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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROY SHKEDI AND RONEN SHLOMO

Appeal 2017-000325
Application 14/089,645
Technology Center 3600

Before MURRIEL E. CRAWFORD, BIBHU R. MOHANTY, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant(s) seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 50-80. We have jurisdiction over the appeal under 35 U.S.C. § 6(b). Appellants appeared for oral hearing on November 28, 2016.

We REVERSE.

Claim 50 is illustrative:

50. A computer-implemented method of dealing with online activity of a first user having a first set-top box and a first online user interface device, the method comprising:

(a) receiving at a computer system a notification, wherein the notification: (i) includes or references a first set-top box identifier, and (ii) results from and signifies a first television advertisement presented using the first set-top box that corresponds to the first set-top box identifier; and

(b) using the notification, automatically with the computer system causing a first action to be taken with respect to online activity through the first online user interface device subsequent to presentation of the first television advertisement, which first online user interface device corresponds, at a time of the first action, to a first online user interface device identifier;

(c) wherein the first online user interface device identifier and the first set top box identifier are associated without using personally identifiable information pertaining to a user of the set-top box that corresponds to the first set-top box identifier.

Appellant(s) appeal the following rejection(s):

1. Claims 50–60 and 63–80 under 35 U.S.C. § 101 as directed to non-statutory subject matter.
2. Claims 50–60 and 63–80 under 35 U.S.C. § 102(b) as anticipated by Blasko (US 2001/0049620 A1, published December 6, 2001).
3. Claims 61 and 62 under 35 U.S.C. § 103(a) as unpatentable over Blasko in view of Ertugrul (US 2008/0222283 A1, published September 11, 2008).

PRINCIPLES OF LAW

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. The Supreme Court, however, has long interpreted § 101 to include implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter.”); *Parker v. Flook*, 437 U.S. 584, 594–595 (1978) (“Respondent’s application simply provides a new and presumably better method for calculating alarm limit values.”); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.”).

The patent-ineligible end of the spectrum includes fundamental economic practices, *Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611; mathematical formulas, *Parker*, 437 U.S. at 594–95; and basic tools of scientific and technological work, *Gottschalk*, 409 U.S. at 69. On the patent-eligible side of the spectrum are physical and chemical processes, such as curing rubber, *Diamond*, 450 U.S. at 184 n.7, “tanning, dyeing, making waterproof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour, *Gottschalk*, 409 U.S. at 69.

If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an “inventive concept”—an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.*

ANALYSIS

Rejection under 35 U.S.C. § 101

The Examiner determines that the claims are directed to causing actions based on advertisement which is a fundamental economic practice.

Final Act. 20. The Examiner finds:

The additional element(s) or combination of elements in the claim(s) other than the abstract idea per se amount(s) to no more than recitation of generic computer structure that

serves to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the pertinent industry. Viewed as a whole, these additional claim element(s) do not provide meaningful limitation(s) to transform the abstract idea into a patent eligible application of the abstract idea such that the claim(s) amounts to significantly more than the abstract idea itself.

Final Act. 20-21

Appellants argue that the rejection fails because the Examiner did not acknowledge or discuss any “additional elements” or the “combination of elements” to determine whether these additional elements or the combination of elements amount to significantly more than the abstract idea.

The Appellants are correct. The Examiner has not addressed what elements of claim 50 were considered in making the finding that the additional elements amount to only generic computer structure which performs generic computer functions. In this regard, claim 50 recites using a notification which results from a television advertisement presented using a set top box which causes “a first action to be taken with respect to online activity through the first online user interface device.” This recitation requires an interaction between a set top box and an online device. The Examiner did not discuss much less analyze why this recitation in claim 50 does not amount to significantly more than the abstract idea and thus does not support this finding.

In view of the foregoing, we will not sustain this rejection as it is directed to claim 50. We will also not sustain this rejection as it is directed to the remaining claims for the same reason.

Prior art rejections

We will not sustain the rejection under 35 U.S.C. § 102(b) because we agree with the Appellants that the Examiner has not established that Blasko discloses that the device identifier and the first set top box identifier are associated *without using personally identifiable information* as required by claim 50.

The Examiner relies on paragraphs 16, 22, 50 and 77 for teaching this subject matter. Final Act. 24-25.

We find that paragraph 16 describes a system and method for transaction profiling using transaction data in a privacy protected manner. In the Internet context, purchase data is used for the transaction data and in the television context programming or advertisements watched is used for the transaction data.

We find that paragraph 22 describes an embodiment of the Blasko invention which includes a secured correlation system which receives locally generated profile vectors and generates aggregated profile vectors. The aggregated profile vectors are used to target advertisement.

We find that paragraph 50 describes that in the case of television programming, the profile vectors may indicate the type of programming the user is interested in and in the case of the Internet, the profile vectors may indicate the type and style of web pages the user prefers or the interests of the user based on the content of the web pages.

We find that paragraph 77 describes that the secure correlation server is configured to receive transactions profile vectors from one or more sources. The transaction profile vectors are based on one or more actions in a transaction profile vector based on one or more actions in a transaction,

e.g. retail purchases, on-line purchases, television viewing habits, web surfing habits etc.

We find no disclosure in these portions of Blasko of associating a set top box identifier with a device identifier without using personally identifiable information. Therefore we will not sustain the rejection of claim 50 under 35 U.S.C. § 102(b). We will also not sustain the rejection as it is directed to the remaining claims subject to this rejection for the same reason.

We will also not sustain the Examiner's rejection under 35 U.S.C. § 103(a) because the Examiner relies on Blasko for teaching the subject matter we have found above is not disclosed in Blasko.

DECISION

We reverse the Examiner's § 101 and § 103 rejections.

REVERSED