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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/277,603	11/25/2008	Ravi R. Subramanian	325356-US-NP	6343
69316	7590	03/21/2018	EXAMINER	
MICROSOFT CORPORATION ONE MICROSOFT WAY REDMOND, WA 98052			STOLTENBERG, DAVID J	
			ART UNIT	PAPER NUMBER
			3682	
			NOTIFICATION DATE	DELIVERY MODE
			03/21/2018	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAVI R. SUBRAMANIAN and SCOTT COLVILLE

Appeal 2016-008651
Application 12/277,603
Technology Center 3600

Before JOHN A. EVANS, CHARLES J. BOUDREAU, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants¹ seek our review under 35 U.S.C. § 134(a) from a final rejection of claims 1–7 and 9–32, i.e., all pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ Appellants identify the real party in interest as Microsoft Technology Licensing LLC. App. Br. 3.

STATEMENT OF THE CASE

The Invention

According to the Specification, the invention concerns “context-sensitive advertising for content on a mobile device.” Spec. ¶ 15.² For example, “content” includes emails and instant messages. *Id.* The Specification explains that: (1) “relevant advertisements are provided to the mobile device, and one or more of the relevant advertisements are injected into content, by the mobile device”; (2) “an advertisement is marked with a sentinel marker when it is injected into content”; and (3) “[w]hen the content is to be sent from the device, the sentinel marker is detected and the marked advertisement is removed from the content before the content leaves the device.” Abstract; *see* Spec. ¶ 5.

Exemplary Claims

Independent claims 1 and 9 exemplify the claims at issue and read as follows (with formatting added for clarity):

1. A method comprising:

receiving, at a computing device, content that is to be presented on the computing device, wherein the content that is to be presented on the computing device includes injectable content injected into the content;

receiving an indication that the content is to be sent from the computing device to one or more user devices;

² This decision uses the following abbreviations: “Spec.” for the Specification, filed November 25, 2008; “Final Act.” for the Final Office Action, mailed April 14, 2015; “App. Br.” for the Appeal Brief, filed December 8, 2015; “Ans.” for the Examiner’s Answer, mailed July 20, 2016; and “Reply Br.” for the Reply Brief, filed September 20, 2016.

removing the injectable content from the content that is to be sent before the content is sent from the computing device to the one or more user devices; and

sending the content with the injectable content removed, from the computing device to the one or more user devices without first being queried for the content by at least one of the one or more user devices.

9. A computing device comprising:

one or more processors;

one or more computer-readable storage media embodying software instructions which, when executed by the one or more processors, implement a method comprising:

receiving, at the computing device, injectable content from a remote resource, the injectable content configured to be:

embedded into and displayed with content on a display associated with the computing device, and

identified by a sentinel marker that identifies the injectable content as being distinct from the content;

receiving a signal representing an indication that the content is to be sent from the computing device to a device different from the computing device;

detecting the sentinel marker in the content; and

removing, using the sentinel marker, the injectable content from the content before the content is sent from the computing device to the device different from the computing device; and

transmitting the content from the computing device.

The Prior Art Supporting the Rejections on Appeal

As evidence of unpatentability, the Examiner relies on the following prior art:

Bandera et al. (“Bandera”)	US 6,332,127 B1	Dec. 18, 2001
Voisin et al. (“Voisin”)	US 7,103,563 B1	Sept. 5, 2006
Goldentouch	US 2009/0254529 A1	Oct. 8, 2009 (filed Apr. 2, 2009) (provisional appl. filed Apr. 4, 2008)
Crolley	US 7,778,873 B2	Aug. 17, 2010 (filed Apr. 20, 2005)
Mekikian	US 8,135,799 B2	Mar. 13, 2012 (filed Jan. 11, 2007)

The Rejections on Appeal

Claims 1–7 and 9–32 stand rejected under 35 U.S.C. § 101 as directed to patent-ineligible subject matter. Final Act. 2–8.

Claims 1, 2, 5, 6, 9, 10, 12–17, and 19–32 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bandera and Goldentouch. Final Act. 9–36.

Claims 3 and 11 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bandera, Goldentouch, and Crolley. Final Act. 36–38.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Bandera, Goldentouch, and Voisin. Final Act. 38–39.

Claims 4 and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bandera, Goldentouch, and Mekikian. Final Act. 39–40.

ANALYSIS

We have reviewed the rejections in light of Appellants’ arguments that the Examiner erred. For the reasons explained below, we concur with the Examiner’s conclusions concerning unpatentability under § 101 and § 103(a). We adopt the Examiner’s findings and reasoning in the Final Office Action (Final Act. 2–43) and Answer (Ans. 3–12). We add the following to address and emphasize specific findings and arguments.

The § 101 Rejection of Claims 1–7 and 9–32

INTRODUCTION

The Patent Act defines patent-eligible subject matter broadly: “Whoever 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 therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 70 (2012), and *Alice Corp. v. CLS Bank International*, 134 S. Ct. 2347, 2354 (2014), the Supreme Court explained that § 101 “contains an important implicit exception” for laws of nature, natural phenomena, and abstract ideas. *See Diamond v. Diehr*, 450 U.S. 175, 185 (1981). In *Mayo* and *Alice*, the Court set forth a two-step analytical framework for evaluating patent-eligible subject matter: First, “determine whether the claims at issue are directed to” a patent-ineligible concept, such as an abstract idea. *Alice*, 134 S. Ct. at 2355. If so, “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements” add enough to transform the “nature of the claim” into “significantly more” than a patent-ineligible concept. *Id.* at 2355, 2357 (quoting *Mayo*, 566 U.S.

at 79); see *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Step one of the *Mayo/Alice* framework involves looking at the “focus” of the claims at issue and their “character as a whole.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). Step two involves the search for an “inventive concept.” *Alice*, 134 S. Ct. at 2355; *Elec. Power Grp.*, 830 F.3d at 1353. Under step two, “an inventive concept must be evident in the claims.” *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017). And although “an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces,” *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016), an “inventive concept” requires more than “well-understood, routine, conventional activity already engaged in” by the relevant community, *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1047 (Fed. Cir. 2016) (quoting *Mayo*, 566 U.S. at 79–80).

MAYO/ALICE STEP ONE

Appellants assert that independent claims 1, 9, 14, 24, and 29 satisfy *Mayo/Alice* step one because they include steps that “are not fundamental economic practices, methods of organizing human activity, an idea itself, or a mathematic relationship.” App. Br. 13, 16–19. Appellants further assert that the Examiner failed to consider the claims “taken as a whole” and instead analyzed only some claim elements. *Id.* at 13, 15–17.

Appellants’ assertions do not persuade us of Examiner error. The Examiner determines that the claims are directed to the abstract idea of “receiving, removing, and sending content,” in particular, “receiving

content, removing some of the content (e.g. the injectable content), and sending the remaining content (e.g. to one or more other users).” Final Act. 5, 41; Ans. 3. Hence, the Examiner accurately assesses the “focus” of the claims at issue. *See Elec. Power Grp.*, 830 F.3d at 1353.

The Examiner also determines that the claims concern a method of organizing human activity, i.e., a “sequence of claimed steps” for “removing an inserted advertisement from received correspondence and sending the correspondence without the advertisement to another destination.” Final Act. 5, 41; Ans. 3. That sequence of claimed steps is analogous in substance to the “series of steps instructing how to hedge risk” in a commodities market recited in the claims at issue in *Bilski v. Kappos*, 561 U.S. 593, 599 (2010). In *Alice*, the Supreme Court explained that the claims in *Bilski* concerned a method of organizing human activity. *Alice*, 134 S. Ct. at 2356; *see also Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015) (finding the claim at issue “not meaningfully different from the ideas found to be abstract in other cases before the Supreme Court and our court involving methods of organizing human activity”).

In addition, the claims cover data collection and manipulation. *See* Ans. 4–5. The Federal Circuit has ruled that claims covering data collection and manipulation were directed to abstract ideas. *See, e.g., Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1047, 1054–56 & n.6 (Fed. Cir. 2017); *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1339–40 (Fed. Cir. 2017); *Elec. Power Grp.*, 830 F.3d at 1351–54.

MAYO/ALICE STEP TWO

Appellants assert that independent claims 1, 9, 14, 24, and 29 satisfy *Mayo/Alice* step two because they “satisfy the machine-or-transformation test.” App. Br. 15. Appellants also assert that the claims include “meaningful limitations” that: (1) “sufficiently tie the claimed features to a particular machine”; and (2) “transform content with injectable content to content with the injectable content removed enabling improved device performance with reduced size of content file.” *Id.*

Appellants’ assertions do not persuade us of Examiner error. After *Mayo* and *Alice*, satisfying the machine-or-transformation test does not necessarily demonstrate patent eligibility because “not all transformations or machine implementations infuse an otherwise ineligible claim with an ‘inventive concept.’” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014); *see also Vehicle Intelligence & Safety LLC v. Mercedes-Benz USA, LLC*, 635 F. App’x 914, 919 (Fed. Cir. 2015). Simply using a “physical machine” does not impart patent eligibility. *See Mayo*, 566 U.S. at 84. In *Alice*, for example, “[a]ll of the claims [we]re implemented using a computer.” 134 S. Ct. at 2353, 2360.

Moreover, the machine-or-transformation test requires “an apparatus specific to the claimed invention” for patent eligibility. *Smart Sys. Innovations, LLC v. Chi. Transit Auth.*, 873 F.3d 1364, 1375 (Fed. Cir. 2017). Here, the claims at issue do not require “an apparatus specific to the claimed invention” but instead recite generic computer components performing generic computer functions. *See App. Br. 37–46 (Claims App.)*; *see also* Final Act. 5–7; Ans. 4–5. For instance, claim 9 recites a “computing device” comprising “one or more processors,” “one or more

computer-readable storage media,” and a “display.” App. Br. 38–39. Further, the Specification describes generic computer components rather than an invention-specific hardware arrangement. *See, e.g.*, Spec. ¶¶ 19, 54–56, Fig. 8. As the Examiner reasons, “none of the hardware recited” provides “a meaningful limitation beyond generally linking the use of the method to a particular technological environment.” Final Act. 7.

Regarding the asserted transformation, the Examiner reasons that: (1) “there is no physical transformation of any matter taking place”; and (2) “there is no transformation taking place, not even of the content involved.” Final Act. 42; Ans. 4. The Examiner explains that “[t]he claims receive[] two types of content, remove[] one of the types of content,” “send[] the other type of content,” and “[b]oth pieces of content remain the same.” Final Act. 42; Ans. 4.

In addition, the transformation of informational content would not confer patent eligibility. The Federal Circuit has ruled that claims covering the transformation of information in one form (“a functional description of a logic circuit”) into another form (“a hardware component description of the logic circuit”) were directed to abstract ideas. *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1139, 1150–51 (Fed. Cir. 2016); *see Gottschalk v. Benson*, 409 U.S. 63, 71–74 (1972) (holding that claims covering methods for converting binary-coded decimal numbers to binary numbers did not satisfy § 101).

Appellants contend, without citing any supporting evidence, that “with the injectable content removed from the content, there is improved device performance with reduced size of the content file and, consequently, reduced bandwidth capacity for transmitting.” App. Br. 14, 16–19.

Appellants' contention constitutes attorney argument. Attorney argument "cannot take the place of evidence." *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974).

In addition, the Examiner reasons that "reducing the size of a file may in fact improve system performance" but "relating any system performance increase on a file size reduction should take into account the relative size reduction as well as other factors before any performance enhancement may be realized." Ans. 5. The Examiner explains that "if the original content file is large, and the inserted content is relatively small, a removal of the inserted content would have little if any effect upon system performance." *Id.* Further, the Examiner finds that the Specification lacks "any recitation or disclosure of an improvement in computer or network performance" due to the claimed invention. *Id.* Accordingly, the Examiner determines that the claimed invention does not "improve the functioning of the computer itself or another technology or technical field." Final Act. 5. Appellants' arguments do not persuade us of error in the Examiner's determinations.

Consequently, we agree with the Examiner that the claims at issue lack meaningful limitations needed to transform them into significantly more than a patent-ineligible abstract idea, and thus do not satisfy *Mayo/Alice* step two. Final Act. 6–7; *see* Ans. 5–6.

SUMMARY

For the reasons discussed above, Appellants' arguments have not persuaded us that the Examiner erred in rejecting independent claims 1, 9, 14, 24, and 29 under § 101. Hence, we sustain the § 101 rejection of these independent claims.

Claims 2–7, 10–13, 15–23, 25–28, and 30–32 depend directly or indirectly from an independent claim discussed above. Appellants do not argue patentability separately for these dependent claims. App. Br. 13–19; Reply Br. 1–2. Because Appellants do not argue the claims separately, we sustain the § 101 rejection of these dependent claims for the same reasons as the independent claims. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The § 103(a) Rejections of Claims 1–7 and 9–32

REMOVING THE INJECTABLE CONTENT BEFORE SENDING

Appellants argue that the Examiner erred in rejecting independent claims 1, 9, 14, 24, and 29 because Bandera and Goldentouch fail to teach or suggest the following limitation in claim 1 and similar limitations in the other independent claims: “removing the injectable content from the content that is to be sent before the content is sent from the computing device to the one or more user devices.” App. Br. 22, 26, 28, 31, 34. Appellants contend that the Examiner “concedes that Bandera is not directed to this subject matter.” *Id.* at 23. Appellants then assert that Goldentouch discloses: (1) generating from a source internet document a second internet document “further including” certain “granular elements” and “granular element associated information”; and (2) sending the second internet document containing additional content compared to the source internet document. *Id.* at 23, 27, 29, 32, 34–35 (quoting Goldentouch ¶ 160). Appellants contrast Goldentouch’s addition of content before sending to the claimed removal of content before sending. *Id.* at 24, 26–27.

Appellants’ arguments do not persuade us of Examiner error because, as the Examiner finds, Goldentouch discloses: (1) acquiring a source internet document, such as an HTML document, that may include an embedded

object, e.g., an advertising object; (2) generating a second internet document from the source internet document by adding or removing content, e.g., removing an advertising object; and (3) sending the second internet document to a user device, such as a cellular device. Goldentouch ¶¶ 60–61, 106, 115, 119–120, 124–125, 160, 166–169, 442, 449, 548, 569, Fig. 4A; see Final Act. 10–11 (citing Goldentouch ¶¶ 61, 442, 548, 568); Ans. 6–8 (citing Goldentouch ¶¶ 106, 115, 125, 160, 166–167, 449, 569). For example, Goldentouch explains that embedded content in a source internet document includes “active objects” and that document modification involves “remov[ing] scripts, advertising or other” objects. Goldentouch ¶¶ 125, 569. Further, Goldentouch describes document-modification algorithms, such as “ad-blocking algorithms,” that “remove or otherwise modify” content. *Id.* ¶¶ 127, 157, 373, 385, 564.

Although Goldentouch discloses adding content, such as “granular element associated information,” when generating the second internet document, adding content does not distinguish Goldentouch from the claims. The claims use the transitional term “comprising” and, therefore, do not exclude unrecited elements, such as “granular element associated information.” See *Regeneron Pharm., Inc. v. Merus N.V.*, 864 F.3d 1343, 1352 (Fed. Cir. 2017) (citing *Manual of Patent Examining Procedure* § 2111.03).

Appellants assert that “Goldentouch teaches directly away from” the claimed subject matter by “requiring generation of a second document” with additional content. App. Br. 24, 27, 29, 32, 35. “A reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’

investigation into the invention claimed.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (quoting *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004)). Here, Goldentouch’s disclosure of content addition as well as content removal when generating the second internet document does not “criticize, discredit, or otherwise discourage” investigation into the claimed subject matter.

Appellants argue that “modifying Goldentouch to meet” the claimed subject matter “would change the intended purpose of Goldentouch which is to allow users to collaborate on a second document while maintaining the original version information.” App. Br. 24, 27, 29–30, 32, 35. But that argument does not respond to the rejection because the Examiner relies on *Bandera* as the primary reference and Goldentouch as the secondary reference. *See* Final Act. 9–11. Based on Goldentouch’s teachings, the Examiner determines that “it would have been obvious to one having ordinary skill in the art at the time the invention was made for Bandera to strip off (remove) the inserted advertising object.” *Id.* at 11. In addition, obviousness does not depend on “whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

REMOVING THE INJECTABLE
CONTENT IN RESPONSE TO A SIGNAL

Appellants argue that the Examiner erred in rejecting independent claims 14 and 29 because “there is simply no indication in Goldentouch that the injectable content is removed ‘responsive to receiving a signal representing an indication to send the content’ as recited in” these claims. App. Br. 30, 35. We disagree.

As the Examiner finds, Goldentouch discloses document modification in response to receiving a query for a document. Goldentouch ¶¶ 129, 172–175, Fig. 4A; *see* Ans. 10, 12 (citing Goldentouch ¶¶ 60, 124–175, Fig. 4A). A query for a document corresponds to a signal representing an indication to send the document. Thus, Goldentouch teaches or suggests content removal “responsive to receiving a signal representing an indication to send the content,” as recited in claims 14 and 29.

SUMMARY

For the reasons discussed above, Appellants’ arguments have not persuaded us that the Examiner erred in rejecting independent claims 1, 9, 14, 24, and 29 for obviousness based on *Bandera* and *Goldentouch*. Hence, we sustain the § 103(a) rejection of these independent claims.

Claims 2–7, 10–13, 15–23, 25–28, and 30–32 depend directly or indirectly from an independent claim discussed above. Appellants do not argue patentability separately for these dependent claims. App. Br. 22–36; Reply Br. 1–2. Because Appellants do not argue the claims separately, we sustain the § 103(a) rejections of these dependent claims for the same reasons as the independent claims. *See* 37 C.F.R. § 41.37(c)(1)(iv).

DECISION

We affirm the rejection of claims 1–7 and 9–32 under 35 U.S.C. § 101.

We affirm the rejections of claims 1–7 and 9–32 under 35 U.S.C. § 103(a).

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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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED