to Appellants' Appeal Brief filed (Dec. 27, 2015)
("App. Br."); Reply Brief filed (Sept. 1, 2016) ("Reply Br."); Examiner's
Answer mailed (July 1, 2016) ("Ans."); Non-Final Office Action mailed
(June 12, 2015) ("Non-Final Act."); and original Specification filed (June
27, 2008) ("Spec.").

STATEMENT OF THE CASE

Appellants' invention relates to "[o]nline ad hosting." Abstract.

Claims 1, 14, and 20 are independent claims. Claim 1 illustrates Appellants' invention, as reproduced below:

1. A computer-implemented method, comprising:
creating an insulator in a host webpage in a browser;
receiving third-party content into the insulator, the third-party content from a third-party domain different than a domain associated with the host webpage;
receiving a request from the third-party content regarding a change to the third-party content;
determining, via a processing unit, whether the request is valid against one or more host parameters associated with the insulator by determining whether the request meets one or more limitations of the one or more host parameters; and
responsive to determining that the request is valid against the one or more host parameters by determining that the request meets the one or more limitations of the one or more host parameters, changing, via the processing unit, one or more properties of the insulator to allow for at least one of expansion of the insulator in the host webpage in the browser or movement of the insulator in the host webpage in the browser to accommodate the change to the third-party content, where the change to the third-party content comprises at least one of expansion of the third-party content in the host web page in the browser or movement of the third-party content in the host webpage in the browser.

App. Br. 16 (Claims App.).

Examiner's Rejection

Claims 1–20 are rejected under 35 U.S.C. § 101 for non-statutory subject matter.

Claims 1–20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang et al. (US 2009/0037806 A1, published Feb. 5,

2009) (hereinafter "Yang") in view of Tandetnik (US 2006/0053048 A1, published Mar. 9, 2006).

Issues on Appeal

Did the Examiner err in rejecting claim 1 as being directed to judicially excepted subject matter?

Did the Examiner err in rejecting claim 1 as being obvious?

ANALYSIS

1. Rejection under § 101

In *Alice Corp. Pty. Ltd. v. CLS Bank International*, 134 S. Ct. 2347 (2014), the Supreme Court reiterates an analytical two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), "for distinguishing 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. The first step in the analysis is to "determine whether the claims at issue are directed to one of those patent-ineligible concepts," such as an abstract idea. *Id.* If the claims are directed to eligible subject matter, the inquiry ends. *Thales Visionix Inc. v. United States*, 850 F.3d 1343, 1349 (Fed. Cir. 2017); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016). If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims "individually and 'as an ordered combination'" to determine whether there are additional elements that "'transform the nature of the claim' into a patent-eligible application."

Enfish, 822 F.3d at 1334 (citing *Mayo*, 566 U.S. at 78–79). In other words, the second step is to "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*, 134 S. Ct. at 2355 (citing *Mayo*, 566 U.S. at 72–73).

In rejecting independent claims 1, 14, and 20 and dependent claims 2–13 and 15–19 under 35 U.S.C. § 101, the Examiner concludes these claims are directed to an abstract idea of "online ad hosting." Non-Final Act. 3.

The Examiner concludes, and we agree, the functions recited in claim 1 involve the abstract idea of

> providing an insulated third part content onto a web page that comprises the steps of **receiving** a request to change third-party content on a webpage, determining whether the request meets a set of criteria, and **changing** the third-party content within a method of online advertisement hosting. The method and/or system is similar to concepts that have been identified as abstract by the courts, such as using categories to organize, store, and transmit information in *Cyberfone* or comparing new and stored information and using rules to identify options in *SmartGene*.

Ans. 11–12 (Emphasis ours).

> Appellants argue claims 1, 14, and 20 are not an abstract idea because

> Claims 1, 14 and 20 address a concern that is specific to computer networks, namely the degree to which the third-party content is able to expand (be resized) and/or move on a host webpage. Accordingly, Claims 1, 14 and 20 differ from other claims found to recite abstract ideas at least because Claims 1, 14 and 20 do not "merely recite the performance of some business practice known from the pre-Internet world along with the requirement to perform it on the Internet. Instead, **the [Appellants'] claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks"**

> *(DDR Holdings, LLC v. Hotels.com et al.,* 113 USPQ2d 1097
> (Fed. Cir. 2014)).

App. Br. 14.

> Appellants further argue
>
> [t]he claimed invention addresses the Internet-centric challenge
> of alerting a subscriber with time sensitive information when
> the subscriber's computer is offline ... These are meaningful
> limitations that add more than generally linking the use of the
> abstract idea (the general concept of organizing and comparing
> data) to the Internet, because they solve an Internet-centric
> problem with a claimed solution that is necessarily rooted in
> computer technology, similar to the additional elements in *DDR
> Holdings*.

Id.

We disagree with Appellants. None of the functions recited in Appellants' claims 1, 14, and 20 provide, and nowhere in the Specification can we find, any description or explanation as to how these data manipulation steps are intended to provide a "solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks," as explained by the Federal Circuit in *DDR Holdings*, 773 F.3d at 1257.

Turning now to the second step of the *Alice* inquiry, we find nothing in claims 1, 14, and 20 which adds "significantly more" to transform the abstract concept of collecting, storing, and analyzing information into a patent-eligible application. *Alice*, 134 S. Ct. at 2357.

The Examiner concludes, and we agree, "[t]he claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional elements when

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considered both individually and as a combination do not amount to significantly more than the abstract idea." Ans. 12.

Limiting the abstract concept of receiving, storing and manipulating information to a general purpose computer having generic elements, such as the servers, processor, and machine-readable medium recited in Appellants' claims 1, 14, and 20, does not transform the abstract idea into a patent-eligible invention under 35 U.S.C. § 101. Ans. 12. As recognized by the Supreme Court, "the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention." *See Alice*, 134 S. Ct. at 2358, 2359 (concluding claims "simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer" are not patent eligible); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014) (concluding claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet are not patent-eligible); *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (concluding claims reciting "generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer" are not patent-eligible); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) ("[s]imply adding a 'computer aided' limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible").

Because Appellants' claims 1–20 are directed to a patent-ineligible abstract concept under *Alice* step 1, and do not recite something

"significantly more" under *Alice* step 2, we sustain the Examiner's rejection of these claims under 35 U.S.C. § 101.

2. Obviousness

We have reviewed the Examiner's obviousness rejection of claims 1–20 in light of Appellants' contentions that the Examiner has erred.

Further, we have reviewed the Examiner's response to Appellants' arguments. The Examiner has provided a comprehensive response to each argument presented by the Appellants on pages 3 through 11 of the Answer. We have reviewed this response and concur with the Examiner's findings and conclusions. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Non-Final Action and Answer in response to Appellants' Appeal Brief.

We have considered Appellants' arguments in the Reply Brief on pages 2 through 8, but find them unpersuasive. In particular, we agree with the Examiner that Tandetnik explicitly teaches "dynamically changing, moving or resizing the presentation" (Ans. 4, 11, citing Tandetnik ¶ 32).

CONCLUSIONS

We affirm the Examiner's rejection of claims 1–20 under 35 U.S.C. § 101.

We affirm the Examiner's rejection of claims 1–20 as being unpatentable under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's Non-final rejection of claims 1–20.

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