



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/041,106	09/30/2013	Rahul Razdan	058769/435627	5023
826	7590	05/02/2018	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			ELCHANTI, TAREK	
			ART UNIT	PAPER NUMBER
			3621	
			NOTIFICATION DATE	DELIVERY MODE
			05/02/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptomail@alston.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAHUL RAZDAN, FANG CAO, ZHENBO SHI,
ANDREW GIANIKAS, and DI WANG

Appeal 2016-008623¹
Application 14/041,106
Technology Center 3600

Before JOHN A. JEFFERY, LARRY J. HUME, and
CATHERINE SHIANG, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 1–20, which are all claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM, and enter a new ground of rejection for claim 5, pursuant to our authority under 37 C.F.R. § 41.50(b).

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

STATEMENT OF THE CASE²

The Invention

Appellants' disclosed embodiments and claimed invention "are related to marketing of businesses on the Internet." Spec. ¶ 1. "A method, apparatus, and computer program product are therefore provided for facilitating a marketing interlock between businesses on the Internet. As described herein, embodiments of the claims provide mutually beneficial co-marketing opportunities to businesses. Spec. ¶ 3.

Exemplary Claims

Claims 1, 4, 5, 7–9, and 20, reproduced below, are representative of the subject matter on appeal (*emphases* added to contested prior-art limitations):

1. A method for facilitating marketing of at least two entities, the method comprising:

receiving, from a sponsoring entity, a funding indication indicating an intent to fund a third party advertisement of a sponsored entity;

receiving, from the sponsored entity, a marketing indication indicating an intent to place marketing content of the sponsoring entity on a website associated with the sponsored entity in exchange for the sponsoring entity funding the third party advertisement of the sponsored entity; and

with a processor, and in response to the funding indication and marketing indication, causing the marketing

² Our decision relies upon Appellants' Appeal Brief ("App. Br.," filed Dec. 11, 2015); Reply Brief ("Reply Br.," filed Sept. 19, 2016); Examiner's Answer ("Ans.," mailed July 18, 2016); Final Office Action ("Final Act.," mailed July 10, 2015); and the original Specification ("Spec.," filed Sept. 30, 2013).

content of the sponsoring entity to be displayed on the website associated with the sponsored entity.

4. The method of claim 1, *wherein the third party advertisement of the sponsored entity comprises a link to the website associated with the sponsored entity.*

5. The method of claim 5, wherein the third party advertisement of the sponsored entity is provided via a web-based search engine.

7. The method of claim 1, wherein receiving the marketing indication comprises receiving an indication of an agreement between the sponsored entity and a marketing facilitator to reserve marketing content space on the website associated with the sponsored entity, wherein the agreement is made prior to receiving the funding indication, and the method further comprises maintaining the marketing content space on the website associated with the sponsored entity.

8. The method of claim 1, further comprising:
causing transmittal of a notification to a provider of the third party advertisement to provide the third party advertisement of the sponsored entity.

9. The method of claim 1, wherein the sponsored entity is not initially registered with a marketing facilitator and the funding indication comprises information identifying the sponsored entity, and the method further comprises:

in response to the funding indication, causing transmittal, to the sponsored entity, of an invitation to register with the marketing facilitator.

20. A method for facilitating business marketing relationships comprising:

identifying a service category and a defined geographic area of a subject business entity;

identifying at least one related service category to the identified service category of the subject business entity;

identifying at least one related business entity belonging to the at least one related service category and located in the defined geographic area; and

establishing a marketing relationship between the subject business entity and the at least one related business entity in a business entity database.

Prior Art

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Ho	US 2012/0041828 A1	Feb. 16, 2012
Bouthillier	US 8,818,859 B1	Aug. 26, 2014
Smith	US 2014/0278928 A1	Sept. 18, 2014

Rejections on Appeal

R1. Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. Final Act. 2.

R2. Claims 1, 3–5, and 12 stand rejected under 35 U.S.C. § 102(a)(1) as being anticipated by Bouthillier. Final Act. 4.

R3. Claims 2, 11, 13, and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Bouthillier and Smith. Final Act. 6.³

R4. Claim 6–10 and 14–18 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Bouthillier and Ho. Final Act. 7.

³ We note the Examiner cites (Final Act. 6) pre-AIA 35 U.S.C. § 103(a) in the rejection, but a more correct statement of the basis for the rejection would be under AIA 35 U.S.C. § 103.

R5. Claim 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Smith and Ho. Final Act. 10.

CLAIM GROUPING

Based on Appellants' arguments (App. Br. 8–26) and our analysis herein, we decide the appeal of patent-ineligible subject matter Rejection R1 of claims 1–20 on the basis of representative claim 1; we decide the appeal of anticipation Rejection R2 of claims 1, 3, and 12 on the basis of representative claim 1; and we decide the appeal of separately argued anticipation Rejection R2 of claims 4 and 5, *infra*.

We decide the appeal of obviousness Rejection R4 of claims 7–9 and 15–17, and obviousness Rejection R5 of claim 20, *infra*.

Remaining claims 2, 11, 13, and 19 in Rejection R3, and claims 6, 10, 14, and 18 in Rejection R4, not argued separately or with specificity, stand or fall with the respective independent claim from which they depend.⁴

ISSUES AND ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellants. We do not consider arguments Appellants could have made but chose not to make in the Briefs, and we deem any such arguments waived. 37 C.F.R. § 41.37(c)(1)(iv).

⁴ "Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(iv). In addition, when Appellants do not separately argue the patentability of dependent claims, the claims stand or fall with the claims from which they depend. *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

Based upon our review of the record, we find a preponderance of the evidence supports particular arguments advanced by Appellants with respect to Rejection R4 of claims 7–9 and 15–17, and Rejection R5 of claim 20 for the specific reasons discussed below.

However, we disagree with Appellants' arguments with respect to Rejection R1 of claims 1–20, Rejection R2 of claims 1, 3–5, and 12, Rejection R3 of claims 2, 11, 13, and 19, and Rejection R4 of claims 6, 10, 14, and 18. Unless otherwise noted, we incorporate by reference herein and 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 and rebuttals set forth in the Examiner's Answer in response to Appellants' arguments with respect to the rejections we affirm. We highlight and address specific findings and arguments regarding claims 1, 4, 7–9, and 20 for emphasis as follows.

1. § 101 Rejection R1 of Claims 1–20

Issue 1

Appellants argue (App. Br. 17–21; Reply Br. 4–7) the Examiner's rejection of claim 1 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter is in error. These contentions present us with the following issue:

Did the Examiner err in concluding the following?

Claim(s) 1–20 is/are directed towards facilitating a marketing interlock between businesses and funding a third party advertisement of sponsored entity which is considered to be an abstract idea inasmuch as such activity is considered both a method of organizing human activity a fundamental economic

practice. The claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the claims merely amount to the application or instructions to apply the abstract idea.

Final Act. 2.

Analysis

Alice Framework

Section 101 provides that anyone who "invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" may obtain a patent. 35 U.S.C. § 101. The Supreme Court has repeatedly emphasized that patent protection should not extend to claims that monopolize "the basic tools of scientific and technological work." *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012); *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014). Accordingly, laws of nature, natural phenomena, and abstract ideas are not patent-eligible subject matter. *Id.*

The Supreme Court's two-part *Mayo/Alice* framework guides us in distinguishing between patent claims that impermissibly claim the "building blocks of human ingenuity" and those that "integrate the building blocks into something more." *Alice*, 134 S. Ct. at 2354 (internal quotation marks, citation, and bracketing omitted). First, we "determine whether the claims at issue are directed to [a] patent-ineligible concept[]." *Id.* at 2355. If so, we "examine the elements of the claim to determine whether it contains an 'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Id.* at 2357 (quoting *Mayo*, 566 U.S. at 72, 79).

While the two steps of the *Alice* framework are related, the "Supreme Court's formulation makes clear that the first-stage filter is a meaningful one, sometimes ending the § 101 inquiry." *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). We note the Supreme Court "has not established a definitive rule to determine what constitutes an 'abstract idea'" for the purposes of step one. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016) (citing *Alice*, 134 S. Ct. at 2357).

However, our reviewing court has held claims ineligible as directed to an abstract idea when they merely collect electronic information, display information, or embody mental processes that could be performed by humans. *Elec. Power Grp.*, 830 F.3d at 1353–54 (collecting cases). At the same time, "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." *Mayo*, 566 U.S. at 71. Abstract ideas may include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Alice*, 134 S. Ct. at 2355–57. Under this guidance, we must therefore ensure at step one that we articulate what the claims are directed to with enough specificity to ensure the step one inquiry is meaningful. *Id.* at 2354 ("[W]e tread carefully in construing this exclusionary principle lest it swallow all of patent law.").

Under the "abstract idea" step, we must evaluate "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 Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (citation omitted). If the claims are not directed to a patent-ineligible concept, the inquiry ends. *See Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1262 (Fed.

Cir. 2017). If the concept is directed to a patent-ineligible concept, we proceed to the "inventive concept" step. For that second step we must "look with more specificity at what the claim elements add, in order to determine 'whether they identify an "inventive concept" in the application of the ineligible subject matter' to which the claim is directed." *Affinity Labs*, 838 F.3d at 1258 (quoting *Elec. Power Grp.*, 830 F.3d at 1353).

Alice Step 1 — Abstract Idea

Our reviewing court has held claims ineligible as being directed to an abstract idea when they merely collect electronic information, display information, or embody mental processes that could be performed by humans. *Elec. Power Grp.*, 830 F.3d at 1353–54 (collecting cases). At the same time, "all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." *Mayo*, 566 U.S. at 71. Under this guidance, we must therefore ensure at step one that we articulate what the claims are directed to with enough specificity to ensure the step one inquiry is meaningful. *Alice*, 134 S. Ct. at 2354 ("[W]e tread carefully in construing this exclusionary principle lest it swallow all of patent law.").

Appellants contend:

In the response dated May 1, 2015, the Applicant argued that the Supreme Court has only identified two fundamental economic practices — hedging and intermediate settlement. The Applicant argued that both cases relied on documentary evidence to show the concepts have been long prevalent in our systems. The documentary evidence included several introductory finance books. Applicant argued that the Office has not identified any such references that indicate the claimed subject matter has been a long prevalent fundamental economic

process. The Office has not responded to these arguments. Furthermore, the Applicant has cited examples of case law in which the same concepts were tested (e.g., *BuySAFE v. Google* and *Alice Corp. v. CLS Bank International*) and described how the instant case differs from these. The Office has not responded to these arguments either.

As such, Applicant maintains the arguments previously presented and further emphasizes that (1) the claims as a whole do indeed provide significantly more than an abstract idea or fundamental economic process, and (2) the claims do not preemptively seek to tie up all methods of advertising or marketing such that other cannot practice it.

App. Br. 18.

Under the "abstract idea" step, we must evaluate "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*, 838 F.3d at 1257 (citation omitted).

Turning to the claimed invention, claim 1 recites "[a] method for facilitating marketing of at least two entities." Claim 1 (preamble). The method of claim 1 further includes the steps of "receiving . . . a funding indication"; "receiving . . . a marketing indication"; and "in response to the funding indication and marketing indication, causing the marketing content of the sponsoring entity to be displayed on the website associated with the sponsored entity." Claim 1.

The Examiner concludes the appealed claims are directed to a judicial exception, i.e., the abstract idea of "facilitating a marketing interlock between businesses and funding a third party advertisement of sponsored entity which is considered to be an abstract idea inasmuch as such activity is

considered both a method of organizing human activity [and] a fundamental economic practice." Final Act. 2; *see also* Ans. 3–4.

Under step one, we agree with the Examiner that the inventions claimed in each of independent claims 1, 12, and 20 are directed to an abstract idea, i.e., methods of organizing human activity, particularly human activity associated with facilitating marketing between businesses and funding third party advertisement. *See id.*

As the Specification describes, "[a] method, apparatus, and computer program product are therefore provided for facilitating a marketing interlock between businesses on the Internet. As described herein, embodiments of the claims provide mutually beneficial co-marketing opportunities to businesses." Spec. ¶ 3. The Abstract similarly describes facilitating a marketing interlock between businesses and third-party advertising.⁵

We find this type of activity, i.e., facilitating and funding marketing between complimentary businesses on a third-party platform, and

⁵ The Abstract discloses:

A method, apparatus and computer program product are provided for facilitating a marketing interlock between businesses. Two or more businesses may enter into a co-marketing campaign in which a sponsoring entity funds an advertisement of a sponsored entity on a third party advertising system, such as a search engine. Marketing content of the sponsoring entity is inserted on the website of the sponsored entity. Traffic originating on the third party advertising system may therefore first be driven to the sponsored entity's website, and subsequently to the sponsoring entity's website, thereby achieving a mutually beneficial co-marketing relationship. Marketing relationships among complimentary businesses based on provided service and location may also be facilitated according to the methods provided.

notwithstanding that the claims on appeal rely at least to some extent upon computer and Internet technology for implementation, includes longstanding conduct that existed well before the advent of computers and the Internet, and could be carried out by a human with pen and paper, e.g., by written contract, or in face-to-face meetings. *See CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011) ("That purely mental processes can be unpatentable, even when performed by a computer, was precisely the holding of the Supreme Court in *Gottschalk v. Benson*.").⁶

We further find this ordered combination of steps recites an abstraction — an idea, having no particular concrete or tangible form. The process of "receiving . . . a funding indication"; "receiving . . . a marketing indication"; and "in response to the funding indication and marketing indication, causing the marketing content of the sponsoring entity to be displayed on the website associated with the sponsored entity" all describe an abstract idea, devoid of a concrete or tangible application. *See, e.g., Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014).

Our reviewing court has previously held other patent claims ineligible for reciting similar abstract concepts. For example, while the Supreme Court has enhanced the § 101 analysis since *CyberSource* in cases like *Mayo* and *Alice*, they continue to "treat[] analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category." *Synopsys*,

⁶ *CyberSource* further guides that "a method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101." *CyberSource*, 654 F.3d at 1373.

Inc. v. Mentor Graphics Corp., 839 F.3d 1138, 1146–47 (Fed. Cir. 2016) (alteration in original) (quoting *Elec. Power Grp.*, 830 F.3d at 1354).

Therefore, in agreement with the Examiner, we conclude claim 1 involves nothing more than marketing and funding third-party advertising, without any particular inventive technology — an abstract idea. See *Elec. Power Grp.*, 830 F.3d at 1354. We further refer to *Content Extraction*, where the Federal Circuit has provided additional guidance on the issue of statutory subject matter by holding claims to collecting data, recognizing certain data within the collected data set, and storing that recognized data in memory were directed to an abstract idea and therefore unpatentable under § 101. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343 (Fed. Cir. 2014). 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).

Accordingly, on this record, and under step one of *Alice*, we agree with the Examiner's conclusion the claims are directed to an abstract idea.

Alice Step 2—Inventive Concept

Because the claims are directed to a patent-ineligible concept, as we conclude above, we proceed to the "inventive concept" step. For that step we must "look with more specificity at what the claim elements add, in order to determine 'whether they identify an "inventive concept" in the application of the ineligible subject matter' to which the claim is directed." *Affinity Labs*, 838 F.3d at 1258 (quoting *Elec. Power Grp.*, 830 F.3d at 1353).

In applying step two of the *Alice* analysis, our reviewing court guides 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. *Ulramercial*, 772 F.3d at 715. To this end, we determine 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. *Alice*, 134 S. Ct. at 2357. Those "additional features" must be more than "well-understood, routine, conventional activity." *Mayo*, 566 U.S. at 79.

In arguing under Step 2 of the *Alice* analysis, Appellants allege the claims are directed to statutory subject matter because:

[T]he claims amount to significantly more than an abstract idea or fundamental economic process. The claims provide additional recitations directed to the specific problem and solution described above. Similar to concepts tested in *DDR*, embodiments of the claims *transform* a website of the sponsored entity in response to receipt of (1) a funding indication and (2) a marketing indication. The ability for such a transformation of the website to occur without a specific request from the sponsored entity, while driving increased traffic to at least two websites solves an Internet-centric problem in the very specific scenario involving the marketing of two entities with a single paid-for or sponsored advertisement. That is, the funding indication and corresponding third party advertisement of a sponsored entity draws additional web traffic to the website of the sponsored entity, which indirectly routes web traffic to the sponsoring entity's site, as the marketing indication results in the marketing content of the sponsoring entity to be displayed on the website of the sponsored entity. The intricacies of such embodiments therefore do indeed amount to significantly more than an abstract idea or fundamental economic process relating to merely advertising, marketing or sponsorship.

App. Br. 20. Appellants further argue "the claims to do not tie up all methods of advertising, marketing or sponsorship such that others cannot practice it." *Id.*

In response to Appellants' reliance upon *DDR* and the alleged website transformation,⁷ the Examiner states, "the second step in the analysis requires us to determine whether the claims do significantly more than simply describe the abstract method" and "the instant claimed invention is in fact merely carried out by a generically recited computing platform. . . . Those 'additional features' must be more than 'well-understood, routine, conventional activity.'" Ans. 4 (citing *Mayo*, 566 U.S. at 79).

Evaluating representative claim 1 under Step 2, we agree with the Examiner that it lacks an inventive concept that transforms the abstract idea of facilitating and funding marketing between complimentary businesses on a third-party platform into a patent-eligible application of that abstract idea. *See* Ans. 4–5.

As held in *DDR*, we conclude the test of eligibility is not based on whether the claimed invention could only be carried out with a computer or over the Internet. "*DDR Holdings* does not apply when . . . the asserted claims do not 'attempt to solve a challenge particular to the Internet.'" *Smart Sys. Innovations, LLC v. Chi. Transit Auth.*, 873 F.3d 1364, 1375 (Fed. Cir. 2017) (quoting *In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016)). Rather, when using a generic computer, the test is whether the claimed invention effects an improvement to another technology

⁷ *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014).

or technical field; whether the claimed invention does amount to an improvement to the functioning of a computer itself; and whether the claimed invention does move beyond a general link of the use of an abstract idea to a particular technological environment. *DDR*, 773 F.3d at 1259. In this case, we conclude the claimed invention does not meet any of the aforementioned criteria. The technology implemented in the present application is useful to solve a *business problem*, but the additional elements are not a technological solution to a technological problem, or a solution to a problem introduced by the technology itself. Therefore, we conclude Appellants' claims do not address a similar problem and do not contain a similar inventive concept as the patent-eligible claims in *DDR*.⁸

We agree with the Examiner because, as in *Alice*, we find the recitation of "[a] method for facilitating marketing of at least two entities" that "with a processor," causes marketing content to be displayed on a website (claim 1); "[a] computer program product for facilitating marketing of at least two entities" executed by "an apparatus" to cause marketing content to be displayed on a website (claim 12); or "[a] method for facilitating business marketing relationships" that utilizes a "business entity database" (claim 20) are simply not enough to transform the patent-ineligible abstract idea here into a patent-eligible invention. *See Alice*, 134 S. Ct.

⁸ We note independent claims 1, 12, and 20 provide scant reference to or recitations of any computer technology/components.

at 2357 ("[C]laims, which merely require generic computer implementation, fail to transform [an] abstract idea into a patent-eligible invention.").⁹

Accordingly, based upon the analysis above, on this record, we are not persuaded of error in the Examiner's conclusion that the appealed claims are directed to patent-ineligible subject matter. Therefore, we sustain the Examiner's § 101 rejection of independent claim 1, and grouped claims 2–20, which fall therewith. *See Claim Grouping, supra.*

2. § 102(a)(1) Rejection R2 of Claims 1, 3, and 12

Issue 2

Appellants argue (App. Br. 11–16; Reply Br. 1–3) the Examiner's rejection of claim 1 under 35 U.S.C. § 102(a)(1) as being anticipated by Bouthillier is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art discloses a "method for facilitating marketing of at least two entities" that includes, *inter alia*, the steps of "receiving, from the sponsored entity, a marketing indication indicating an intent to place marketing content of the sponsoring entity on a website associated with the sponsored entity in exchange for the sponsoring entity funding the third party advertisement of the sponsored entity;" and "in response to the funding indication and marketing indication, causing the marketing content of the sponsoring entity to be displayed on the website associated with the sponsored entity," as recited in claim 1?

⁹ As evidence of the conventional nature of the claimed components and processes, we highlight Appellants' Specification, e.g., paragraph 37 and Figure 2.

Analysis

Receiving a Marketing Indication

Appellants contend, "Bouthillier fails to provide any suggestion of a marketing indication from the *sponsored* entity, such that marketing content of the *sponsoring* entity be placed on a website associated with the *sponsored* entity. Applicant specifically argued that Bouthillier fails to distinguish between a sponsored entity and sponsoring entity" App. Br. 13. Appellants further allege the Examiner, while referencing "the broadest reasonable interpretation in light of the supporting disclosure," "fails to refer to what alleged broad interpretations from the specification of the pending application are being considered." App. Br. 14. Appellants also contend, "there is no broader interpretation described in the specification of the pending application that would lead one skilled in the art to consider that Bouthillier describes a sponsored entity, sponsoring entity, and the marketing of *both* such as presented in the claims and as supported by the specification." *Id.*

In response, and as cited by the Examiner under the broadest reasonable interpretation standard,¹⁰ we find Bouthillier discloses a "sponsor

¹⁰ During prosecution, claims must be given their broadest reasonable interpretation when reading claim language in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Under this standard, we interpret claim terms using "the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

of the ad" (Bouthillier col. 2, ll. 10 and ll. 22–23¹¹) and a "sponsored entity." Bouthillier col. 1, l. 65 – col. 2, l. 2 ("The advertisement management is provided as a . . . system which connects advertisers for a product or service with ad-creators, ad-sponsors and end-customers, while enabling end-customers (viewers of the ad) to obtain content for free in exchange for viewing the ad.").

As cited by the Examiner, Bouthillier further discloses:

The advertisement management system has several advantages which will be apparent upon reading the following detailed description. The advertisement system connects viewers of advertisements directly with sponsors of an advertisement to allow for targeted advertising. Additionally, the system provides an arrangement where viewers and other end-customers or end-users are able to access content from content providers by viewing an advertisement that is related to a particular product or service which they choose. For example, a user may select an advertisement for a credit card, or for a vehicle of their choice. *Sponsors of the advertisement (which may or may not be owners of the particular product or service which the advertisement is related to) provide funds to sponsor the advertisement. These funds are sent in part to the creator of the advertisement, so that they may be compensated for creating the advertisement. The funds are also sent in part to the content provider, the content provider having content which the end-customer wishes to acquire.* The user is able to view an ad, by choosing an advertisement related to a product or service which they are interested in, and upon completion of the advertisement, the content provider is compensated from funds provided by the sponsor of the advertisement.

Bouthillier col. 3, ll. 32–54 (emphasis added).

¹¹ "The present invention also relates to a process for an ad-sponsor to sponsor a posted GTVideo" Bouthillier col. 2, ll. 22–23.

Thus, we find Bouthillier discloses receiving the recited marketing indication from the sponsored entity, as well as a sponsoring entity.

Causing Marketing Content to be Displayed

Appellants contend "the current rejection does not explain any reasoning for the Office changing positions [from a previous rejection on the disclosure of Bouthillier] and it is therefore submitted that the concession was made in response to the Applicant's prior arguments, and not in error," and "Applicant maintains that Bouthillier does not disclose [the contested limitation]." App. Br. 15.

The Examiner cites to Bouthillier at column 3, lines 32–63¹² as disclosing this contested limitation. Final Act. 4. In addition, in the Answer, the Examiner provides clarification of the findings:

Bouthillier teaches in response to the funding indication and marketing indication, causing the marketing content of the sponsoring entity to be displayed on the website associated with the sponsored entity, (see Fig. 8 804: "the GTVideo is the marketing content of the sponsoring entity") to be displayed (see Fig. 8 800 "display on the website") associated with the sponsored entity (Fig. 8 806 "where to buy[") and (Fig.11 1122 "sponsor") and (Fig. 12 1220 "Ad Sponsor Info").

Ans. 2.

¹² Column 3 of Bouthillier discloses: "viewing an advertisement" (l. 39); "[t]he user is able to view an ad" (ll. 49–50); and "[r]efer to FIGS. 9 to 12 for diagrams of exemplary screen displays of an interface of the advertisement system in accordance with an operative embodiment of the present invention" (ll. 60–63).

Thus, under the broadest reasonable interpretation, we agree with the Examiner's findings that Bouthillier discloses this second contested claim limitation.

Therefore, based upon the findings above, on this record, we are not persuaded of error in the Examiner's reliance on the cited prior art to disclose the disputed limitations of claim 1, nor do we find error in the Examiner's resulting finding of anticipation. Therefore, we sustain the Examiner's anticipation rejection of independent claim 1, and grouped claims 3 and 12 which fall therewith. *See Claim Grouping, supra.*

3. § 102 Rejection R2 of Claims 4 and 5¹³

Issue 3

Appellants argue (App. Br. 16–17) the Examiner's rejection of claim 4 under 35 U.S.C. § 102(a)(1) as being anticipated by Bouthillier is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art discloses the method of claim 1, "wherein the third party advertisement of the sponsored entity comprises a link to the website associated with the sponsored entity," as recited in claim 4?

Analysis

The Examiner cites Bouthillier column 2, lines 22 to 28 as disclosing this limitation (Final Act. 5), but Appellants contend, "[t]his passage is completely silent regarding a link to a website associated with the sponsored entity." App. Br. 16. We disagree.

¹³ Claim 5 may be construed as indefinite under 35 U.S.C. § 112, second paragraph. *See infra*, "New Ground of Rejection".

We disagree because:

Bouthillier teaches where the third party advertisement of the sponsored entity comprises a link to the website associated with the sponsored entity (col. 9 lines 38–42 "The term link as used herein includes any graphical representation corresponding to a data file, such as a hyperlink or URL (uniform resource locator) link, as well as other linking capabilities readily apparent to those skilled in the art") and (col. 2 lines 34–37 "GTVideos often provide purchasing information, which may include product/service cost and availability through online and local retail outlets or direct links to facilitate the viewers' purchase of the product.").

Ans. 3.

Therefore, we affirm the Examiner's rejection of dependent claim 4.

Appellants also argue claim 5 is not anticipated by Bouthillier, and allege the Examiner (*see* Final Act. 5) has not adequately addressed the rejection. Reply Br. 3.

Claim 5 recites, in pertinent part, "wherein the third party advertisement of the sponsored entity is provided via a web-based search engine." Although claim 5 depends from itself—an inconsistency that renders the claim indefinite as noted in our new ground of rejection later in this opinion—we nonetheless presume that the claim depends from claim 1 for purposes of this appeal.

Turning to the rejection, the Examiner cites Bouthillier at column 3, lines 64 through 67 and column 4, lines 1 through 7 for disclosing this limitation.¹⁴ Final Act. 5. We agree with the Examiner's findings.

¹⁴ This portion of Bouthillier states:

We agree because Bouthillier's "Graditube database uses product identification methods, such as a web-search" that, under the broadest reasonable interpretation, involves a "web-based search engine." Bouthillier col. 4, ll. 2–4.

Therefore, we also affirm the anticipation Rejection R2 of claim 5.

4. § 103(a) Rejection R4 of Claims 7–9 and 15–17

Issue 4

Appellants argue (App. Br. 11–16; Reply Br. 1–3) the Examiner's rejection of claim 7 under 35 U.S.C. § 103(a) as being obvious over the combination of Bouthillier and Ho is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art teaches or suggests the method of claim 1, wherein (1) "receiving the marketing indication comprises receiving an indication of an agreement between the sponsored entity and a marketing facilitator to reserve marketing content space on the website associated with the sponsored entity"; (2) "the agreement is made

GTVideos are conventional commercial advertisements or customer-created, context sensitive video advertisements or other appropriate media files, such as a message sent to a phone or other device using a multimedia message service, that customers of products or services create and post to the Graditube Web Server Database. The Graditube database uses product identification methods, such as a web-search or UPC/SKU look-up to ensure that GTVideos are correctly associated with specific product instances. FIGS. 5 and 6, described below, detail the procedures for posting and sponsoring videos, respectively.

Bouthillier col. 3, l. 64 – col. 4, l. 7.

prior to receiving the funding indication"; and (3) "the method further comprises maintaining the marketing content space on the website associated with the sponsored entity," as recited in claim 7?

Analysis

Appellants contend the Examiner merely referred to Ho paragraph 22 and Figure 10b as "showing weighted percentages at which 6 different sponsors, jointly contributing to a sponsorship, are sponsored on a website with rotating corresponding advertisements." App. Br. 22; *see also* Final Act. 8.¹⁵

On this record, given the paucity of the disclosure relied upon in Ho to teach or suggest the contested limitation of claim 7, we find the Examiner did not adequately map the contested limitations of claim 7 to the reference combination in a manner that meets the threshold burden necessary to establish a *prima facie* case of obviousness. Accordingly, we do not sustain Rejection R4 of claims 7 and 15, argued together.

Appellants make similar arguments with respect to Rejection R4 of claims 8 and 16, i.e., the Examiner does not adequately map the contested limitations of claim 8 to the prior art combination of Bouthillier and Ho. App. Br. 22–23; and *see* Final Act. 8 (again citing Ho ¶ 22). Accordingly, we do not sustain Rejection R4 of claims 8 and 16, argued together.

With respect to claims 9 and 17, the Examiner cites Ho at paragraph 35 (*see* Final Act 8; Ans. 7) as teaching or suggesting, "in

¹⁵ "FIG. 10b shows a weighted randomization module for a graphical representation of a sponsor selection rotation module, in accordance with an embodiment of the invention." Ho ¶ 22.

response to the funding indication, causing transmittal, to the sponsored entity, of an invitation to register with the marketing facilitator." Claim 9.¹⁶

We agree with Appellants that the Examiner's mapping is deficient with respect to the disputed limitations of claims 9 and 17. Accordingly, we do not sustain Rejection R4 of claims 9 and 17, argued together.

5. § 103(a) Rejection R5 of Claim 20

Issue 5

Appellants argue (App. Br. 24–26) the Examiner's rejection of claim 20 under 35 U.S.C. § 103(a) as being obvious over the combination of Smith and Ho is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art teaches or suggests "[a] method for facilitating business marketing relationships" that includes, the steps as recited in claim 20?

¹⁶ The portion of Ho relied upon by the Examiner in rejecting claims 9 and 17 discloses:

FIG.1 shows a conventional layout (100) of presenting all multiple sponsors on a same webpage, in accordance with a conventional method. This conventional method illustrates how all multiple sponsors are presented in one webpage. The webpage is based on an example of a "World Cup Contest" registration for a website visitor. The visual heuristics, or effectiveness of the single-page web advertisement for many sponsors (e.g. 16 national sponsor teams presented in FIG. 1), is less than optimal because too much information is presented to the website visitor all at once. Such a cluttered presentation of multiple or multiple sponsor information may not be the most effective form of advertising, as a typical website visitor may find the excessive number of all sponsors unmemorable.

Ho ¶ 35.

Analysis

The Examiner relied upon paragraph 11 of Smith and paragraph 50 of Ho as teaching or suggesting all the limitations of claim 20. *See* Final Act. 10–11. Appellants argue all the limitations in their Appeal Brief. *See* App. Br. 24–26. However, in the Answer, the Examiner only partially responds by stating,

the combination Smith and Ho do teach identifying a service category and a defined geographic area of a subject business entity (paragraph 0011: "Advertiser data may include a specification of a target geographic and/or demographic as well as an image-based ad to be used with appropriate clubs and separately branch or local contact information").

Ans. 9.

We disagree with the Examiner for the same reasons set forth by Appellants. *See* App. Br. 24–26. Accordingly, we do not sustain Rejection R5 of claim 20.

6. Rejection R3 of claims 2, 11, 13, and 19, and Rejection R4 of Claims 6, 10, 14, and 18 — Not Separately Argued

In view of the lack of any substantive or separate arguments directed to obviousness Rejections R3 of claims 2, 11, 13, and 19 and Rejection R4 claims 6, 10, 14, and 18 under § 103 (*see* App. Br. 21–24), we sustain the Examiner's rejection of these claims. Arguments not made are waived.¹⁷

¹⁷ Appellants merely argue,

the cited combination relies upon Bouthillier for disclosing the same features as described above with respect to the rejection of the independent claims. Since Bouthillier fails in this regard, and Smith does not cure the deficiencies of Bouthillier, nor is Smith cited for this

REPLY BRIEF

To the extent Appellants *may* advance new arguments in the Reply Brief (Reply Br. 1–7) not in response to a shift in the Examiner's position in the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause (*see* 37 C.F.R. § 41.41(b)(2)), which Appellants have not shown.

NEW GROUND OF REJECTION

Pursuant to our authority under C.F.R. § 41.50(b), we enter a new ground of rejection for claim 5 under 35 U.S.C. § 112(b) for indefiniteness. Original dependent claim 5 depends from itself. *See* claim 5, *supra*.

CONCLUSIONS

(1) The Examiner did not err with respect to patent-ineligible subject matter Rejection R1 of claims 1–20 under 35 U.S.C. § 101, and we sustain the rejection.

(2) The Examiner did not err with respect to anticipation Rejection R2 of claims 1, 3–5, and 12 under 35 U.S.C. § 102(a)(1) over the cited prior art of record, and we sustain the rejection.

(3) The Examiner did not err with respect to obviousness Rejection R3 of claims 2, 11, 13, and 19 under 35 U.S.C. § 103 over the cited prior art combination of record, and we sustain the rejection.

purpose, claims 2, 11, 13, and 19 are patentable over the cited combination due at least to the failures of Bouthillier.
App. Br. 21.

(4) The Examiner erred with respect to obviousness Rejection R4 of claims 7–9 and 15–17 under 35 U.S.C. § 103 over the cited prior art combination of record, and we do not sustain the rejection.

However, the Examiner did not err with respect to obviousness Rejection R4 of claims 6, 10, 14, and 18 under 35 U.S.C. § 103 over the cited prior art combination of record, and we sustain the rejection.

(5) The Examiner erred with respect to obviousness Rejection R5 of claim 20 under 35 U.S.C. § 103, and we do not sustain the rejection.

(6) We enter a new ground of rejection of claim 5 under 35 U.S.C. § 112(b) for indefiniteness.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, we affirm the Examiner's decision. *See* 37 C.F.R. § 41.50(a)(1).

DECISION

We affirm the Examiner's decision rejecting claims 1–20.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating

to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

AFFIRMED

37 C.F.R. § 41.50(b)