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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte LISANDRO MIGUEL LEJANO, ERIK RUBEN RACHO, and
CLAUDE JONES

Appeal 2017-004327
Application 14/070,235
Technology Center 3600

Before JOHN A. JEFFERY, BETH Z. SHAW, and
JASON M. REPKO, *Administrative Patent Judges*.

SHAW, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Office Action rejecting claims 13, 14, 16–20, 23–27, and 30–37, all of which are pending on appeal. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.¹

¹ Our Decision refers to the Appeal Brief filed July 15, 2016 (“App. Br.”); Reply Brief filed January 12, 2017 (“Reply. Br.”); Examiner's Answer mailed November 18, 2016 (“Ans.”); and Final Office Action mailed December 22, 2015 (“Final Act.”).

STATEMENT OF THE CASE

Appellants' invention relates to "systems and methods for organizing an advertising campaign, which can receive selection criteria, match websites to the selection criteria, and generate a list of website names and purchasing information to be displayed on a display device." App. Br. 2.

Claim 13 is illustrative of Appellants' invention, as reproduced below:

13. A system, comprising:

one or more processors and a non-transitory storage medium comprising program logic for execution on the processors, the program logic comprising:

a list generator;

a graphical user interface (GUI) generator, the GUI generator comprising instructions executable to generate a user interface including a GUI search field configured to:

receive a user entered query for websites with available ad space for purchase; and
communicate the user entered query to the list generator; and

the list generator comprising instructions executable to:

receive the user entered query communicated by the GUI search field, the user entered query including selection criteria;
use the selection criteria as input for a search algorithm to match websites to the selection criteria, the algorithm configured to:

search a database including website information, the website information including attributes of websites with available ad space for purchase; and
identify websites that match the selection criteria by comparing the selection criteria to at least some of the attributes of at least some of the websites;

execute the search algorithm;

generate a list of website names and purchasing information corresponding to the websites identified by the executed search algorithm, to be displayed on a display device, the website names representing the matched websites, and the

purchasing information defining terms for placing advertisements on the matched websites; and
communicate the list to the GUI generator, the GUI generator further comprising instructions executable to switch from the user interface including the GUI search field to a user interface including a GUI output field configured to display the list.

Examiner's Rejection

Claims 13, 14, 16–20, 23–27, and 30–37 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to ineligible subject matter. Final Act. 2–5.

ANALYSIS

The Examiner finds claims 13, 14, 16–20, 23–27, and 30–37 are directed to ideas that have been identified as abstract by our reviewing court. Final Act. 2–5; Ans. 3–5. In particular, the Examiner finds the claims constitute an abstract idea of certain methods of organizing human activity, including advertising. Final Act. 3, Ans. 3. The Examiner also finds additional elements recited in the claims do not amount to significantly more than the abstract idea itself. Final Act. 3–5. According to the Examiner, the claims require no more than performing generic computer functions. *Id.*

Appellants present several arguments against the 35 U.S.C. § 101 rejection. App. Br. 7–21; Reply Br. 2–10. Appellants argue claims 13, 20, and 27. App. Br. 7–21. We select claim 13 as representative of the group. 37 C.F.R. § 41.50(b).

Appellants contend the claims are not directed to an abstract idea because the claimed invention provides benefits over conventional systems by describing unconventional technology to search for websites based on advertiser criteria and to display those websites to the user. App. Br. 7–8.

Appellants also contend the claims recite significantly more than an abstract idea because the claimed invention is necessarily rooted in computer technology that would only arise in the context of online advertising computer networks. *Id.* at 13–14.

We do not find Appellants’ arguments persuasive. At the outset, we note the Supreme Court has long held that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 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 ‘[a]n idea, by itself, is not patentable.’” *Id.* at 2355 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

In *Alice*, the Supreme Court set 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.*, 566 U.S. 66 (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.* (citing *Mayo*, 566 U.S. at 77–78).

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*, 566 U.S. at 79, 78). 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.* (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73). 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) (citation omitted).

Turning to the first step of the *Alice* inquiry, Appellants’ claims are directed to an abstract idea of searching and retrieving information. All the steps recited in Appellants’ claims, including, for example: (i) “receive a user entered query,” (ii) “search a database,” (iii) “identify websites,” (iv) “execute the search algorithm,” and (v) “generate a list of website names and purchasing information corresponding to the websites identified by the executed search algorithm,” are abstract processes of receiving, identifying, and generating data. Our reviewing court’s cases find an abstract idea in storing, sending, receiving, determining, updating, and displaying data. *See Elec. Power Grp. LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (“collecting, analyzing, and displaying certain results of the collection and analysis” is abstract); *In re Salwan*, 681 Fed. App’x 938, 941 (Fed. Cir. 2017) (nonprecedential) (affirming the rejection under § 101 of claims directed to “storing, communicating, transferring, and reporting patient health information,” noting that “while these concepts may be directed to practical concepts, they are fundamental economic and conventional business practices”); *Cyberfone Sys., LLC v. CNN Interactive Grp., Inc.*, 558 F. App’x 988, 992 (Fed. Cir. 2014) (nonprecedential) (“using categories to organize, store, and transmit information is well-established”). Similarly, all

the steps executed by claim 13’s “processors” are abstract processes of receiving, identifying, and generating data.

Turning to the second step of the *Alice* inquiry, we find nothing in Appellants’ claims that adds anything “significantly more” to transform them into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2357. The claimed steps are ordinary steps in search retrieval and are recited in an ordinary order.

We are not persuaded by Appellants’ argument that the claims are necessarily “rooted” in computer technology. App. Br. 7. Appellants do not persuade us why the claims or Specification provide the “unconventional technology” asserted by Appellants. App. Br. 7. Rather, the claims and Specification provide little specificity regarding technological elements. *See* Spec. ¶ 19 (“Fig. 15 illustrates a general computer system, which may represent any of the computing devices referenced herein”), ¶ 76 (“the processor 1405 may be part of a standard personal computer”), Fig. 14; Ans. 4. Thus, contrary to Appellants’ assertions, the Specification does not describe the system as made up of special-purpose or specially configured computer components, but rather, as a general-purpose computer that includes generic components. As a result, nothing recited by the claims “offers a meaningful limitation beyond generally linking ‘the use of the [method] to a particular technological environment,’ that is, implementation via computers.” *Alice* 134 S. Ct. at 2360 (quoting *Bilski*, 561 U.S. at 610–11).

Appellants argue that the

claimed invention thus solves a technical problem in the field of online advertising computer networks, and in the process provides benefits over conventional online advertising

networks, because the claimed invention *does* allow advertisers to find and choose, in a rapid and efficient manner, a relevant and available set of websites with which to present targeted online advertisements.

App. Br. 8. Yet, limiting an abstract concept of searching and finding websites to general purpose computer having generic components, such as the processor(s) recited in Appellants' claims, does not make the abstract concept patent-eligible under 35 U.S.C. § 101. As recognized by the Supreme Court, "the mere recitation of a generic computer cannot transform a patent ineligible abstract idea into a patent-eligible invention." *Alice*, 134 S. Ct. at 2358; *see id.* at 2359 (concluding claims "simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer" are not patent eligible); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715–16 (Fed. Cir. 2014) (claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet are not patent eligible); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (claims reciting "generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer" are not patent eligible); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) ("[s]imply adding a 'computer aided' limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible"); *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1056 (Fed. Cir. 2017) (generic computer elements did not represent improvement in computer technology but rather were invoked merely as tools, and did not transform the claims into

significantly more than claims to abstract idea itself); *Elec. Power Group*, 830 F.3d at 1356 (rejection affirmed for a method of performing real-time performance monitoring of an electric power grid because “the claims do not go beyond requiring the collection, analysis, and display of available information in a particular field . . . over conventional computer and network technology”).

Contrary to Appellants’ arguments (*see* App. Br. 16–18), the claims are neither rooted in computer technology as outlined in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), nor do they seek to improve any type of *computer* capabilities, such as a “self-referential table for a computer database” outlined in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016). The “one or more processors” or “processor” recited in Appellants’ claims is described in the Specification as “part of a standard personal computer or a workstation.” Spec. ¶ 76. “[M]erely ‘configur[ing]’ [a] generic computer[] in order to ‘supplant and enhance’ an otherwise abstract manual process is precisely the sort of invention that the *Alice* Court deemed ineligible for patenting.” *Credit Acceptance Corp*, 859 F.3d at 1056.

Appellants argue “the claimed invention as a whole would have no meaning outside of a computer network.” App. Br. 14. Appellants overlook that our reviewing court cautioned against Appellants’ position in its *DDR Holdings* decision.

We caution, however, that not all claims purporting to address Internet-centric challenges are eligible for patent. For example, in our recently-decided *Ultramercial* opinion, the patentee argued that its claims were “directed to a specific method of advertising and content distribution that was previously unknown and never employed on the Internet before.” 772 F.3d

at 714. But this alone could not render its claims patent-eligible. In particular, we found the claims to merely recite the abstract idea of “offering media content in exchange for viewing an advertisement,” along with “routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet.” *Id.* at 715–716.

DDR Holdings, 773 F.3d at 1258.

The claimed invention in *DDR Holdings* did not merely use the Internet, but changed how interactions on the Internet operated. In contrast, Appellants’ recited computer technology is merely used to increase the efficiency of known processes. *See* App. Br. 14 (“the question of how an advertiser can find and choose, in a rapid and efficient manner, a relevant and available set of websites with which to present targeted online advertisements”).

Appellants further argue in the Reply Brief that the claims are not directed to an abstract idea because the claims “(1) are sufficiently specific that they do not preempt all manners of achieving the particular improvement of the relevant technology; and (2) do not merely automate a prior method of achieving the particular improvement of the relevant technology,” similar to the patent-eligible claims in *McRO, Inc. v. Bandai Namco Games America, Inc.*, 837 F.3d 1299 (Fed. Cir. 2016). Reply Br. 3–4. Appellants’ arguments are unpersuasive.

In *McRO*, the Federal Circuit found that “the claims themselves set out meaningful requirements for the first set of rules: they ‘define[] a morph weight set stream as a function of phoneme sequence and times associated with said phoneme sequence.’” 837 F.3d at 1313 (citation omitted). The

Federal Circuit further explained that “[t]he specific, claimed features of these rules allow for the improvement realized by the invention.” *Id.*

The present claims are distinguishable from the patent-eligible claims in *McRO*. Notably, the present claims do not define meaningful requirements for any “specific rules” as alleged by Appellants that are remotely analogous to the meaningful requirements for the first set of rules in *McRO*. Claims App’x. Consequently, we fail to see how these alleged rules result in an improvement. Rather, the alleged improvement appears to be the automation of searching for and retrieving a list of websites. *Cf. McRO*, 837 F.3d at 1314 (“This [conventional] activity, even if automated by rules, would not be within the scope of the claims because it does not evaluate sub-sequences, generate transition parameters or apply transition parameters to create a final morph weight set. It is the incorporation of the claimed rules, not the use of the computer, that ‘improved [the] existing technological processes’ by allowing the automation of further tasks.” (citing *Alice*, 134 S. Ct. at 2358)).

Moreover, preemption is not the sole test for patent eligibility, and any questions on preemption in the instant case have been resolved by the Examiner’s *Mayo/Alice* analysis. As our reviewing court has explained: “questions on preemption are inherent in and resolved by the § 101 analysis,” and, although “preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *cf. OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362–63 (Fed. Cir. 2015) (“[T]hat 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.”).

Additionally, Appellants argue that claim 20 specifically “effects a transformation of a particular article to a different state or thing,” such that “the method results in a transformation of the browser from one that is not displaying ‘the output data’ to one that *is* displaying ‘the output data.’” App. Br. 20.

To the extent Appellants rely on the machine-or-transformation test set forth in *Bilski v. Kappos*, 561 U.S. 593 (2010), we are not persuaded that claim 20 satisfies the test. First, we note that the Supreme Court has made clear that a patent claim’s failure to satisfy the machine-or-transformation test is not dispositive of the § 101 inquiry. *See Bilski*, 130 S. Ct at 3227. However, the machine-or-transformation test is “a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under § 101.” *Id.*

Claim 20 recites method steps that merely identify websites that match selection criteria and communicates output data, including a list of website names, that represents the matched websites. The matching of one type of electronic data (i.e., selection criteria) to another type of electronic data (i.e., list of website names corresponding to the selection criteria) is not a transformation or reduction of an article into a different state or thing constituting patent-eligible subject matter. “The mere manipulation or reorganization of data . . . does not satisfy the transformation prong.” *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1375 (Fed. Cir. 2011). Thus, claim 20 fails to satisfy the transformation prong of the machine-or-transformation test.

Because Appellants' claims are directed to a patent-ineligible abstract concept and do not recite something "significantly more" under the second prong of the *Alice* analysis, we sustain the Examiner's rejection of these claims under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny.

CONCLUSION

On the record before us, we conclude Appellants have not demonstrated the Examiner erred in rejecting claims 13, 14, 16–20, 23–27, and 30–37 under 35 U.S.C. § 101.

DECISION

We affirm the Examiner's rejection of claims 13, 14, 16–20, 23–27, and 30–37.

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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