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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MURUGAPPAN PALANIAPPAN

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Appeal 2017-001895  
Application 11/870,847<sup>1</sup>  
Technology Center 2100

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Before: HUNG H. BUI, NATHAN A. ENGELS, and  
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 42–46, 49–52, 55–57, and 59–70. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Appellant identifies Adobe Systems Incorporated as the real party in interest. Appeal Br. 2.

### ILLUSTRATIVE CLAIM

Appellant's Application "generally relates to methods and systems for dynamically retrieving keyword-based advertisements." Appeal Br. 2 (citing Spec. ¶¶ 7, 73).

Claims 42, 49, and 60 are independent claims. Claim 42, reproduced below, is illustrative of the claimed subject matter:

42. A computer-implemented method, comprising:

receiving, by a first rich internet application executed in a runtime environment provided by a processor, input representing a selection of a displayed object;

determining, by the processor, a first keyword associated with the displayed object in response to receiving the selection of the displayed object;

automatically updating, by the processor, profile data for a user accessing the runtime environment, wherein the profile data is provided by a second rich internet application that is executed in the runtime environment and that is different from the first rich internet application, wherein the profile data comprises information describing user interactions with a plurality of applications including the first and second rich internet applications and is updated in response to the selection of the displayed object via the first rich internet application;

determining, by the processor, a second keyword from the updated profile data to be used in selecting an advertisement;

retrieving, by the processor, a set of advertisements the advertisement by submitting a request to an advertisement provider, the request comprising the first keyword;

based on the second keyword, selecting, by the processor, the advertisement from the retrieved set of advertisements and excluding other advertisements from the retrieved set of advertisements, and

displaying, by the processor, the selected advertisement.

## THE REJECTIONS<sup>2</sup> AND REFERENCES

1. Claims 42–46, 49–52, 55–57, and 59–70 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. App. Br. 5.

2. Claims 49–52 and 60–68 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. *Id.*

3. Claims 42–44, 46, 49, 50, 52, 55, 57, 59–62, 64, 65, 67, and 68 were rejected under 35 U.S.C. § 103(a), in view of Goyal et al. (US 2008/0028064 A1; pub. Jan. 31, 2008) (hereinafter “Goyal”), Lax et al. (US 2009/0006375 A1; pub. Jan. 1, 2009) (hereinafter “Lax”), Irvin et al. (US 2008/0256109 A1; pub. Oct. 16, 2008) (hereinafter “Irvin”), and further in view of Marshall (US 2007/0184820 A1; pub. Aug. 9, 2007). *Id.*

4. Claims 45, 51 and 63 35 were rejected under 35 U.S.C. § 103(a), in view of Goyal, Lax, Irvin, Marshall and further in view of Bromm et al. (US 2007/0088687 A1; pub. Apr. 19, 2007) (hereinafter “Bromm”). *Id.*

5. Claims 56 and 66 were rejected under U.S.C. § 103(a), in view of Goyal, Lax, Irvin, Marshall and in further view of Yogaratnam (US 6,513,158 B1; iss. Jan. 28, 2003). *Id.*

6. Claims 69 was rejected under 35 U.S.C. § 103(a), in view of Goyal, Lax, Irvin, Marshall, and in further view of Wood et al. (US 2002/0045154 A1; pub. Apr. 18, 2002) (hereinafter “Wood”). *Id.* at 6.

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<sup>2</sup> In the event of further prosecution, the Examiner may wish to consider whether Appellant’s claims are directed to patent-ineligible subject matter under 35 U.S.C. § 101. *See Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014).

7. Claim 70 was rejected under 35 U.S.C. § 103(a), in view of Goyal, Lax, Irvin, Marshall, and in further view of Zustak et al. (US 2002/0087402 A1; pub. July 4, 2002) (hereinafter “Zustak”). *Id.* at 6.

## ANALYSIS

Appellant’s Application was previously the subject of Appeal No. 2012-003263. In that Appeal, the Board affirmed previous rejections of Appellant’s claims in a Decision on Appeal dated October 1, 2014 (hereinafter “the 2014 Decision”). After the 2014 Decision, Appellant filed claim amendments in a response to a March 27, 2015, Non-final Office Action, and the Examiner entered those amendments. Appeal Br. 2. Appellant filed additional claim amendments after the Examiner’s December 3, 2015 Final Office Action, but the Examiner did not enter those amendments. *Id.* This Decision addresses the Examiner’s rejections from the December 3, 2015 Final Office Action. *See id.* at 5–6.

### *1. The written description rejection*

Each of independent claims 42, 49, and 60 includes limitations directed to selecting an advertisement from a set of advertisements and excluding other advertisements from the set of advertisements. Appellant contends the Examiner erred in finding that Appellant’s Specification lacks support for *excluding* advertisements, as required by Appellant’s claims. Final Act. 3; *accord* Ans. 6–7.

The test for sufficiency of an application’s written description is whether the application’s disclosure reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351

(Fed. Cir. 2010) (*en banc*). The test requires an objective inquiry into the four corners of the application’s specification from the perspective of a person of ordinary skill in the art (*id.*), and a description that merely renders the invention obvious does not satisfy the requirement (*id.* at 1352).

Inherent disclosures can provide written description support, but to establish inherency, the missing descriptive matter must be necessarily present in the disclosure and recognized as such by a person of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

Appellant does not identify any explicit support for excluding advertisements based on the second keyword. Instead, citing the Specification’s disclosures of “selecting” advertisements, Appellant contends the Specification implicitly or inherently discloses “excluding” advertisements. Appeal Br. 14–15 (citing Spec. ¶¶ 7–8, 23, 40, 55, 62–63, 76, 78); *accord* Reply Br. 2 (arguing the cited portions of the Specification “describe a ‘selection’ of a subset of advertisements, which necessarily implies that any *non-selected* advertisements are *excluded* from the subset”).

We disagree with Appellant. First, Appellant’s claims recite two separate requirements, (i) “selecting” an advertisement from a set of advertisements and (ii) “excluding other advertisements” from the set of advertisements, and Appellant’s argument that a person of ordinary skill would necessarily recognize the “excluding” limitations from disclosures of the “selecting” limitations would effectively render the “excluding” requirement superfluous. *See Power Mosfet Techs., LLC v. Siemens AG*, 378 F.3d 1396, 1410 (Fed. Cir. 2004) (explaining that claim interpretations that render some portion of the claim language superfluous are disfavored).

Further illustrating that the “excluding” limitations recite functions distinct from and in addition to the “selecting” limitations, dependent claim 70 defines the “excluding” limitation of claim 42 by reciting criteria for “excluding” advertisements separate and apart from the claimed “selecting” step. Appeal Br. 33 (Claims Appendix) (claim 70 reciting “wherein excluding the other advertisements from the retrieved set of advertisements based on the second keyword comprises excluding the other advertisements *based on the other advertisements having visual content that is noncompliant with the preference regarding visual presentation of advertisements*”) (emphasis added). Moreover, Appellant’s Specification describes selecting and displaying “one or more” or a “plurality of” advertisements, meaning that selection of “the advertisement” as claimed, does not, in and of itself, *exclude* the other advertisements. Spec. ¶¶ 65 (“application 50 may display one or more advertisements dynamically”), 67 (“application 50 may select and display a plurality of advertisements from the response set”), 77 (“advertisements may be cached locally and selected from a cache”); *cf.* Reply Br. 2 (citing the Specification’s description of “‘selection’ of a subset of advertisements” to argue that selection of a subset “necessarily implies that any *non-selected* advertisements are *excluded* from the subset”) (underline added)).

Reading the claims in light of Appellant’s Specification and considering Appellant’s disclosure as a whole, we agree with the Examiner that the Specification does not directly support the “excluding” limitation, and we disagree with Appellant’s arguments that the Specification’s disclosures of the “selecting” limitations inherently or implicitly provide

written description support for the “excluding” limitations. Accordingly, we sustain the Examiner’s rejection under 35 U.S.C. § 112, first paragraph.

2. *The indefiniteness rejections*

As noted above, Appellant filed an amendment after the Examiner’s December 3, 2015 Final Office Action in an attempt to overcome the Examiner’s indefiniteness rejection, but the Examiner did not enter Appellant’s proposed amendments. Appeal Br. 10–12. Appellant argues the Examiner should have entered the proposed amendments, and Appellant requests that the Board “remand” the application to the Examiner for entry of the amendments. Appeal Br. 10–12; Reply Br. 3–4.

An examiner’s decision not to enter claim amendments is not an issue the Board can decide on appeal. An examiner’s decision not to enter claim amendments is reviewable by petition to the Director (37 C.F.R. §§ 1.113, 1.181; *Ex parte Searles, Jr.*, 422 F.2d 431, 435 (CCPA 1970)), but Appellant did not file a petition. Accordingly, because Appellant does not substantively rebut the Examiner’s indefiniteness rejection, we sustain the Examiner’s rejection under 35 U.S.C. § 112, second paragraph, *pro forma*.

3. *The obviousness rejections*

Appellant contends each of independent claims 42, 49, and 60 requires selecting an advertisement from a set of advertisements, “where the set is retrieved using *a first keyword generated by a user’s selection of a displayed object*, and where the advertisement is selected from that retrieved set using *a second keyword* that is obtained from profile data regarding *user interactions with multiple applications*.” Appeal Br. 16 (additional emphasis omitted); *accord* Appeal Br. 20–21; Reply Br. 4 (“each independent claim requires selecting advertisements using a keyword that is obtained from

*profile data regarding user interactions with multiple applications”*) (additional emphasis omitted). Following Appellant’s discussion of individual prior art references and each reference’s alleged deficiencies, Appellant argues the combined disclosures of the prior art “at best” teach:

selecting advertisements based on user behavior in a single, certain application (as disclosed by Goyal), a history of downloads by that application (as disclosed by Irvin), or browsing in that application (as disclosed by Marshall), and a user’s demographic information (as disclosed by Lax). This combination is limited to the behavior, download history (e.g., podcast history), and characteristics of a user for a single application (e.g., Irvin’s podcast application or Marshall’s browsing program).

Appeal Br. 20.

We disagree. As an initial matter, Appellant’s arguments attacking the references individually do not substantively and persuasively rebut the Examiner’s rejections, which address what a person of ordinary skill would have understood from the combined teachings of the prior art. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (explaining that nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures). Moreover, we disagree with Appellant’s characterizations of the individual references.

Regarding Lax, for example, Appellant acknowledges that Lax teaches selecting advertisements based on a user profile, but Appellant argues Lax does not teach or suggest “a profile that includes information describing user interactions with multiple applications or that a profile provided by one application is updated by interactions received via a second application, as required by the claims.” App. Br. 18. Appellant’s argument

is unpersuasive because Lax describes multiple rich Internet applications and user profiles that reflect user interactions with multiple rich Internet applications. *See* Lax ¶¶ 17 (describing webpages with various types of content, including “interactive ADOBE FLASH, JavaScript, or other forms of interactive content”), 24 (“Content provided by content provider **104** can include news, weather, entertainment, or other consumable textual, audio, video, game, or multimedia content . . . . such as, for example, FLASH-based content that presents video and audio, Asynchronous JavaScript and XML (AJAX) based web applications or web pages, and the like.”), 38–50 (describing user devices that include web browsers, one or more plug-ins, and content players in communication with a one or more advertisement and content providers), 41 (describing an ad server that receives usage information from the user device; “usage information may include measured or observed user behavior relat[ing] to ads that have been served”), 52–56 (describing a user interface that includes a content player region and one or more surrounding content regions capable of displaying various types of media), 80 (describing user profiles, including user profiles that include information from social networking sites, and using user profiles in combination with content information such as topics and keywords associated with advertisements to identify candidate advertisements), 81 (describing user profiles containing users’ demographic information), 84 (describing using “interaction data (e.g., skipping, fast-forwarding, watching multiple times, etc.)” collected from users for use in advertisement selection), 89–91 (describing a weighting system for selecting advertisements based on video content, surrounding content, and user profiles and adjusting the weights over time based on an advertisement’s

performance, among other factors). Considering Lax’s disclosures as a whole, Appellant’s focus on Lax’s “demographic data” does not substantively address what a person of ordinary skill would understand from Lax and the combined teachings of the prior art. *See In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991) (explaining that an obviousness analysis requires consideration of the prior art as a whole).

We similarly disagree with Appellant’s characterization of Irvin as limited to a single application. Reply Br. 4–6. Specifically, contrary to Appellant’s arguments that “Irvin merely discloses that different podcast applications exist” and that “nothing in Irvin teaches that the *Google podcast application* that ‘examine[s] a history of podcasts served to the IP address’ can access any information about podcasts provided by *other podcast applications* (i.e., iTunes or iPodder)” (Reply Br. 5 (citing Irvin ¶¶ 26, 27, 42, 43) (additional emphasis omitted)), Irvin teaches or at least suggests that for *any* podcast application, the Google podcast backend can examine a user’s podcast history, keywords, and metadata to select advertisements. A person of ordinary skill would understand those capabilities of the Google podcast backend to apply to any of the multiple podcast applications disclosed in Irvin (*see, e.g.*, Irvin Fig. 1A (depicting the Google podcast backend in communication with podcast aggregators), ¶ 27 (explaining that “a popular way of receiving podcasts is through a subscription based aggregator **150**, using a pod-catcher or a podcast-client like iTunes or iPodder”)), at least because Irvin explains *additional* capabilities available when listeners use one particular podcast application—the Google web plug-in (Irvin ¶ 43 (“Moreover, if a listener downloads a podcast via a Google web plug-in, additional demographic data associated with the listener can be

obtained.”)). As such, Appellant’s arguments do not substantively address what a person of ordinary skill would understand from Irvin and the combined teachings of the prior art.

We also disagree with Appellant’s arguments that the Examiner has not provided sufficient rationale for combining the teachings of Goyal, Lax, Irvin, and Marshall. *See* Appeal Br. 21–23. As cited by the Examiner, each reference discloses and suggests improvements to the selection of relevant advertisements and the prior art itself provides reasons for the combinations. *See* Ans. 31–41; Lax ¶ 3 (“Many advertisers are interested in maximizing the number of actions (e.g., impressions and/or click-throughs) for their advertisements. To achieve this, advertisers make efforts to place advertisements with content that is relevant to their advertisements.”); *accord* 2014 Decision at 7–9; *see also, e.g.*, Appeal Br. 9 (describing Goyal as teaching “monitoring user behavior that may suggest interest in specific material, and utilizing that material to select the next advertisements that are rotated), 10 (describing Marshall as teaching selection, delivery, and display of targeted advertisements on mobile phones and allowing users the option include or exclude specified product brands); Reply Br. 5 (citing Irvin ¶¶ 42–43 as disclosing an advertisement selection engine that can examine a user’s podcast history).

Appellant additionally argues that dependent claim 70 is independently patentable beyond the arguments advanced for independent claim 42. Appeal Br. 25–27; Reply Br. 6–7. In particular, Appellant argues “Zustak discloses that ‘the user is given various options regarding . . . how the advertisement is presented,’ but [Zustak] lacks any teaching that advertisements *are not shown* to a user if they ‘do not conform to a specified

visual style,’ as alleged by the Examiner.” Reply Br. 7 (citing *Zustak* ¶ 48, Ans. 43) (additional emphasis omitted). Further, Appellant argues “[n]othing in *Zustak* teaches *excluding an advertisement altogether* if ‘it is noncompliant with the preference regarding visual presentation of advertisements,’ as required by claim 70.” Reply Br. 7 (additional emphasis omitted).

These arguments are not persuasive. *Zustak* describes viewers selecting advertisements and/or advertisement types and, following the viewer’s selections, downloading advertisements for presentation to the user. *See, e.g.*, *Zustak* ¶¶ 4 (describing the need for viewer control for supplying appropriately targeted advertisements), 6 (“Upon selection of the desired advertisement and/or advertisement type, advertisements are downloaded to the user’s set-top box storage for merging with entertainment content for presentation to the user.”). Further, *Zustak* explains that “[w]hile the user still has to be presented with advertisements,” “the user is given various options regarding the type of advertisement as well as how the advertisement is presented” and the user “can exercise a preference for both advertiser and advertisement type.” *Zustak* ¶ 48; *see also* *Zustak* ¶¶ 50–51 (describing users’ selections of advertisement types). Moreover, in describing a user’s ability to select certain types of advertisement, *Zustak* describes the different types of advertisements as “substitutes” and “trade offs” for one another. *Zustak* ¶¶ 50 (“if the user selects **320**, a conventional commercial segment will interrupt the presentation periodically”; “[i]f the user selects menu icon **322**, a banner advertisement will appear either during presentation of the programming material or as a substitute for the commercial segment during the time slot normally occupied by such a commercial segment”), 51 (“The

user, for example, may desire to see a full commercial message for some advertisers and thus accept a 30-second or 1 minute (or more or less) of an interruption in the programming content periodically. If, however, the user prefers to view the content substantially uninterrupted, he may wish to trade off the interruption for a longer presentation of a banner advertisement or perhaps an even longer display of a watermark type advertisement.”).

Further still, Zustak explains that “the user has the option . . . *to not be bothered with* advertisements that are of no interest.” Zustak ¶ 51 (emphasis added). Accordingly, unlike Appellant’s arguments that an application’s selection of one advertisement from a set of advertisements necessarily “excludes” other advertisements (*see* Appeal Br. 14–15; Reply Br. 1–3), we agree with the Examiner that a person of ordinary skill would understand that Zustak’s disclosures teach, or at least reasonably suggest, excluding advertisements that have visual content that is noncompliant with the viewer’s preferences regarding visual presentation of advertisements, as claimed. *See* Zustak ¶ 51 (“a 30–second commercial interruption might be traded off for a longer presentation (e.g. perhaps 5 minutes) of banners or an even longer presentation (e.g. 20 minutes) of watermark advertisements”).

In conclusion, having considered the Examiner’s obviousness rejections in light of each of Appellant’s arguments and the evidence of record, we sustain the Examiner’s rejections of independent claims 42, 49, and 60 and dependent claim 70 for the reasons explained above as well as the reasons explained in the Examiner’s Final Office Action and Answer. Appellant does not raise additional arguments for the patentability of dependent claims 43–46, 50–52, 55–57, 59, and 61–69, and we sustain the Examiner’s rejections of those claims for the same reasons discussed above.

Appeal 2017-001895  
Application 11/870,847

DECISION

For the above reasons, we affirm the Examiner's rejections of claims 42–46, 49–52, 55–57, and 59–70.

No time period for taking any subsequent action in connection with this appeal may be extended. 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED