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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VICTOR K. WONG

Appeal 2017-000726
Application 12/622,367¹
Technology Center 3600

Before HUNG H. BUI, AMBER L. HAGY, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

CUTITTA, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner's decision rejecting claims 1–10 and 13–40, which are all the claims pending in the application.² We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellant identifies the Real Party in Interest as PAPERG, INC. *See* Appeal Br. 1.

² Claims 11 and 12 are cancelled. *See* Appeal Br. 14.

STATEMENT OF THE CASE

Invention

Appellant's invention relates to generating marketing materials based on business content relevant to a business of a user. Spec. 1:12–15.³ The content is filtered for quantitative and qualitative information based on predefined criteria of the business of the user. Spec. 2:16–19.

Exemplary Claim

Claims 1, 25, and 40 are independent. Claim 1 is exemplary and is reproduced below with limitations at issue emphasized.

1. A method for automatically generating an advertisement, the method comprising:

searching a computer network using a descriptor for a topic in order to determine a plurality of sources having topic content concerning the topic, using a device having a processor that is capable of executing instructions stored on a non-transitory medium for carrying out the method;

filtering the plurality of sources having the topic content to derive one or more of the plurality of sources that also has business content related to the topic and relevant to a business of a user thereby deriving business content;

filtering the business content for quantitative and qualitative information based on predefined criteria of the business of the user to generate filtered information, wherein the filtering of the business content includes filtering both positive and negative information of the business content; and

³ Our Decision refers to: Appellant's Appeal Brief filed January 27, 2016 ("Appeal Br."); Reply Brief filed October 18, 2016 ("Reply Br."); Examiner's Answer mailed August 18, 2016 ("Ans."); Final Office Action mailed May 27, 2015 ("Final Act."); and original Specification filed November 19, 2009 ("Spec.").

creating an advertisement for the business of the user based on the generated filtered information.

Appeal Br. 13.

REFERENCES AND REJECTIONS

Claims 1–10 and 13–40 stand rejected under 35 U.S.C. § 101 as directed to non-patentable subject matter. Final Act. 2–5.

Claims 1–10 and 13–40 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Hurst-Hiller (US 7,293,017 B2; published November 6, 2007) and Morrisroe (US 2005/0144073 A1; published June 30, 2005). Final Act. 5–9.

ANALYSIS

Issue 1—Rejection of Claim 1 Under § 101

Issue: Whether the Examiner properly rejects the claims under 35 U.S.C. § 101 as being directed to non-patentable subject matter?

Appellant argues the claims as a group. *See* Appeal Br. 15. We select independent claim 1 as exemplary of Appellant’s arguments for claims 2–4, 6–8, 10, 13–19, 23–34, and 38–40. 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds claim 1 is “directed to generating an advertisement which is considered to be an abstract idea inasmuch as such activity is considered both a fundamental economic practice and a method of organizing human activity.” Final Act. 3. The Examiner also finds the claim does not include additional elements sufficient 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. *See* Final Act. 43.

Appellant presents several arguments against the § 101 rejection. We do not find Appellant’s arguments persuasive. Instead, we find the Examiner has provided a comprehensive response to Appellant’s arguments supported by a preponderance of evidence. *See* Ans. 3–5. As such, we adopt the Examiner’s findings and explanations. *See* Final Act. 2–5; Ans. 2–5.

Section 101 provides that “[w]hoever 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. The provision, however, “contains an important implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). The “abstract ideas” category embodies the longstanding rule that an idea, by itself, is not patentable. *Alice*, 134 S. Ct. at 2355 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

In *Alice*, the Supreme Court sets forth an analytical “framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1296–97 (2012)). The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* If the claims are

directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether [there are] additional elements [that] “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297). In other words, the second step is to “search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294). The prohibition against patenting an abstract idea “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity’.” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010).

Turning to the first step of the *Alice* inquiry, we agree with the Examiner that Appellant’s claim 1 is directed to the abstract idea of “generating an advertisement,” which is considered a fundamental economic practice. Final Act. 3. Such activities are squarely within the realm of abstract ideas. Generating an advertisement is a fundamental business practice long prevalent in our system of commerce, like the risk hedging in *Bilski* (see *Bilski*, 561 U.S. at 593), the intermediated settlement in *Alice* (see *Alice*, 134 S. Ct. at 2356–57), verifying credit card transactions in *CyberSource* (see *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011)), collecting and analyzing information to detect and notify of misuses in *FairWarning* (see *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016)), and guaranteeing transactions (see *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1354 (Fed.

Cir. 2014)). Generating an advertisement is also a building block of a market economy. Thus, generating an advertisement, like risk hedging and intermediated settlement, is an “abstract idea” beyond the scope of § 101. *See Alice* 134 S. Ct. at 2356.

In addition, we also agree with the Examiner that Appellant’s claim 1 is also directed an abstract idea because “the claim recites filtering and organizing information for retrieving and manipulating data. This is simply the organization and comparison of data[,] which can be performed mentally and is an idea of itself.” Ans. 3. Information as such is an intangible. *Bayer AG v. Housey Pharm., Inc.*, 340 F.3d 1367, 1372 (Fed. Cir. 2003). Our reviewing court has treated collecting information as within the realm of abstract ideas. *See, e.g., OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); *CyberSource*, 654 F.3d at 1370. Furthermore, merely storing or displaying the results of abstract processes of collecting information (such as by creating an advertisement), without more, is abstract as an ancillary part of such collection and analysis. *See, e.g., Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014)); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). Similarly, our reviewing court has treated a method that can be performed by human thought alone or by pen and paper as merely an abstract idea that is not patent-eligible under § 101. *See Versata Development Group, Inc. v. SAP America, Inc.*, 793 F.3d 1306, 1335 (Fed. Cir. 2015) (citing *CyberSource*, 654 F.3d at 1373). Creating an advertisement, as recited in claim 1, can be performed by pen and paper and, thus, is merely an abstract idea. Claim 1 is clearly focused

on the combination of various abstract-idea processes. The advance Appellant purports to make in creating an advertisement is essentially a process of extracting and analyzing information of a specified content, then storing or displaying the results, and not any particular assertedly inventive technology for performing those functions. The claim is, therefore, directed to an abstract idea.

The decision in *Electric Power Group v. Alstom* is also instructive. The claims in that case related to “real-time performance monitoring of an electric power grid by collecting data from multiple data sources, analyzing the data, and displaying the results.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1351 (Fed. Cir. 2016). Specifically, the claims recited (1) receiving input data regarding the power grid, other power system data sources, and non-grid data sources; (2) “detecting and analyzing events in real-time from the plurality of data streams” based on measurements specifically related to power, including “dynamic stability metrics”; (3) “displaying the event analysis results and diagnoses of events and associated ones of the metrics . . . in visuals, tables, charts, or combinations thereof,” including “tracking data” or “historical data”; and (4) “deriving a composite indicator of reliability.” *Id.* at 1351–52. Thus, as here, where the claim is limited to “advertisement,” the claims in *Electric Power Group* were narrowly limited to one field of use. And just like the claim here uses “a descriptor for a topic,” the claims in *Electric Power Group* received inputs specifically tied to that field of use and generated reports for the data, including filtered data. Nevertheless, the Federal Circuit still held the claims there were ineligible under § 101: “Though lengthy and numerous, the claims do not go beyond requiring the collection, analysis, and display of

available information in a particular field, stating those functions in general terms, without limiting them to technical means for performing the functions that are arguably an advance over conventional computer and network technology.” *Elec. Power Grp.*, 830 F.3d at 1351. The process of claim 1 is merely the automation of the same process previously performed by a human, i.e., creating an advertisement based on a subset of available business content relevant to a business. *See McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016).

Appellant argues the Examiner does not “seek to apply the analysis to the pending claims other than at a high level generality not germane to the specifically claimed features.” Appeal Br. 4. We are unpersuaded, noting the Examiner has directly tied the specific claim language to the identified abstract idea. *See* Final Act. 3–4; Ans. 3.

We need not define the outer limits of “abstract idea,” or at this stage exclude the possibility that any particular inventive means are to be found somewhere in the claims, to conclude that these claims focus on an abstract idea—and hence require stage-two analysis under § 101.

Turning to the second step of the *Alice* inquiry, we find nothing in Appellant’s claim 1 that adds “significantly more,” sufficient to transform the abstract concept of collecting, analyzing, and generating information into a patent-eligible application. *Alice*, 134 S. Ct. at 2357. Merely extracting information for collection, analysis, and display does nothing significant to differentiate a process from ordinary mental processes, whose implicit exclusion from § 101 underpins the information-based category of abstract ideas. Claim 1 does not require a new source or type of information, or a new technique for analyzing it. Consequently, claim 1 does not require an

arguably inventive set of components or methods, such as measurement devices or techniques, that would generate new data. Moreover, the claim does not invoke any assertedly inventive programming. Merely manipulating data for storage or display by itself does not transform the otherwise-abstract processes of information collection and analysis.

Appellant argues the searching limitation in combination with each of the filtering limitations “amount to significantly more than merely ‘generating an advertisement.’” Appeal Br. 4–5.

We disagree because, although the limitations add a degree of particularity to the claim, the underlying concept embodied by the limitations merely encompasses the abstract idea itself of extracting, manipulating, and storing or displaying data labeled as an advertisement. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (“[A]ny novelty in implementation of the idea is a factor to be considered only in the second step of the *Alice* analysis.”). There is no “inventive concept” in Appellant’s use of a generic processor to perform well-understood, routine, and conventional activities commonly used in industry. *See Alice*, 134 S. Ct. at 2359.

Moreover, nothing in claim 1, understood in light of the Specification, requires anything other than off-the-shelf, conventional computer technology for extracting, analyzing, and generating the desired data. Our reviewing court has repeatedly held that such invocations of computers and networks that are not even arguably inventive are “insufficient to pass the test of an inventive concept in the application” of an abstract idea. *buySAFE, Inc.*, 765 F.3d at 1353, 1355; *see, e.g., Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015).

Also, to the extent that Appellant argues the claim is patent eligible because it satisfies the transformation prong of the machine-or transformation test set forth in *Bilski*, i.e., that “there is a transformation of a particular article to a different state” (Appeal Br. 6), we note that the alleged “transformation” in the claimed “creating an advertisement” is merely a manipulation of data, which is not sufficient to meet the transformation prong under § 101. *See Gottschalk*, 409 U.S. at 71–72 (a computer-based algorithm that merely transforms data from one form to another is not patent-eligible).

Appellant further argues:

searching a computer network by using a descriptor for a topic in order to determine a plurality of sources having topic content concerning the topic is not a conventional step with respect to the abstract idea of generating an advertisement. Nor is filtering the sources to derive business content or filtering the business content for quantitative and qualitative information to generate filtered information.

Appeal Br. 6.

We are unpersuaded because claim 1 does “not go beyond requiring the collection, analysis, and display of available information in a particular field, stating those functions in general terms, without limiting them to technical means for performing the functions that are arguably an advance over conventional computer and network technology.” *Elec. Power Grp.*, 830 F.3d at 1351. Put another way, “the practices of collecting, analyzing, and displaying data, with nothing more, are practices whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas.” *FairWarning*, 839 F.3d at 1097–98 (quotation omitted). The decision in *FairWarning* provides another helpful guidepost. The claims in

FairWarning related to “detecting improper access of a patient’s protected health information” by generating and applying a rule that compared audit log data to at least one criterion related to accesses (e.g., exceeding a certain volume) and providing a notification if the criterion had been met.

FairWarning, 839 F.3d at 1092. Thus, like the claim at issue here, the claims in *FairWarning* involved (1) a comparison of collected data, (2) a report of the comparison, and (3) a specific field of use, yet the Federal Circuit still found the claims directed to an abstract idea. *Id.* at 1094 (“Specifically, the claims here are directed to collecting and analyzing information to detect misuse and notifying a user when misuse is detected.”). For the same reasons as *Electric Power Group* and *FairWarning*, the claims at issue here also are directed to an abstract idea and nothing more and ultimately are ineligible under § 101.

Because Appellant’s representative claim 1 is directed to a patent-ineligible abstract concept and does not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of these claim under 35 U.S.C. § 101 as being directed to non-patentable subject matter in light of *Alice* and its progeny. Claims 2–4, 6–8, 10, 13–19, 23–34, and 38–40, which are not argued separately, are rejected for the same reasons.

Likewise, Appellant fails to demonstrate that dependent claim 5 is substantively different than claim 1. As Appellant notes, “claim 5 recites, in pertinent part, the marketing material comprises at least one selected from the group consisting of: a print advertisement, online advertisement, brochure, pamphlet, website, flyer, and video.” Appeal Br. 7. Appellant argues that “[e]ach element . . . is tangible and nonabstract” and thus

“significantly more than the idea of generating an advertisement in the abstract.” *Id.*

We are unpersuaded because Appellant fails to demonstrate any of the claimed marketing materials are tangible in view of the Specification. Thus, “creating an advertisement,” as claimed, is no more than merely a manipulation of data, which is insufficient to meet the transformation prong under § 101. *See Gottschalk*, 409 U.S. 63 at 71–72. Like claim 1, claim 5 is directed to an abstract idea. In addition, claim 5 does not provide meaningful additional limitations to transform the abstract idea into a patent eligible application of the abstract idea such that the claim amounts to significantly more than the abstract idea itself.

Appellant also fails to establish that “audio and visual materials” as recited in dependent claim 9 are tangible in view of the Specification. Appeal Br. 7–8. Because Appellant also fails to demonstrate the “audio and visual materials” are tangible, we find Appellant’s argument regarding claim 9 unpersuasive for reasons similar to those provided for claim 5.

Still further, Appellant does not demonstrate that dependent claims 20, 21, 22, 35, 36 and 37 are substantively different than claim 1. Appellant argues the filtering steps recited in these claims, “when considered in combination with the other claim elements, amount to significantly more than merely generating an advertisement in the abstract.” Appeal Br. 8.

Appellant’s argument is unpersuasive for lack of persuasive evidence or reasoned explanation in support of the asserted conclusion. The claimed filtering steps are mere data manipulation that add nothing sufficiently inventive to amount to significantly more than the abstract idea itself.

Issue 2—Rejection of Claim 1 Under § 103(a)

Issue: Whether the Examiner erred in finding the combination of Hurst-Hiller and Morrisroe teaches or suggests “filtering the business content for quantitative and qualitative information,” and “generating an advertisement,” as recited in claim 1.

The Examiner finds Hurst-Hiller teaches or suggests “filtering the business content for quantitative and qualitative information,” as recited in claim 1. Final Act. 5–9 (citing Hurst-Hiller 2:23–37, 10:5–20, 12:1–18, 13:4–11).

Appellant disputes the Examiner’s factual findings. Appellant argues “Hurst-Hiller clearly fails to filter any quantitative information” because “Hurst-Hiller functions simply to exclude content, namely undesirable content,” i.e., “qualitative information.” Appeal Br. 9.

We are unpersuaded. The Examiner finds, and we agree, that Hurst-Hiller teaches filtering business content for quantitative information because Hurst-Hiller “discloses reporting data . . . to see how much blocking primary content categorization filter 127 and/or secondary content filter 220 are doing (e.g., what percent of queries, what percent of search results, what percentage of presentation data) how much data is being fed . . . , (quantifying).” Ans. 6 (citing Hurst-Hiller 13:4–11). Appellant, in turn, does not present substantive arguments that specifically address the Examiner’s finding. Appellant further argues the Examiner’s interpretation of “quantitative” is too broad. Reply Br. 5. But, even assuming Appellant’s proffered interpretation of “quantitative” as a “numerical rating,” Appellant fails to address the Examiner’s finding by distinguishing the cited portions of Hurst-Hiller from a numerical rating. Ans. 6. Appellant, thus, fails to

persuasively show that Hurst-Hiller’s discussion of generating data indicating the percentage of queries and search results that are blocked (Hurst-Hiller 13:4–11) does not teach or suggest filtering content for quantitative information, as claimed. Appellant’s naked assertion that “Hurst-Hiller clearly fails to filter any quantitative information” is insufficient to demonstrate Examiner error. Appeal Br. 9.

Appellant argues Hurst-Hiller does not teach generating an advertisement, as claimed, because “Hurst-Hiller is not concerned with, and does not even mention, generating an advertisement.” Appeal Br. 11.

The Examiner, however, relies on Morrisroe, rather than Hurst-Hiller, to teach “generating an advertisement,” as claimed. *See* Final Act. 8. Appellant’s argument is not responsive to the Examiner’s findings and, thus, fails to take into account what the collective teachings of the prior art would have suggested to one of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Appellant argues “Hurst-Hiller teaches away from the claimed invention in that undesired content in Hurst-Hiller is excluded from being displayed to users.” Appeal Br. 11.

We understand Appellant to argue that Hurst-Hiller teaches away from the claimed invention because claim 1 requires that some negative content be included when creating the advertisement and, in contrast, Hurst-Hiller teaches filtering out all negative content. We are unpersuaded. Hurst-Hiller teaches filtering out undesired content, which includes content “relating to sex education, mature content, pornography, gambling, hate speech, alcohol, drugs, tobacco, bomb-making, weapons, etc.” Hurst-Hiller 1:40–43. The Examiner finds, however, and we agree, that Hurst-Hiller may

include some potentially negative content, such as sex education information, that may be undesired to some people. *See* Appeal Br. 7 (citing Hurst-Hiller 10:9–24.) Accordingly, Hurst-Hiller does NOT filter out *all* negative information. Therefore, Hurst-Hiller is not incompatible with “filtering both positive and negative information of the business content,” as recited in claim 1. For this reason, we determine Appellant does not proffer sufficient evidence or argument that Hurst-Hiller teaches away from the cited combination by criticizing, discrediting, or otherwise discouraging the claimed solution. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Accordingly, Appellant has not shown error in the Examiner’s factual findings or conclusion of obviousness. We, therefore, sustain the Examiner’s 35 U.S.C. § 103(a) rejection of independent claim 1. Claims 2–10 and 13–40 are not argued separately and so the rejections of these claims are sustained for the reasons given for independent claim 1. *See* Appeal Br. 9.

DECISION

We affirm the Examiner’s rejection of claims 1–10 and 13–40 under 35 U.S.C. § 101.

We affirm the Examiner’s decision rejecting claims 1–10 and 13–40 under 35 U.S.C. § 103(a).

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).

AFFIRMED