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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT A. LUFF

Appeal 2016-008739
Application 12/263,079
Technology Center 3600

Before ELENI MANTIS MERCADER, JOHNNY A. KUMAR, and
CARL L. SILVERMAN, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a rejection of claims 1–12, 23–34, and 37–49, which constitute all the claims pending in this application. Claims 13–22, 35, and 36 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

CLAIMED SUBJECT MATTER

The claimed invention is directed to performing consumer surveys while the person is exposed to an advertisement regarding a product.

Abstract.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A method to automatically conduct surveys, comprising:
counting, using a processor, a first number of exposures a person has to at least one of a first advertisement, a first product or a first location based on activity data collected by a portable device;
comparing, with the processor, the first number of exposures to a first threshold value;
when the first number of exposures exceeds the first threshold value, automatically offering a survey question related to the first advertisement, the first product or the first location to the person via the portable device substantially while the person is exposed to at least one of the first advertisement, the first product or the first location, wherein the first threshold value is at least one; and
storing a response received from the person.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Granik et al. (“Granik”)Willner et al. (“Willner”)	US 2002/0010757 A1	Jan. 24, 2002
Westberg	US 2002/0196275 A1	Dec. 26, 2002
DeWind et al. (“DeWind”)	US 2005/0102696 A1	May 12, 2005
Levkovitz et al. (“Levkovitz”)	US 2006/0164230 A1	July 27, 2006
Albertson et al. (“Albertson”)	US 2007/0088801 A1	Apr. 19, 2007
	US 2008/0172261 A1	July 17, 2008

REJECTIONS

Claims 1–12, 23–34, and 37–49 stand rejected under 35 U.S.C. § 101 as being directed to an abstract idea.

Claims 37–48 were rejected under 35 U.S.C. § 101 as allegedly covering transitory propagating signals per se.

Claims 1–4, 6, 8–12, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Willner in view of Granik and further in view of Albertson.

Claims 5 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Willner in view of Granik and further in view of Albertson and further in view of Olavarrieta.

Claims 23, 26, and 28–32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Westberg in view of Willner in view of Granik and further in view of Albertson.

Claims 27 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Westberg in view of Willner and Albertson and further in view of Olavarrieta.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Westberg in view of Granik and further in view of Willner and Albertson.

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Westberg in view of Granik and further in view of Levkovitz.

Claims 33, 34, and 47–49 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Albertson in view of De Wind.

Claims 37, 40, 42, and 44–46 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Albertson in view of Willner.

Claim 39 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Willner, Granik, and Albertson in view of Levkovitz.

Claim 41 and 43 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Albertson and Willner in view of Olavarrieta.

ANALYSIS

We adopt the Examiner’s findings in the Answer and Final Rejection. We add the following for emphasis. We note that if Appellant failed to “present arguments on a particular issue — or, more broadly, on a particular rejection — the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection.” *See Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential); *Hyatt v. Dudas*, 551 F.3d 1307, 1313–14 (Fed. Cir. 2008) (The Board may treat arguments Appellant failed to make for a given ground of rejection as waived).

Claims 1–12, 23–34, and 37–49 rejected under 35 U.S.C § 101

Appellant argues that claim 1 as a whole presents no danger of tying up the alleged abstract ideas of “conducting surveys” or “organizing a human activity” (App. Br. 25). Appellant argues in particular that the Supreme Court was clear that when no preemption concern is present, the claim remains patentable for the monopoly granted under our patent laws (App. Br. 26). According to Appellant, claim 1 as a whole enables the collection of more relevant and meaningful feedback from survey respondents in a safe and efficacious manner by dynamically asking relevant

time and activity dependent questions in response to environmental conditions to capture the respondents' transparent real-time reactions to their experiences. App. Br. 29.

Appellant argues that a human surveyor cannot practically track exposures and automatically present a survey question only when a number of exposures exceeds a threshold value as recited in claim 1 (App. Br. 30). Therefore, Appellant asserts that claim 1 is not merely automating a previously known process or doing something that could reasonably be done in the human mind, but rather, is directed to an invention inherently embodied in computer technology. App. Br. 30 citing *DDR Holdings v. Hotels.com L. P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) (holding claims patent eligible because "the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks").

We are not persuaded by Appellant's argument. According to *Alice* step one, "[w]e must first determine whether the claims at issue are directed to a patent-ineligible concept," such as an abstract idea. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014). We agree with the Examiner that the steps of comparing the number of exposures to a threshold value and offering a survey question when the number of exposures exceeds the threshold value is similar to the abstract idea of comparing new (i.e., number of exposures) and stored (i.e., threshold value) information and using rules to identify options (Ans. 5–6). These steps are considered abstract idea because they can be performed mentally or by human using pen and paper because it is the organization and comparison of data and is similar to other concepts that have been identified as abstract by the courts,

such as using categories to organize, store and transmit information or comparing new and stored information using rules to identify options. *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*”); *Cyberfone Systems, LLC v. CNN Interactive Group, Inc.*, 558 F. App’x 988 (Fed. Cir. 2014); *SmartGene, Inc. v. Advanced Biological Laboratories, SA*, 555 F. App’x 950 (Fed. Cir. 2014)).

“In a similar vein, we have treated *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.” *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d at 1350, 1354 (Fed. Cir. 2016)(emphasis added); *see also In re TLI Comm’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016). That the claim is implemented by a generic computer is not sufficient to show the claimed concept is patent-eligible. *See FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1094 (Fed. Cir. 2016) (merely implementing an old practice in a new environment is abstract).

Thus, implementing a mathematical calculation on a computer for determining whether the number of exposures exceeds a threshold value to provide the option of taking a survey constitutes an abstract idea.

Because we conclude all claims on appeal are directed to an abstract idea, we proceed to the second part of the *Mayo/Alice* analysis. We further analyze the claims to determine if there are additional limitations that individually, or as an ordered combination, ensure the claims amount to “significantly more” than the abstract idea. *Alice*, 134 S. Ct. at 2357.

We agree with the Examiner that the claims recite the additional elements including a processor, a portable device, a database and a communication interface performing generic computer functions, such as receiving, storing, manipulating and transmitting information (Ans. 6). We agree with the Examiner's findings that as described in the claims, the steps of "counting, using a processor, a first number of exposures," "comparing, with the processor, the first number of exposures to a first threshold value," "automatically offering a survey question . . . via a portable device," and "storing a response received" are merely applying an abstract idea to a technology field or automating mental tasks by implementing the abstract idea onto a computer (*see* Ans. 6). More broadly, on this record, it is our view that Appellant has not established that the claims attempt to provide a solution "necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks." *DDR*, 773 F.3d at 1257. The claims are similar to the claims of *Electric Power*, because they do not require any nonconventional computer or network components, or even a "non-conventional and non-generic arrangement of known, conventional pieces," but merely call for performance of the claimed information collection, analysis, and display functions on generic computer components and display devices. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016).

Appellant further argues that the claims do not raise any preemption concerns (*see* App. Br. 26–27). Appellant's assertion regarding pre-emption is unpersuasive, because "[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility Where a patent's claims are deemed only to disclose

patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP*, 788 F.3d at 1362–63 (“that the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract”).

Accordingly, for at least the reasons discussed above, we sustain the Examiner’s rejection under 35 U.S.C. § 101 of claim 1 and for similar reasons the rejections of claims 2–12, 23–34, and 37–49, as being directed to patent-ineligible subject matter.

Claims 37–48 were rejected under 35 U.S.C. § 101

Appellant argues, with respect to claims 37–48, that the “machine accessible storage device” covers forms of non-transitory media and transitory propagating signals per se (App. Br. 45).

We do not agree. We agree with Examiner’s finding that Appellant’s Specification does not explicitly exclude such signal or communications media from the scope of “machine accessible storage device” recited in independent claims 37, 38 and 47 (Ans. 27). Given the lack of definition in Appellant’s Specification, we agree with the Examiner’s finding giving the term “machine accessible storage device” its broadest reasonable interpretation to cover transitory propagating signals per se (Ans. 27).

Accordingly, we affirm the Examiner’s rejection of independent claims 37, 38 and 47 and their respective dependent claims. Thus, we affirm the Examiner’s rejection of claims 37–48.

Claims 2–12, 23–27, 28–32, and 38 rejected under 35 U.S.C § 103(a)

Appellant argues that the combination of Willner, Granik and Albertson do not teach the limitation of “when the first number of exposures exceeds the first threshold value, automatically offering a survey question related to the first advertisement . . . while the person is exposed to at least one of the first advertisement” as recited in claim 1 (*see* App. Br. 48–52).

Appellant argues with respect to claim 1 that even though paragraph 58 in Willner describes actively asking a user one or more questions as part of or following an advertisement to obtain feedback, seeking such feedback is in no way tied to the number of exposures to the advertisement (App. Br. 49). Appellant asserts that apart from actively asking questions, paragraph 58 in Willner further describes an alternative passive method to obtain feedback (i.e., obtaining feedback without actively asking the user questions) that involves monitoring viewing behavior that may be based on the number of times a user is exposed to an advertisement (App. Br. 49). According to Appellant Willner describes (1) actively asking questions as part of or following an advertisement and (2) monitoring a number of displays of an advertisement as two separate alternative ways to obtain feedback (App. Br. 49). Appellant argues that nothing in Willner teaches or suggests that asking of questions is to occur after a number of displays of an advertisement exceeds a threshold as recited in claim 1 (App. Br. 49).

Appellant further argues that although Willner mentions asking questions following the display of a single advertisement, nothing in Willner teaches or suggests asking questions following the display of multiple instances of the same advertisement. (App. Br. 49–50). Appellant further argues that while paragraph 45 in Granik may suggest comparing a number

of exposures to a threshold, there is nothing in Granik that teaches or suggests automatically offering a survey question when such a threshold is exceeded (App. Br. 51).

We are not persuaded by Appellant's argument. In essence, Appellant's arguments do not take into account what the collective teachings of the prior art would have suggested to one of ordinary skill in the art and is therefore ineffective to rebut the Examiner's prima facie case of obviousness. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981) ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.") (citations omitted).

We agree with the Examiner's finding that Willner teaches "obtaining feedback from a user by asking one or more questions, which may be included as part of an advertisement or follow the display of an advertisement An evaluation of viewing behavior may be based, at least in part, on the user's duration of exposure to an advertisement, or the number of times a user is exposed to an advertisement" (*see* Ans. 27–28 citing para. 58). The Examiner concludes, and we agree, that Willner teaches at least offering a survey question based on the number of times a user is exposed to an advertisement and the evaluation in Willner is necessary to compare the number of exposures of the user with a predefined value before asking the question (Ans. 28). We further agree with the Examiner that the claim does not require multiple instances of the same

advertisement as argued by Appellant (Ans. 29). Willner's teaching of a user being exposed to an advertisement a number of times (para. 58) meets the claim limitation of "at least one of a first advertisement" as recited in claim 1 (Ans. 29).

The Examiner then relies on Granik for the explicit teaching of a threshold value (Ans. 28). Granik teaches determining when a predetermined threshold has been exceeded and taking appropriate action (Ans. 28 citing paras. 45–46). Thus, we agree with the Examiner that Granik teaches at least *comparing the number of exposures to a predefined value* before taking appropriate action (i.e., asking question) (Ans. 28).

Accordingly, we agree with the Examiner that the combination of the teachings of at least Willner and Granik teaches the disputed limitation of "when the first number of exposures exceeds the first threshold value, automatically offering a survey question related to the first advertisement . . . while the person is exposed to at least one of the first advertisement," as recited in claim 1.

Thus, we sustain the Examiner's rejection of claim 1 and for at least the same reasons the rejections of claims 2–12, 23–27, 28–32, and 38.

DECISION

The Examiner's rejection of claims 1–12, 23–34, and 37–49 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). *See* 37 C.F.R.

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§ 1.136(a)(1)(iv).

AFFIRMED