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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERIN COKER, ALEKSEI TOLOMPOIKO, JUSTIN HAYGOOD,
and ALFRED XAVIER

Appeal 2017-002437¹
Application 12/332,823²
Technology Center 3600

Before BIBHU R. MOHANTY, NINA L. MEDLOCK, and
JAMES A. WORTH, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner’s final rejection of claims 1, 3, 8, 9, 11, 13–15, and 18–33. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

¹ Our decision references Appellants’ Appeal Brief (“App. Br.,” filed July 27, 2016) and Reply Brief (“Reply Br.,” filed December 2, 2016), and the Examiner’s Answer (“Ans.,” mailed October 4, 2016) and Final Office Action (“Final Act.,” mailed February 29, 2016).

² Appellants identify Eyewonder, Inc. as the real party in interest. App. Br. .

CLAIMED INVENTION

Appellants' claimed invention "relates to advertising media, and in particular, relates to systems and methods for generating, reviewing, editing, and transmitting an advertising unit in a single environment" (Spec. ¶ 2).

Claims 1, 8, 15, and 21 are the independent claims on appeal.

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

1. A method for generating an advertising unit in a single environment, the method comprising:

executing, on a first client device, an ad unit component module program adapted to operate in the single environment, wherein the single environment allows a first user and a second user to process an advertising unit in real-time;

simultaneously executing an authoring tool program to provide video or animation editing functionality within the single environment, wherein:

the authoring tool program receives video or animation content generated by the first user at the first client device, and the authoring tool program utilizes scripting language;

utilizing, by the first user, a creative application program tool associated with the ad unit component module program to generate the advertising unit including the video or animation content in the single environment, wherein the advertising unit is an electronic advertisement configured to be associated with at least one webpage and viewed on a display device when the webpage is downloaded to the display device;

within the single environment, transferring one or more files associated with the advertising unit in real-time from the first user to the second user, wherein one or more files associated with the advertising unit are transmitted via a server to a second client device associated with the second user for editing at least a portion of the video or animation content in the advertising unit using the same authoring tool program within the single environment;

within the single environment, receiving by the first user edited user-generated video or animation content for the advertising unit from the second user operating the second client device, wherein the edited user-generated video or animation content is adapted to modify the original advertising unit sent from the first user to the second user;

within the single environment, publishing the advertising unit to initiate placement for viewing outside the single environment;

utilizing at least one tracking tool associated with the ad unit component module program, wherein:

the at least one tracking tool is programmed to collect indications of viewer interaction associated with the advertising unit after placement, and

the viewer interaction is outside the single environment; and providing the indications to the single environment.

REJECTIONS³

Claims 1, 3, 8, 9, 11, 13–15, and 18–33 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 1, 3, 8, 9, 11, 13–15, and 18–33 are rejected under 35 U.S.C. § 101 as directed to a judicial exception without significantly more.

Claims 1, 3, 8, 9, 11, 13–15, and 18–22, 24, 26, 28, and 30–33 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lerman et al. (US 2006/0259588 A1, pub. Nov. 16, 2006) (“Lerman”) and Haberman et al. (US 7, 870,577 B2, iss. Jan. 11, 2011) (“Haberman”).⁴

³ We treat the Examiner’s references to canceled claim 7 as inadvertent error.

⁴ In setting forth the rejection at page 6 of the Final Office Action, the Examiner does not list claims 30–33 among the rejected claims. However,

Claims 23, 25, 27, and 29 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lerman, Haberman, and Fenton et al. (US 2002/0194151 A1, pub. Dec. 19, 2002) (“Fenton”).

ANALYSIS

Written Description

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact, and is assessed on a case-by-case basis. *See, e.g., Regents of Univ. of Cal. v. Eli Lilly and Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991)). The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, an applicant was in possession of the invention as now claimed. *See, e.g., Vas-Cath, Inc.*, 935 F.2d at 1563–64.

Here, in rejecting 1, 3, 8, 9, 11, 13–15, and 18–33 under 35 U.S.C. § 112, first paragraph, the Examiner notes that each of independent claims 1, 8, 15, and 21 and dependent claims 30–33 recites that certain operations, i.e., processing an advertising unit and transferring one or more files, occur “**in rea[I] time**” (Final Act. 3). And the Examiner takes the position that Appellants’ Specification has no support for these claim limitations (*id.*).

We do not agree that written description support is lacking. Instead, we agree with Appellants that the Specification includes the requisite written

we understand, from the Examiner’s discussion at page 26 of the Final Office Action, that claims 30–33 are rejected under § 103(a) as unpatentable over Lerman and Haberman.

description support at least in paragraphs 8 and 78–84 (App. Br. 17–19). In this regard, we agree with Appellants that “real time,” as used in the claims, would be understood to mean that the timing of events occurs normally, without any delay, except as necessitated by the process being controlled or the level of computer responsiveness (App. Br. 18–19).

Patent-Eligible Subject Matter

Under 35 U.S.C. § 101, 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 an implicit exception: “[l]aws of nature, natural phenomena, and abstract ideas” are not patentable. *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

The Supreme Court, in *Alice*, reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp.*, 134 S. Ct. at 2355. The first step in that analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are not directed to a patent-ineligible concept, e.g., an abstract idea, the inquiry ends. Otherwise, the inquiry proceeds to the second step where the elements of the claims are considered “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*, 566 U.S. at 79, 78).

The Court acknowledged in *Mayo*, that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. Therefore, the Federal Circuit has instructed that claims are to be considered in their entirety to determine “whether their character as a whole is directed to excluded subject matter.” *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)).

Here, in rejecting the pending claims under 35 U.S.C. § 101, the Examiner notes that the claims recite “generating, reviewing, editing and transmitting [an] advertising unit to allow the second user to provide the same reviewing, editing, generating and transmitting functionality,” i.e., that the claims recite “a series of acts for publishing [an] advertising unit and collecting viewer data” (Final Act. 4). The Examiner determines that this is “simply, the organization and comparison of data [which] can be performed mentally, including certain methods of organizing human activities and . . . an idea itself,” and that this concept is similar to concepts that have been identified as abstract by the courts (*id.* at 4–5). The Examiner also determines that the claims do not include additional elements or a combination of elements that is sufficient to ensure that the claims amount to significantly more than the judicial exception itself (*id.* at 5).

Addressing the first step of the *Mayo/Alice* framework, Appellants argue that although the claims have elements related to advertising and video creation/editing, the claims “are **not** directed to advertising or creation/editing as an abstract idea” (App. Br. 21). Instead, according to Appellants, the claims are “***directed to*** overcoming the **technical**

drawbacks of conventional tools outlined in the background section of [Appellants’] application” (App. Br. 21–22).

The Specification sets forth various drawbacks associated with conventional tools and programs — problems associated with modern Internet advertising that Appellants maintain are “technically” handled by the pending claims (*id.* at 22). Appellants assert that “Appellants’ claims must cite the advertising elements but only so as to explain their solution to the **technical problem**” (*id.*).

The Specification discloses, in the “Background” section, that many businesses outsource the creation of their online advertising to developers or advertising agencies, who work with these business clients to create advertisements for viewing on the Internet, using various conventional tools and programs (Spec. ¶ 3). The Specification describes that this process often includes the exchange of multiple drafts of an online ad until the client approves the ad for online publication, and that conventional tools and programs may be cumbersome and time-consuming when used to combine the processes for modifying an online ad and exchanging drafts of the ad (*id.*). In this regard, the Specification discloses a number of drawbacks associated with the use of conventional tools and programs, i.e., the conventional tools and programs (1) may not accommodate differences in computer equipment, making it difficult to implement revisions in online ads; (2) may require significant customization to provide suitable functionality to track the online advertising units once they have been transferred and are available to an Internet user; and (3) may require users to separate the process of revising an online ad from the process of exchanging various files containing the online advertising content in a network

environment, creating complexity in both the processes and the environments which slows those processes and often relates to higher levels of failure (*id.*).

The claimed invention is ostensibly intended to address these shortcomings by providing a system and method for generating, reviewing, editing, and transmitting an advertising unit *in a single environment* (*id.* ¶ 8). The Specification, thus, describes that the system permits both the developer and the client to add, modify, edit, and transfer the advertising unit of interest in *the single environment*, such that the process for developing the resulting advertising unit can be streamlined to permit relatively efficient transfer of the advertising unit (*id.*)

Putting aside whether the Examiner erred in determining that the claims are directed to an abstract idea, we are persuaded that even if the claims are directed to an abstract idea, the Examiner has not adequately explained why the claims fail to recite limitations that are “significantly more” than the abstract idea itself. For example, the Examiner does not explain why, in view the express claim language read in light of the above-referenced portions of the Specification, the claimed invention would not be considered a technical improvement in the way advertising content is created. Indeed, the Examiner appears to all but ignore the “single environment” aspect of the claimed invention, which is the focus of the claims. And, to that extent, the Examiner does not appear to have considered the character of the claims as a whole.

The Examiner has not sufficiently established that the claims are directed to patent-ineligible subject matter. Therefore, we do not sustain the

Examiner's rejection of claims 1, 3, 8, 9, 11, 13–15, and 18–33 under 35 U.S.C. § 101.

Obviousness

Independent Claim 1 and Dependent Claims 3, 22, and 30

We are persuaded by Appellants' argument that the Examiner erred in rejecting independent claim 1 under 35 U.S.C. § 103(a) at least because Lerman, on which the Examiner relies, does not disclose or suggest that two users, i.e., a first user and a second user, both modify the video or animation content in the advertising unit, i.e., "generat[ing] [by the first user] the advertising unit including the video or animation content " and " transferring one or more files associated with the advertising unit in real-time from the first user to the second user, wherein [the] one or more files . . . are transmitted . . . to . . . the second user for editing at least a portion of the video or animation content in the advertising unit," as recited in claim 1 (App. Br. 31–36).

Lerman is directed to a method and system for uploading and posting digital content, including video, on the web, and discloses that the system includes a self-contained embeddable software component adapted to provide video capture and video editing functions (Lerman ¶¶ 5, 6). Lerman discloses a browser-enabled video manipulation and posting facility 100, with reference to Figure 1, including a browser-enabled processor platform 104A (*id.* ¶ 27). Platform 104A includes a publisher 112, which is configured as a browser plug-in embedded into platform 104A (*id.*), and used to post video files on websites 122 (*id.* ¶¶ 189, 196, 215). Lerman discloses that a user may transfer a video file from a video-enabled recording/storage device 101 or from a local database 130,

edit the file as desired, and then send the file to content delivery network 124, via publisher 112 and application servers 120; video files stored on content delivery network 124 may then be linked to a network location, i.e., a posting website 122 (*id.* ¶¶ 31, 189, 196, 215). Any user, with access to the network location, i.e., website 122, and desiring to interact with the linked video may then use his/her own browser-enabled processor platform 104B, equipped with network interface 110B and player 128, to select the link for downloading the video file for viewing on a video-enabled playback device 132 and/or storage to a database 130 (*id.* ¶¶ 33, 34, 191, 196, 215).

In rejecting claim 1 under § 103(a), the Examiner cites paragraphs 196 and 215 of Lerman as disclosing the argued limitations (Final Act. 9–10; *see also* Ans. 12). However, we find nothing there that discloses or suggests that two users, i.e., a first user and a second user, both modify the video content. Instead, as Appellants correctly observe, Lerman discloses one user, i.e., a single user, who creates the video; although another user may view the video, Lerman does not disclose or suggest that this second user participates in the creation process in any way (App. Br. 32)

In view of the foregoing, we do not sustain the Examiner’s rejection of independent claim 1 under 35 U.S.C. § 103(a). For the same reasons, we also do not sustain the rejection of dependent claims 3, 22, and 30. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

Independent Claims 8, 15, and 21 and Dependent Claims 9, 11, 13, 14, 18–20, and 31–33

Independent claims 8, 15, and 21 include language substantially similar to the language of claim 1, and stand rejected based on the same rationale applied with respect to claim 1 (*see* Final Act. 14, 19, 24).

Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of independent claims 8, 15, and 21, and claims 9, 11, 13, 14, 18–20, and 31–33, which depend therefrom, for the same reasons set forth above with respect to claim 1.

Dependent Claims 23, 25, 27, and 29

Each of claims 23, 25, 27, and 29 depend from one of independent claims 8, 15, and 21. The Examiner's rejection of these dependent claims does not cure the deficiency in the Examiner's rejection of independent claims 8, 15, and 21.

Therefore, we do not sustain the Examiner's rejection under 35 U.S.C. § 103(a) of dependent claims 23, 25, 27, and 29 for the same reasons set forth above with respect to the independent claims.

DECISION

The Examiner's rejection of claims 1, 3, 8, 9, 11, 13–15, and 18–33 under 35 U.S.C. § 112, first paragraph, is reversed.

The Examiner's rejection of claims 1, 3, 8, 9, 11, 13–15, and 18–33 under 35 U.S.C. § 101 is reversed.

The Examiner's rejections of claims 1, 3, 8, 9, 11, 13–15, and 18–33 under 35 U.S.C. § 103(a) are reversed.

REVERSED