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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* KWAKU O. PRAKAH-ASANTE and  
PERRY ROBINSON MACNEILLE<sup>1</sup>

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Appeal 2016-008398  
Application 13/873,966  
Technology Center 3600

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Before BRADLEY W. BAUMEISTER, ADAM J. PYONIN, and  
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

BAUMEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–14 and 16–20. App. Br. 6–9. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> Appellants list Ford Global Technologies as the real party in interest. Appeal Brief filed January 11, 2016 (“App. Br.”) 2.

## STATEMENT OF THE CASE

Appellants describe the present invention as follows:

An advertising system enabling one or more processors to determine and select an in-vehicle drip advertisement. The advertising system may communicate with a vehicle computing system enabling one or more processors to receive input representing a current location. The advertising system may receive input representing a destination and define at least one navigation route corresponding to the current location and the destination. The system may select one or more advertisements based on the at least one navigation route. The system may output the one or more advertisements on an output device at one or more predetermined points on the at least one navigation route. The system may receive an input in response to an advertisement and determine a related advertisement corresponding to the response and the one or more navigation routes. The system may output the related advertisement on the output device.

Abstract.

Independent claim 11, reproduced below, illustrates the claimed subject matter on appeal:

11. A method comprising:

generating navigation routes, via a vehicle processor, corresponding to a current location and a destination;

calculating a driver workload value for each of the navigation routes based on current driving conditions measured with vehicle sensors in communication with the vehicle processor;

outputting one or more advertisements based on the navigation routes; and

in response to received input to an advertisement, outputting a related advertisement based on the driver workload value.

Claims 1–14 and 16–20 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Final Act. 2–4.<sup>2</sup>

Claim 14 stands rejected under 35 U.S.C. § 112(d) or pre-AIA § 112, ¶ 4, for failing to include all of the limitations of the claim upon which it depends. Final Act. 4–5.

Claims 1–8, 11–14, and 16–20 stand rejected under 35 U.S.C. § 102(b) as anticipated by Kamar (US 2010/0332315 A1; published Dec. 10, 2010). Final Act. 5–8.

Claims 9 and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Kamar and Chutorash (US 2010/0280956 A1; published Nov. 4, 2010). Final Act. 8–9.

We review the appealed rejections below *seriatim*. In so doing, we review the rejections for error based upon the issues identified by Appellants, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

## I.

### *Findings and Contentions*

The Examiner determines that independent claim 11, for example, is directed to an abstract idea because “[a]ll of the steps of [claim 11] can be performed by a human given the information and time.” Final Act. 2. The Examiner further characterizes the invention as “merely receiving,

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<sup>2</sup> Rather than repeat the Examiner’s positions and Appellants’ arguments in their entirety, we refer to the above-mentioned Appeal Brief, as well as the following documents for their respective details: the Final Action mailed August 12, 2015 (“Final Act.”); the Examiner’s Answer mailed July 15, 2016 (“Ans.”); and the Reply Brief filed September 8, 2016 (“Reply Br.”).

determining, and outputting data,” and that “there is nothing in the claim language as to how the driver workload value is being calculated.” *Id.* at 2–3. The Examiner determines that “there are no meaningful limitations in the claim that transform the exception into a patent eligible application such that the claim amounts to significantly more than the exception itself.” *Id.* at 3.

The Examiner additionally determines that claims 1–10 and 17–20 are patent ineligible for similar reasons as claims 11–14 and 16. *Id.* More specifically, the Examiner determines that claims 1–10 set forth a system that requires no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known in the industry. *Id.* The Examiner determines that claims 17–20 set forth a computer readable medium that describes an environment in which to carry out the abstract ideas on a generic computer. *Id.* at 3–4.

Appellants argue that there is not a singular abstract idea encompassed by the claims, and therefore, the Examiner instead merely lists all of the individual limitations and improperly labels them collectively as an abstract idea. App. Br. 6. Appellants further urge that “[w]hether or not the claims contain an abstract idea, there is no one single abstract idea embodied in the claims that it tied up such that others cannot practice it.” *Id.* at 7.

#### *Principles of Law*

Patent eligibility is a question of law that is reviewable *de novo*. *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333 (Fed. Cir. 2012).

In determining whether the claims set forth patent eligible subject matter under 35 U.S.C. § 101, we first must determine whether the claims at issue are directed to laws of nature, natural phenomena, or abstract ideas.

*Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714 (Fed. Cir. 2014). In considering whether a claim is directed to an abstract idea, we acknowledge, as did the Court in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012). We, therefore, look to whether the claims focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. See *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016).

If the claims are directed to an abstract idea, we then must consider whether the claim contains an element or a combination of elements that is sufficient to transform the nature of the claim into a patent-eligible application. *Ultramercial*, 772 F.3d at 714; *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S.Ct. 2347, 2355 (2014).

In applying step two of the *Alice* analysis, we must “determine whether the claims do significantly more than simply describe [the] abstract method” and thus transform the abstract idea into patentable subject matter. . . . We look to see whether there are any “additional features” in the claims that constitute an “inventive concept,” thereby rendering the claims eligible for patenting even if they are directed to an abstract idea. . . . Those “additional features” must be more than “well-understood, routine, conventional activity.”

*Intellectual Ventures I LLC v. Erie Indemnity Company*, 850 F.3d 1315, 1328 (Fed. Cir. 2017) (citations omitted).

“[C]laims [that] merely require generic computer implementation[] fail to transform [an] abstract idea into a patent-eligible invention.” *Id.* (citing *Alice*, 134 S.Ct. at 2357).

*Analysis*

Regarding Appellants' arguments concerning preemption (App. Br. 7 (contending that the claims do not tie up any particular abstract idea)), we recognize as a threshold matter that the Supreme Court has described "the concern that drives this exclusionary principle [i.e., the exclusion of abstract ideas from patent eligible subject matter] as one of pre-emption." *See Alice Corp.*, 134 S. Ct. at 2354. However, characterizing preemption as a driving concern for patent eligibility is not the same as characterizing preemption as the sole test for patent eligibility. As our reviewing court has explained: "The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability" and "[f]or this reason, questions on preemption are inherent in and resolved by the § 101 analysis." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (citing *Alice Corp.*, 134 S. Ct. at 2354). Although "preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility." *Id.*

Turning to the remaining argument, we agree with the Examiner that claim 11 is directed to an abstract idea. Specifically, the claim is directed to the long known method of organizing human activity that entails a vehicle's passenger generating a navigation route for a driver, sensing or ascertaining whether it is a convenient time to ask the driver a sales question, and refraining from doing so when it appears that the driver needs to concentrate.

For example, a long established practice for automobile dealerships has been for the salesperson to ride with a prospective buyer while the buyer test drives a vehicle. In such cases, it had been a common practice for the salesperson to instruct the driver on which navigation route to take while test

driving, especially when the driver is not familiar with the area. It also had been a common practice for the salesperson to point out the automobile's various features to the driver during the test drive. For example, the salesperson may point out the car's superior acceleration on a highway or sensitive handling on a curve. Such explanations reasonably constitute the salesperson "outputting one or more advertisements based on the navigation route," as recited in claim 11.

It also had been a common practice for the salesperson to observe the surrounding road conditions, as well as the driver's level of concentration on the road and responsiveness to the salesperson's sales conversation (or "advertisements"). In the parlance of claim 11, the salesperson is "calculating a driver workload value for each one of the navigation routes based on current driving conditions measured with [human] vehicle sensors," as recited. When the salesperson observes the driver responding to the conversation, such as by asking questions, nodding, or following instructions, the salesperson knows to continue providing more information about the car—or, "outputting a related advertisement based on the driver workload value," as recited in claim 11.

For these reasons, claim 11 appears to be directed to a method of using a computer to perform a well-established abstract idea. Furthermore, claim 11 does not focus on any specific computing means that improves the relevant technology. Claim 11, instead, merely appears to be directed to the result or effect that itself is the abstract idea and merely invokes generic processes and machinery. *See Enfish, LLC*, 822 F.3d at 1336.

Turning to step two of the *Alice* analysis, we find that claim 11 contains no element or combination of elements that is sufficient to



transform the nature of the claim into a patent-eligible application.

*Ultramercial*, 772 F.3d at 714. The entirety of claim 11 appears to be directed to the method of performing the noted abstract idea on a generic computer according to conventional computing processes.

For the foregoing reasons, Appellants have not persuaded us of error in the Examiner’s rejection of claim 11 under 35 U.S.C. § 101 for being directed to patent ineligible subject matter. Accordingly, we sustain the rejection of that claims, as well as claims 1–10, 12–14, and 16–20, which are not argued separately. *See* App. Br. 6–7; *also* 37 C.F.R. § 41.37(c)(1)(iv).

## II.

The Examiner rejects dependent claim 14 under 35 U.S.C. § 112(d) or pre-AIA § 112, ¶ 4, for failing to include all of the limitations of claim 12, upon which claim 14 depends. Final Act. 4. According to the Examiner, “Claim 14 states the [recited] filtering is based on statistical analysis of a number of routes for the navigation route to a particular advertisement destination[, but t]he basis of the filter for claim 14 does not include the basis for filtering [recited] in claim 12.” *Id.*

Appellants do not challenge this rejection on Appeal. *See generally* App. Br. Accordingly, we summarily affirm this rejection without substantive consideration. *See* MPEP § 1205.02 (“If a ground of rejection stated by the examiner is not addressed in the appellant’s brief, that ground of rejection will be summarily sustained by the Board.”).

III.

*Findings and Contentions*

Regarding the anticipation rejection of claims 1–8, 11–14, and 16–20, Appellants argue *inter alia* that Kamar does not disclose that a driving condition is measured with vehicle sensors, as recited in the independent claims. App. Br. 6–9.

The Examiner finds that this claim language is taught in paragraph 29 of Kamar, which states that “sensors might detect current traffic patterns and construction delays.” Ans. 7–8. The Examiner additionally finds that the recited language—“calculating a workload value” of a driver—is taught by Kamar’s paragraphs 37–41. The Examiner specifically cites paragraph 39 for teaching that calculations are performed using the clock, ground-positioning-satellite (GPS) sensors, and weather monitoring device sensors. Ans. 8. The Examiner cites Kamar’s paragraph 40 for teaching that advertisement opportunity may be identified by monitoring biometrics of the user. Ans. 8. The Examiner cites Kamar’s paragraph 41 as disclosing “respective advertisement opportunities may be identified as positions along a potential route having a significant probability of an attention availability of the user at the position.” Ans. 8.

*Analysis*

The cited passages of Kamar do not reasonably support the Examiner’s disputed findings. For example, while Kamar’s paragraph 29 does state that “sensors might detect current traffic patterns and construction delays,” the passage does not specify whether such sensors are, more

particularly, *vehicle* sensors. They may well be remote sensors that transmit the information to the vehicle via GPS signals.

Likewise, Kamar's paragraph 39 discusses the use of a clock, a GPS receiver, and a weather monitoring device, but the passage does not say that any of these sensors more particularly are *vehicle* sensors. Paragraph 40 discusses biometric sensors—not sensors measuring driving conditions. Paragraph 41 discusses travel features—not driving conditions.

Because the appealed rejection is an anticipation rejection under 35 U.S.C. § 102, as opposed to an obviousness rejection under 35 U.S.C. § 103, we are constrained to determine only whether Kamar discloses a vehicle sensor for measuring driving conditions. We do not address the separate question of whether it would have been obvious in light of Kamar to use a vehicle sensor to measure driving conditions.

For the foregoing reasons, Appellants have persuaded us the Examiner erred in rejecting claims 1–8, 11–14, and 16–20 as anticipated over Kamar. Accordingly, we reverse the rejection of these claims under 35 U.S.C. § 102(b).

Regarding the obviousness rejection of dependent claims 9 and 10, the Examiner does not rely on Chutorash to make up for the stated shortcomings of Kamar's disclosure. The Examiner instead relies upon Chutorash for teaching that it was known to use a microphone to provide a verbal input in response to an advertisement (claim 9) and a smartphone (claim 10). For the reasons set forth above, then, we likewise reverse the obviousness rejection of these claims under 35 U.S.C. § 103.

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DECISION

The Examiner's decision rejecting claims 1–14 and 16–20 is affirmed.

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). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED