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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MANAH MOUNIR KHALIL

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Appeal 2017-004366  
Application 13/336,003  
Technology Center 3600

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Before ERIC S. FRAHM, JUSTIN BUSCH, and JAMES W. DEJMEK,  
*Administrative Patent Judges.*

FRAHM, *Administrative Patent Judge.*

DECISION ON APPEAL  
STATEMENT OF THE CASE

Appellant<sup>1</sup> appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–29. Claims 3, 7, 12, 14, 20, and 21 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the rejection of claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–29 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. We also affirm the obviousness rejections of (i) claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–24 over Hueter (US 2009/0248494 A1; published Oct. 1, 2009) and Beyda (US 2005/0165644 A1; published July 28, 2005); and (ii) claims 25–29 over Hueter, Beyda, and Seki (US 2002/0156731 A1;

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<sup>1</sup> According to Appellant, the real party in interest is Verizon Communications, Inc. (Appeal Br. 3).

published Oct. 24, 2002). With regard to the obviousness rejection of claims 25–29, to the extent we rely on different reasoning than applied by the Examiner, we designate our decision affirming claims 25–29 as a new ground of rejection.

*Appellant’s Disclosed and Claimed Invention*

Appellant’s application relates to web browsing on the Internet, and specifically to the “Use of Service Address Identifier [i.e., street address or SAID] for Anonymous User Interactions” (Title). As described by Appellant, cookies with *only* street address information are used to personalize website pages accessed by the user while ensuring privacy. Spec. ¶ 1, 17, 56; *see also* Abstract. Appellant describes the invention in the following manner:

In embodiments described herein, a service provider may, thus, associate a history of contacts between a consumer and the service provider based on the physical service address of the consumer, even when the consumer is establishing contacts anonymously. Over multiple contacts between the consumer and the service provider, the consumer contacts profile can accumulate the consumer’s contact history to link other known identifiers for the same consumer to the consumer’s physical service address. The consumer contacts profile can give the service provider better insight into the consumer’s preferences and may be used for possible service-related recommendations, or for presenting advertisements to the consumer.

Spec. ¶ 20.

Claims 1, 10, and 17 are independent, and each recite a method or network device for presenting a recommendation (i.e., targeting advertising or website personalization) to users through the use of cookies and anonymous user information which includes the user’s street address (and

not other information). Claims 1 and 25 are illustrative of the subject matter on appeal, and are reproduced below, with bracketed lettering and emphases added to disputed portions of the claim, as follows:

1. A method, comprising:

receiving, via one or more web pages hosted by a network device, a first anonymous contact from a consumer, wherein the first anonymous contact identifies a plurality of services or service-related products that are considered by the consumer as candidates for purchase prior to the consumer ordering a particular service or service-related product offered by a service provider;

requesting, via the one or more web pages, a first street address associated with the consumer;

receiving, by the network device from the consumer via the one or more web pages, the first street address associated with the consumer, *and no other identifying or address information associated with the consumer*, wherein the first street address comprises a residential or commercial street address at which a service is provided by the service provider;

monitoring, by the network device, the consumer's online activity with respect to the one or more web pages;

adding, by the network device, information associated with the consumer's online activity to a consumer contacts profile associated with the first street address;

storing, by the network device, the consumer contacts profile in a tracking database; obtaining, by the network device, a cookie associated with the consumer's online activity;

indexing, by the network device and subsequent to receiving the first anonymous contact, the tracking database with the first street address and the cookie to identify the consumer contacts profile;

using, by the network device, the consumer contacts profile to generate a recommendation, related to the identified plurality of services or service-related products offered by the service provider;

[A] *receiving*, by the network device via the one or more web pages and subsequent to the first anonymous contact, *one*

*or more other anonymous contacts identifying the first street address and without other identification of the consumer;*  
and

presenting, by the network device via the one or more web pages, the recommendation in response to the one or more other anonymous contacts based on the cookie.

25. The method of claim 1, further comprising:  
*generating a first time stamp* when the first street address is received from the consumer;

combining the generated first time stamp with the first street address to generate a first service address identifier (SAID);

receiving, subsequent to the first contact, a second contact from the consumer, wherein the second contact is related to the service offered by the service provider;

receiving, by the network device from the consumer, a second street address associated with the consumer, and no other identifying information associated with the consumer;

*generating a second time stamp* when the second street address is received from the consumer;

combining the generated second time stamp with the second street address to generate a second service address identifier (SAID); and

replacing the first SAID with the second SAID in a service address database.

Support for the negative limitation found in limitation [A] of claim 1 is found in paragraph 17 of the Specification:

Subsequent to initial anonymous contact 110 between service provider(s) 115 and consumer 100, consumer 100 may initiate one or more subsequent contacts 135 with service provider(s) 115 in an anonymous manner. *Consumer 100 may provide physical service address 105 to service provider 115 in conjunction with a contact 135, but may provide no other identifying information to service provider 115.*

Spec. ¶ 17 (emphasis added); *see also* Appeal Br. 5 (Summary of Claimed Subject Matter).

Appellant also describes the time stamps (*see* Fig. 1, 120; Fig. 4, 435; Fig. 8, 805; Fig. 10, 1005) recited in claims 25–29 as consisting of either “a date and a time” (Spec. ¶ 16), or “the time, day and year” (Spec. ¶¶ 43, 51). *See also* Appeal Br. 8 (Summary of the Claimed Subject Matter, claim 25). The time stamp can be combined with the street address to generate a service address identifier (SAID) (*see* claims 25, 28, 29), which can be used to build a consumer contacts profile (anonymously identifying a user/consumer and the user’s/consumer’s time of access). The consumer contacts profile can give a service provider better insight into the consumer’s preferences (Spec. ¶ 20).

## REJECTIONS

The Examiner made the following rejections:

(1) The Examiner rejected claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–29 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter (Non-Final Act. 3–9). The Examiner determined claims 1, 10, and 17 are drawn to a combination of abstract ideas, namely: organizing information by category, and storing and transmitting information; comparing new/stored information and using rules to identify options; indexing information by comparison; and making a recommendation based on a relationship between a profile and services offered (Non-Final Act. 4–5, 8–9). The Examiner also determined claims 1, 10, and 17 do not recite a

technological improvement or otherwise claim significantly more than the abstract ideas themselves (Non-Final Act. 5–9).

(2) The Examiner rejected claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–24 under 35 U.S.C. § 103(a) as being unpatentable over Hueter and Beyda. Non-Final Act. 10–42. The Examiner relies upon Hueter (¶¶ 18, 26) as suggesting anonymous contacts (*see* Non-Final Act. 17–18; Ans. 8), and Beyda (¶¶ 44, 205, 212) as teaching or suggesting anonymous contact where only street address information is collected, and privacy is protected (*see* Non-Final Act. 18–21; Ans. 8–10).

(3) The Examiner rejected claims 25–29 under 35 U.S.C. § 103(a) as being unpatentable over Hueter, Beyda, and Seki. Non-Final Act. 42–51. The Examiner relies upon Seki (¶ 113) as teaching, *inter alia*, generating a date stamp (Non-Final Act. 45–46).

#### *Principal Issues on Appeal*

Based on Appellant’s arguments in the Appeal Brief (Appeal Br. 10–24) and the Reply Brief (Reply Br. 4–13), the following principal issues are presented on appeal:

(1) Did the Examiner err in rejecting claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–29 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter, because representative claim 1, taken as a whole in light of the Specification, is directed to an abstract idea or combination of abstract ideas implemented on generic computer equipment without reciting an element or combination of elements that is significantly more than the abstract idea(s) itself (themselves)?

(2) Did the Examiner err in rejecting claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–24 under 35 U.S.C. § 103(a) over the base combination of Hueter

and Beyda because Beyda fails to teach or suggest the negative limitation contained in limitation [A], and as recited in representative claim 1?

(3) Did the Examiner err in rejecting claims 25–29 under 35 U.S.C. § 103(a) as being obvious over the base combination of Hueter and Beyda, as modified with Seki’s teaching of a date stamp?

## ANALYSIS

### *Issue (1): Patent-Ineligible Subject Matter*

In *Alice*, the Supreme Court reiterated the two-step framework set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), for determining whether the claimed subject matter is judicially-excepted from patent eligibility under § 101. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014). Assuming that a claim nominally falls within one of the statutory categories of machine, manufacture, process, or composition of matter, the first step in the analysis is to determine if the claim is directed to a law of nature, a natural phenomenon, or an abstract idea (judicial exceptions). *Alice*, 134 S. Ct. at 2355. For example, abstract ideas include, but are not limited to, fundamental economic practices, methods of organizing human activities, an idea of itself, and mathematical formulas or relationships. *Id.* at 2355–57. If the claim is directed to a judicial exception, such as an abstract idea, the second step is to determine whether additional elements in the claim “transform the nature of the claim’ into a patent-eligible application.” *Id.* at 2355 (quoting *Mayo*, 566 U.S. at 78). This second step is described as “a search for an “inventive concept”—*i.e.*, an element or combination of elements that is ‘. . . significantly more than . . . the [ineligible concept]

itself.” *Id.* at 2355 (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

“[T]he first step in the *Alice* inquiry . . . asks whether the focus of the claims is on the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an ‘abstract idea’ for which computers are invoked merely as a tool.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016). “The abstract idea exception prevents patenting a result where ‘it matters not by what process or machinery the result is accomplished.’” *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1312 (Fed. Cir. 2016) (quoting *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 113 (1854)). “We therefore look to whether the claims . . . focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO*, 837 F.3d at 1314. In other words, a claim that defines the way by which a computer-related result is achieved is distinguishable from a patent-ineligible claim that simply describes a result.

The second step in the *Alice* analysis requires a search for an “‘inventive concept’” that “must be significantly more than the abstract idea itself, and cannot simply be an instruction to implement or apply the abstract idea on a computer.” *BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (2016) (quoting *Alice*, 134 S. Ct. at 2355). There must be more than “computer functions [that] are ‘well-understood, routine, conventional activit[ies]’ previously known to the

industry.” *Alice*, 134 S. Ct. at 2359 (second alteration in original) (quoting *Mayo*, 566 U.S. at 73).

Based on Appellant’s arguments (Appeal Br. 10–18; Reply Br. 4–6) and our discretion under 37 C.F.R. § 41.37(c)(1)(iv), we select claim 1 as representative of claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–29, and decide the appeal of patent-ineligible subject matter rejection on the basis of representative claim 1. We disagree with Appellant’s arguments with respect to claims 1, 2, 4–6, 8–11, 13, 15–19, 22–29. We highlight and address specific findings and arguments regarding independent claim 1 for emphasis as follows.

#### Step One of *Alice*

Regarding step one of *Alice*, *Enfish* held that the “directed to” inquiry asks not whether “the claims *involve* a patent-ineligible concept,” but instead whether, “considered in light of the specification, . . . ‘their character as a whole is directed to excluded subject matter.’” *Enfish*, 822 F.3d at 1335 (internal citation omitted). Regarding improvements to computer-related technology, the Court in *Enfish* held as follows:

We do not read *Alice* to broadly hold that all improvements in computer-related technology are inherently abstract and, therefore, must be considered at step two. Indeed, some improvements in computer-related technology when appropriately claimed are undoubtedly not abstract, such as a chip architecture, an LED display, and the like. Nor do we think that claims directed to software, as opposed to hardware, are inherently abstract and therefore only properly analyzed at the second step of the *Alice* analysis. Software can make non-abstract improvements to computer technology just as hardware improvements can, and sometimes the improvements can be accomplished through either route. We thus see no reason to conclude that all claims directed to improvements in computer-

related technology, including those directed to software, are abstract and necessarily analyzed at the second step of *Alice*, nor do we believe that *Alice* so directs. Therefore, we find it relevant to ask whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea, even at the first step of the *Alice* analysis.

*Enfish*, 822 F.3d at 1335. Thus, we determine whether the claims “focus on a specific means or method that improves the relevant technology” or are “directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *McRO*, 837 F.3d at 1314.

We agree with the Examiner (Non-Final Act. 4–5, 8–9; Ans. 2–4) claim 1, 10, and 17 are drawn to a combination of abstract ideas, namely: organizing information by category, and storing and transmitting information; comparing new/stored information and using rules to identify options; indexing information by comparison; and making a recommendation based on a relationship between a profile and services offered (Non-Final Act. 4–5, 8–9).

Examining earlier cases can have a role in deciding whether a concept that claims are directed to is an abstract idea. *See Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (“Instead of a definition [for what an ‘abstract idea’ encompasses], then, the decisional mechanism courts now apply is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided”).

Courts have determined that similar concepts to those recited in claim 1 were directed to abstract ideas. *See Morsa v. Facebook, Inc.*, 77 F. Supp. 3d 1007, 1013 (C.D. Cal. 2014), *aff’d*, 622 F. App’x 915 (Fed. Cir. 2015) (concluding that claims directed to “targeting advertisements to certain

consumers” were no more than an abstract idea). As noted by the court in *Morsa*, “targeted advertising is [a well-known] concept, insofar as matching consumers with a given product or service ‘has been practiced as long as markets have been in operation.’” *Morsa*, 77 F. Supp. 3d at 1013 (quoting *Tuxis Techs., LLC v. Amazon.com, Inc.*, No. CV 13-1771-RGA, 2014 WL 4382446, at \*5 (D. Del. Sept. 3, 2014)). In other words, “[t]he concept of gathering information about one’s intended market and attempting to customize the information then provided is as old as the saying, ‘know your audience.’” *Id.* at 1013 (quoting *OpenTV, Inc. v. Netflix Inc.*, 76 F. Supp. 3d 886, 893 (N.D. Cal. 2014)).

In addition, the Federal Circuit has concluded that concepts similar to the subject matter of claim 1 were directed to abstract ideas. *See Affinity Labs of Tex., LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1271 (Fed. Cir. 2016) (“tailoring of content based on information about the user--such as where the user lives or what time of day the user views the content--is an abstract idea that is as old as providing different newspaper inserts for different neighborhoods”) (citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369 (Fed. Cir. 2015)); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 712, 714-15 (Fed. Cir. 2014) (concluding claims reciting steps receiving media content, associating the content with an advertisement, providing the content for sale on the Internet while restricting public access to the content, providing the content to a consumer without charge in exchange for viewing an advertisement, and allowing access to the content after viewing or interacting with the advertisement were directed to the abstract idea of “showing an advertisement before delivering free content”).

Our reviewing court has also concluded that abstract ideas include the concept of collecting data, recognizing certain data within the collected data set, and storing the data in memory. *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343, 1347 (Fed. Cir. 2014); *see also Smart Sys. Innovations, LLC v. Chi. Transit Auth.*, 873 F.3d 1364, 1372 (Fed. Cir. 2017) (concluding “claims directed to the collection, storage, and recognition of data are directed to an abstract idea.”).

Additionally, the collection of information and analysis of information (e.g., recognizing certain data within the dataset) is also an abstract idea. *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). Similarly, “collecting, displaying, and manipulating data” is an abstract idea. *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017); *see also SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) (“merely presenting the results of abstract processes of collecting and analyzing information . . . is abstract as an ancillary part of such collection and analysis”) (quotations omitted).

Moreover, our reviewing court recently has concluded that acts of parsing, comparing, storing, and editing data are abstract ideas. *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1366 (Fed. Cir. 2018); *see also Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1146 (Fed. Cir. 2016) (holding that “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, [are] mental processes within the abstract-idea category” (citation omitted)). As in *Electric Power*, the combination of various abstract ideas relating to data collection and analysis is itself an abstract idea.

Further, merely combining several abstract ideas does not render the combination any less abstract. *RecogniCorp*, 855 F.3d at 1327 (“Adding one abstract idea . . . to another abstract idea . . . does not render the claim non-abstract.”); *see also FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1094 (Fed. Cir. 2016) (determining the pending claims were directed to a combination of abstract ideas).

In this light, the organizing information by category, and storing and transmitting information; comparing new/stored information and using rules to identify options; indexing information by comparison; and making a recommendation based on a relationship between a profile and services offered recited in the claims on appeal are a combination of abstract ideas. Thus, claim 1 is drawn to a *combination* of abstract ideas.

Contrary to Appellant’s arguments that the claims are similar to those in *Enfish* (*see* Appeal Br. 13–14), Appellant has not demonstrated that the claims “improve the way a computer stores and retrieves data in memory,” as the claims in *Enfish* did via a “*self-referential* table for a computer database.” *See Enfish*, 822 F.3d at 1336, 1339. Appellant has also not demonstrated that the claims provide an “unconventional technological solution . . . to a technological problem” that “improve[s] the performance of the system itself,” as explained in *Amdocs*, 841 F.3d at 1300, 1302.

We note the similarity of claim 1 on appeal to the concept of collecting information, analyzing it, and displaying results found ineligible in *Electric Power*. In this regard, the claims of the instant application are similar to the claims in *Electric Power*, which did “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*, 830 F.3d at 1351. Specifically, our reviewing court held that “collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas” and that “analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Id.* at 1353–54 (citations omitted).

Our conclusion that claim 1 is directed to a combination of abstract ideas is supported by analogy to the Federal Circuit’s decision in *Electric Power*, where the court concluded claims that focused on “gathering and analyzing information of a specified content, then displaying the results” were directed to an abstract idea. 830 F.3d at 1354.

Here too, Appellant’s claim 1 recites no more than a generic network device, database, and web pages to implement the claimed functions of gathering and analyzing information, and then presenting recommendations.

Having concluded representative claim 1, as well as claims 2, 4–6, 8–11, 13, 15–19, 22–29 grouped therewith, are directed to an abstract idea or combination of abstract ideas that is/are patent-ineligible, we turn to step two of the *Alice* test.

#### Step Two of *Alice*

Regarding step two of *Alice*, Appellant’s contentions that the elements of claim 1, taken as a whole, amount to significantly more than the abstract ideas themselves (*see* Appeal Br. 15–18; Reply Br. 4–6), are unpersuasive. Appellant’s contentions that (i) the recited method for making

recommendations “provides a service provider better insight into the consumer’s preferences, which are used for presenting service-related recommendations to the consumer” (Appeal Br. 16 citing Spec. ¶ 20); and (ii) “the specific method of generating service-related recommendations cannot be said to have been conventional or generic” (Appeal Br. 17), are similarly unpersuasive.

Paragraphs 21 through 32 of the Specification describe the network environment, devices, and database shown in Figures 2 and 3, and support our understanding that the network device, service provider, and tracking database recited in claim 1 on appeal are nothing more than standard, generic computer components used for presenting recommendations via web pages.

Appellant has not demonstrated their claims provide a “solution . . . necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks,” as explained by the Federal Circuit in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014), or provide an “unconventional technological solution . . . to a technological problem” that “improve[s] the performance of the system itself,” as explained in *Amdocs*, 841 F.3d at 1300, 1302.

We agree with the Examiner that claim 1 does not recite a technological improvement or otherwise claim significantly more than the abstract ideas themselves (Non-Final Act. 5–9; Ans. 4–6). Considering the claimed elements individually and as an ordered combination, claim 1 does no more than simply instruct the practitioner to implement the abstract idea on a generic computer or processor. *Alice*, 134 S. Ct. at 2359; *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“Simply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without

more, is insufficient to render . . . [a] claim patent eligible”) (internal citation omitted). And, merely making the practice of an abstract idea more effective by implementing the idea on a computer does not suffice to meet the inventive concept requirement of *Alice*. See *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (“[R]elying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible”).

We are, therefore, not persuaded the Examiner erred by rejecting as patent-ineligible independent claim 1, as well as claims 2, 4–6, 8–11, 13, 15–19, and 22–29 grouped therewith.

*Issue (2): Obviousness of Negative Limitation [A] in Representative Claim 1*

We have reviewed the Examiner’s rejection of claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–24 (Non-Final Act. 10–42) in light of Appellant’s arguments in the briefs (Appeal Br. 18–21; Reply Br. 6–9) that the Examiner has erred, as well as the Examiner’s response to Appellant’s arguments (Ans. 6–10).

Based on Appellant’s arguments (Appeal Br. 18–21; Reply Br. 6–9) and our discretion under 37 C.F.R. § 41.37(c)(1)(iv), we select claim 1 as representative of claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–24, and decide the appeal of the obviousness rejection over the combination of Hueter and Beyda on the basis of representative claim 1. We disagree with Appellant’s contentions. With regard to representative independent claim 1, we adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken (Non-Final Act. 10–22), and (2) the reasons set forth by the Examiner in the Examiner’s Answer (Ans. 6–9) in response to Appellant’s Appeal Brief. We concur with the findings made by the

Examiner as to Hueter and Beyda, and we provide the following for emphasis.

“During examination, ‘claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *In re Am. Acad. of Sci. Tech. Cir.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1053–54 (Fed. Cir. 1997) (citation omitted). Negative limitations may be claimed so long as the limitation is clear and supported by the original disclosure, and the mere absence of a positive recitation of an element is not a basis for a negative limitation. *See* MPEP § 2173.05(i).

Disputed limitation [A] (*see supra* claim 1) is a negative limitation, and recites “receiving, by the network device via the one or more web pages and subsequent to the first anonymous contact, one or more other anonymous contacts identifying the first street address and *without other identification of the consumer.*” This limitation is supported in part by paragraph 17 of the Specification (*see also* Appeal Br. 5, Summary of Claimed Subject Matter). Paragraph 17 of the Specification states, in pertinent part, “[c]onsumer 100 may provide physical service address 105 to service provider 115 in conjunction with a contact 135, *but may provide no other identifying information to service provider 115*” (Spec. ¶ 17) (emphasis added). The purpose of not providing identifying information to the service provider, while building a consumer contacts profile including a physical street address and sites visited, is to “give the service provider better insight into the customer’s preferences and may be used for possible service-related recommendations, or for presenting advertisements to the

consumer” (Spec. ¶ 20), via web pages (*see* claim 1). *Inphi Corp. v. Netlist, Inc.*, 805 F.3d 1350, 1355 (Fed. Cir. 2015) (holding that advantages or disadvantages of each feature can constitute a “reason to exclude” under the standard articulated in *Santarus, Inc. v. Par Pharmaceutical, Inc.*, 694 F.3d 1344, 1351 (Fed. Cir. 2012) (“Negative claim limitations are adequately supported when the specification describes a reason to exclude the relevant limitation.” A negative limitation is accorded the broadest reasonable construction in light of the Specification and the “evidence before the Board” (*In re Morris*, 127 F.3d at 1055).

Appellant’s Specification at paragraphs 17 and 20 provide adequate support for the negative limitation in claim 1 at issue before us, and it is incumbent upon the Examiner to articulate sufficient findings and reasoning in this regard in making a conclusion of obviousness. This the Examiner has done (*see* Ans. 9–10). The Examiner finds (*see* Ans. 9–10), and we agree, that inasmuch as Appellant’s Specification describes a method that *may* provide no other information than a physical address, so does Beyda (*see* Beyda ¶¶ 44).

Therefore, we agree with the Examiner (Non-Final Act. 10–22; Ans. 6–9) that the combination of Hueter and Beyda teaches or suggests the method recited in claim 1, including negative limitation [A].

Notably, Appellant’s arguments (Appeal Br. 18–21) that Beyda fails to disclose or suggest receiving anonymous contacts identifying a street address without any other identification of a consumer do not address the Examiner’s reliance upon paragraphs 205 and 212 of Beyda (*see* Non-Final Act. 18). Paragraph 205 of Beyda discloses collecting data associated with an anonymous profile, as well as “identifying that visitor authoritatively

upon visiting any site within the network” (¶ 205; *see also* ¶ 211), and paragraph 212 of Beyda amplifies this process by adding the feature of doing so “in compliance with the publisher and network privacy policies” (¶ 212). These teachings of Beyda provide perspective to the profile information being collected from member computers 180 in databases 110 in data warehouse 132, and which may include “home and work addresses” (¶ 44), and/or “website pages visited” (¶ 46). This is especially true when taken with the fact that both Hueter (¶¶ 18, 26) and Beyda (¶¶ 205, 212) teach the need for anonymity for users on a network, while continuing to collect information about users (*see* Ans. 21 citing Hueter ¶ 57; Beyda ¶¶ 46, 47, 49).

In view of the foregoing, Appellant’s contentions (Appeal Br. 18–27; Reply Br. 6–9) that Beyda, and thus the combination of Hueter and Beyda, fails to disclose or suggest a method including the receiving step (negative limitation [A]) recited in claim 1, are unpersuasive. Accordingly, we sustain the Examiner’s obviousness rejection of claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–24 over the combination of Hueter and Beyda.

*Issue (2): Obviousness of Time Stamp of Claims 25–29*

Dependent claims 25–29 each recite generating time stamps and combining the time stamps with street addresses to generate a service address identifier (SAID). Appellant describes time stamps (*see* Fig. 1, 120; Fig. 4, 435; Fig. 8, 805; Fig. 10, 1005) as consisting of either “a date and a time” (Spec. ¶ 16), or “the time, day and year” (Spec. ¶¶ 43, 51). *See also* Appeal Br. 8 (Summary of the Claimed Subject Matter, claim 25).

The Examiner relies upon Seki’s disclosure of a “date stamp” (Seki ¶ 113) as teaching or suggesting the recited “time stamp” (*see* Non-Final

Act. 45; Ans. 11–13). We agree with Appellant that Seki’s “date stamp, i.e., YYYY-MM-DD, cannot be reasonably construed to correspond to a timestamp,” and “the recited timestamp indicates a date and a time of day (see Appellant’s specification, para. 16)” (Appeal Br. 23; *see also* Reply Br. 10). In this light, Appellant’s contentions (Appeal Br. 22–23; Reply Br. 9–12) that Seki’s paragraph 113 only teaches a date stamp having a day and year, and not a time of day, month, and year, are persuasive. We also agree with Appellant (Reply Br. 10–11) that the recited timestamps are used by a device that functionally changes the operation of the device, and thus patentable weight must be given to the recited timestamps.

However, we do not agree with Appellant’s contentions (Appeal Br. 22–23; Reply Br. 11–12) that the combination of Hueter, Beyda, and Seki does not disclose or suggest generating timestamps and combining the timestamps with street addresses to generate service address identifiers (SAIDs). We find, instead, that one of ordinary skill in the advertising art would understand that associating a time with a website search is valuable to making decisions regarding targeted advertising (i.e., presenting recommendations to users about websites or advertisements based on a customer’s contact profile), and, therefore, it would have been obvious, in view of the combination of Hueter, Beyda, and Seki (which teaches generating a date stamp), to modify the date stamp of Seki to include a time of day. *See In re Preda*, 401 F.2d 825, 826 (CCPA 1968) (“[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom” (citation omitted)).

Therefore, we determine one of ordinary skill in the art would not limit Seki's teachings to generating dates, but would also include times of day. "A reference may be read for all that it teaches, including uses beyond its primary purpose." *See In re Mouttet*, 686 F.3d 1322, 1331 (Fed. Cir. 2012); *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985) ("A reference must be considered for everything it *teaches* by way of technology and is not limited to the particular *invention* it is describing and attempting to protect."); *In re Taylor Made Golf Company, Inc.*, 589 F. App'x 967 (Fed. Cir. 2014) (the Board erred in failing to consider the prior art in the context of the background knowledge that a person of ordinary skill in the art would have had); *Randall Mfg. v. Rea*, 733 F.3d 1355, 1362 (Fed. Cir. 2013) ("[T]he [KSR] Court required an analysis that reads the prior art in context, taking account of 'demands known to the design community,' 'the background knowledge possessed by a person having ordinary skill in the art,' and 'the inferences and creative steps that a person of ordinary skill in the art would employ.'" (quoting *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007))).

Although there must be "a reason to combine prior art references" (*Kinetic Concepts, Inc. v. Smith & Nephew, Inc.*, 688 F.3d 1342, 1367 (Fed. Cir. 2012) (internal citations omitted)), and an obviousness determination cannot rest upon impermissible hindsight reasoning, our reviewing court "flexibly seeks evidence from before the time of the invention in the form of some teaching, suggestion, or even mere motivation (conceivably found within the knowledge of an ordinarily skilled artisan) to make the variation or combination" to guard against impermissible hindsight reasoning. *Rolls-Royce, PLC v. United Techs. Corp.*, 603 F.3d 1325, 1338 (Fed. Cir. 2010)

(internal citations omitted). The motivation to combine references need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006).

In the case before us, when tracking consumer behavior and website access, it would have been obvious to one of ordinary skill in the art to track exact times of day. For example, this information would be useful in predicting what type of advertising to send to individual consumers (e.g., a consumer looking for food delivery at 3 a.m. in their area may be interested in receiving recommendations for restaurants that are open at that hour or that deliver to their neighborhood). Tracking a time, in addition to the date, would improve accuracy of the information used to make recommendations to users. This is similar to punching a time clock, which records a time, day, month, and year to track employee work time—tracking the time of day, and not just the date, provides much more accurate and useful information.

This is especially true when taken with (i) the understanding of one of ordinary skill in the advertising art that associating a time with a website search is valuable to making decision regarding targeted advertising (i.e., presenting recommendations to users about websites or advertisements based on a customer's contact profile); and/or (ii) Seki's disclosure that it is desirable to use cookies to identify a user terminal 40 (¶ 133) and to then update a member profile database 125 with a customer's last date that the profile (containing personal information such as a street address as taught by Beyda) was changed (*see* ¶¶ 112, 113, 184).

The combination of Hueter, Beyda, and Seki, taken with the knowledge of the ordinarily skilled artisan, teaches or suggests the subject matter of claims 25–29. Hueter (¶¶ 104, 105), Beyda (¶¶ 205, 211), and Seki (¶ 133) all teach using cookies in the realm of Internet usage, as well as website visitor profiles (*see* Hueter Abstract, visitor profiles; Beyda ¶¶ 44, 46, audience member profile information; Beyda ¶¶ 205, 211, 212, visitor profile information; Seki ¶ 113, profile records). Further, both Hueter (¶¶ 18, 26) and Beyda (¶¶ 205, 212) teach the need for anonymity for users on a network, while continuing to collect information about users (*see* Ans. 21 citing Hueter ¶ 57; Beyda ¶¶ 46, 47, 49). Collecting information about anonymous users as in Hueter and Beyda, such as a physical service address (as in Beyda’s ¶ 44), as well as web sites visited (Beyda ¶¶ 46) and times visited (Seki ¶ 113), would have been obvious to one of ordinary skill in the art at the time of Appellant’s invention and “logically would have commended itself to an inventor’s attention in considering” the problems addressed by claims 25–29. *See In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007).

Moreover, modifying Hueter with Beyda, Seki, and/or the knowledge of the ordinarily skilled artisan would merely produce predictable results and would not be “uniquely challenging or difficult for one of ordinary skill in the art” at the time of Appellant’s invention (*see Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007))).

We are, therefore, not persuaded the Examiner erred in rejecting claims 25–29 as obvious over the teachings and suggestions of Hueter and Beyda, and as modified by Seki’s teaching of a date stamp (*see* Seki ¶ 113).

### CONCLUSIONS

(1) The Examiner did not err in rejecting claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–29 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

(2) The Examiner did not err in rejecting claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–24 under 35 U.S.C. § 103(a) over the combination of Hueter and Beyda.

(3) The subject matter of claims 25–29 would have been obvious to one of ordinary skill in the art at the time of Appellant’s claimed invention under 35 U.S.C. § 103(a) over the combination of Hueter, Beyda, and Seki.

### DECISION

(1) We affirm the Examiner’s decision to reject claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–29 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

(2) We affirm the Examiner’s decision to reject claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–29 under 35 U.S.C. § 103(a) as being obvious over the base combination of Hueter and Beyda alone (claims 1, 2, 4–6, 8–11, 13, 15–19, and 22–24), or taken with Seki (claims 25–29).

(3) To the extent that we have relied upon new findings and/or reasoning not relied on by the Examiner as teaching or suggesting the time stamp of claims 25–29, we also designate our affirmance of the obviousness rejection of claims 25–29 as a new ground of rejection under 37 C.F.R. § 41.50(b).

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, Appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

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AFFIRMED;  
37 C.F.R. § 41.50(b)