UNITED STATES PATENT AND TRADEMARK OFFICE

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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 JOHN ANDERSON, ANDREW P. WITKIN, CAMERON
DAVIES, ANJALI DANGE, and MIGUEL CAMPO-REMBADO

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Appeal 2017-004514
Application 13/294,992
Technology Center 3600

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Before JEAN R. HOMERE, DAVID J. CUTITTA II, and
PHILLIP A. BENNETT, *Administrative Patent Judges.*

HOMERE, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of
claims 1–11, 15, 16, 18, 20, 23–29, and 31–33, which constitute all claims
pending in this application.[1] App. Br. 10. Claims 12–14, 17, 19, 21, 22, and
30 have been canceled. Claims App'x. We have jurisdiction under 35
U.S.C. § 6(b).

We reverse.

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[1] Appellants identify the real party in interest as Disney Enterprises, Inc.
App. Br. 3.

Introduction

According to Appellants, the claimed subject matter relates to a method and system for data mining network activity to utilize time-sensitive responses from various data sources so as to provide targeted advertising to selected customers. Spec. ¶ 2. In particular, a message server (101) broadcasts over the Internet (104) an initial message (102) to a plurality of recipient electronic systems (103), which respond to the broadcast by sending a user message via a user message server (105), by initiating a search with a search engine (106) or by requesting content that triggers advertisement via the ad sever (107). *Id.* ¶ 20, Fig. 1. Subsequently, a data mining feedback system (108) aggregates the data collected by the response gathering systems (105, 106, 107) into a data record (111). *Id.* The data mining and feedback system (108) then separates messages from mechanical sources from those of non-mechanical sources so as to filter related messages responsive to the advertisement from those unrelated to the advertisement. *Id.* ¶¶ 24, 52. After determining the demography of respondents, the data mining and feedback system (108) assigns individual weights to the messages so as to classify them and to provide targeted advertisements to customers. *Id.* ¶¶ 32–34, 45–47.

Representative Claim

Independent claim 1 is representative, and reads as follows:

1.   In a system wherein computing devices are used by users at a plurality of nodes at least to initiate messages that flow between nodes of the plurality of nodes, a method of measuring advertising effectiveness, the method comprising:
    monitoring, by a processor, at least one aggregate activity stream following a broadcast time of a broadcast advertisement, wherein the at least one aggregate activity stream represents

one or more messages sent by an aggregation of users that form a statistical group over which advertising effectiveness is to be measured, wherein each of the one or more messages representing the at least one aggregate activity stream do not include the broadcast advertisement;

filtering, by the processor, the one or more messages representing the at least one aggregate activity stream to identify messages that appear to be responsive to the broadcast advertisement, wherein filtering the one or more messages includes determining which of the identified messages were sent before the broadcast time of the broadcast advertisement, and determining which of the identified messages are mechanically generated and which of the identified messages are not mechanically generated, wherein a mechanically generated message includes a message that was previously sent at a prior time and that is resent following the broadcast time, and wherein a non-mechanically generated message includes a message that is sent following the broadcast time and that is based on a human response from an observation of the broadcast advertisement;

assigning, by the processor, a first weight value to the identified messages that are mechanically generated and assigning a second weight value to the identified messages that are non-mechanically generated, wherein the first weight value is less than the second weight value;

classifying, by the processor, the identified messages into a plurality of groups, wherein the identified messages are classified into a group based at least in part on a word pattern or phrase associated with an author;

determining, by the processor, a demographic for each of the plurality of groups; and for each demographic:

determining, by the processor, a measure of favorability based on the identified messages in one or more groups corresponding to the demographic and the weight values assigned to the identified messages in the one or more groups.

App. Br. 29–30.

Rejection on Appeal

Claims 1–11, 15, 16, 18, 20, 23–29, and 31–33 stand rejected under 35 U.S.C. § 101 as being directed to patent ineligible subject matter. Final Act. 5–6.

ANALYSIS

Appellants argue the Examiner erred in concluding that claims 1–11, 15, 16, 18, 20, 23–29, and 31–33 are directed to the mere abstract ideas of "measuring advertising effectiveness" and "comparing and organizing data for analysis." App. Br. 12. Appellants allege that the elements of claim 1 amount to significantly more than the abstract idea as they disclose specific limitations other than what is well-understood, routine and conventional in the field. *Id.* at 25. In particular, Appellants argue the following:

> (1) "monitoring" an aggregate activity stream for messages after a broadcast advertisement, (2)"filtering" messages to determine messages that are non-mechanically generated and mechanically generated, (3) "assigning" a weight value to each messages based on the "filtering," (4) "classifying" the messages into groups based on a word pattern or a phrase associated with an author, (5) "determining" a demographic for each of the groups, and (6) "determining" a measure of favorability for each demographic of each group based on the messages in the group and the weight values assigned to those messages are <u>not</u> "well-understood, routine and conventional in the field."

Id. at 25–26.

The USPTO Memorandum titled "Changes to Examination Procedures Pertaining to Subject Matter Eligibility," April 19, 2018

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("Memorandum"),[2] pursuant to *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. Feb. 8, 2018) (hereafter "*Berkheimer*"), instructs that the question of whether certain claim limitations represent *a well-understood, routine, and conventional activity* is an issue of fact that the Examiner must find, and expressly support in writing with evidence to satisfy the substantial evidence standard under the Administrative Procedure Act (APA). Memorandum 2–3. That is, upon Appellants challenging an Examiner's finding in a step 2B *Mayo* analysis alleging that a claimed feature is *well-understood, routine, and conventional* in the relevant industry, the Examiner must establish such fact by more than mere knowledge or mere disclosure of the disputed fact in the prior art. *Id.* at 3. In other words, upon receiving Appellants' challenge, the Examiner must establish such element(s) is/are *well-understood, routine and conventional* activity by producing evidence that the element(s) is/are widely prevalent or in common use in the relevant industry. *Id.* (citing MPEP 2106.05(d)(I)). The Examiner must therefore support the rejection in writing with one or more of the following:

(1) A citation to an express statement in the Specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the element(s).

(2) A citation to one or more of court decisions discussed in MPEP 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the element(s).

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[2] *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision* (Berkheimer v. HP, Inc.) 1–5 (2018), https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF.

(3) A citation to a publication that demonstrates the well-understood, routine, conventional nature of the element(s) (e.g., a book, manual, review article or other source that describes the state of the art and discusses what is well-known and in common use in the relevant industry.)

(4) A statement that the Examiner is taking official notice of the well-understood, routine, conventional nature of the element(s).

Id. at 3–4.

In the present case, the Examiner states:

> The *July 2015 Update: Subject Matter Eligibility* identifies computer functions that are well-understood, routine and conventional functions including receiving, processing and storing data (see pg. 5). The limitations of claim 1 are reflective of these generic computer functions. For example, the step of monitoring an aggregate activity stream involves monitoring and data mining reaction data (e.g. receiving data), filtering messages is processing data, and the data is store for further analysis. Clearly these are well-understood, routine and conventional functions.

Ans. 9.

In response, Appellants argue that the Examiner mischaracterizes the claim as merely "receiving, processing, and storing data." Reply Br. 14. According to Appellants,

> claim 1 recites *(1)filtering, by the processor, the one or more messages representing the at least one aggregate activity stream to identify messages that appear to be responsive to the broadcast advertisement, wherein filtering the one or more messages includes determining which of the identified messages*

*were sent before the broadcast time of the broadcast
advertisement, and determining which of the identified
messages are mechanically generated and which of the
identified messages are not mechanically generated, wherein a
mechanically generated message includes a message that was
previously sent at a prior time and that is resent following the
broadcast time, and wherein a non-mechanically generated
message includes a message that is sent following the broadcast
time and that is based on a human response from an
observation of the broadcast advertisement.* " This step alone
requires novel programming of a computer in communication
with multiple disparate systems over a network. As explained
above, conventional systems rely on large amounts of data on
individual consumers and targeting advertisements to each of
them. This can also require inordinate amounts of effort on the
part of advertisers in dealing with individual messages to each
potential consumer. Further, conventional systems, such as a
pure point-to-point system, may rely on sending messages to a
known set of individual nodes and receiving individual
responses. A conventional system does <u>not</u> "filter" messages, as
recited in Appellant's claim 1.

Id. at 14–15.

We are persuaded by Appellants' argument. We do not agree with the

Examiner's characterization of the claimed elements. Although the claims

encompass a generic computer performing the functions of receiving,

processing, and storing data, the claims are not limited to just those

functions. As persuasively argued by Appellants, the claims recite

additional functions, particularly the specific filtering that separates

mechanically-generated messages from non-mechanically generated ones, as

well as those responsive/non responsive to a received broadcast. On the

record before us, we do not find the Examiner has provided sufficient

evidence to establish such functions performed by the computer are *well-*

understood, routine or conventional activities. *Cf. BASCOM Glob. Internet Servs. v. AT&T Mobility LLC,* 827 F.3d 1341, 1351 (Fed. Cir. 2016) (finding filtering steps in claims satisfy *Alice* step 2 because they were "claiming a technology-based solution (not an abstract-idea-based solution implemented with generic technical components in a conventional way) to filter content on the Internet that overcomes existing problems with other Internet filtering systems").

Thus, after reviewing the § 101 arguments articulated by Appellants in the Briefs, we find Appellants' arguments persuasive: (1) based upon *Berkheimer* (881 F.3d at 1369), and (2), based upon the USPTO Memorandum, which changed the examination procedures to be fully compliant with *Berkheimer.* Accordingly, we do not sustain the Examiner's rejection that claims 1–11, 15, 16, 18, 20, 23–29, and 31–33 are directed to patent ineligible subject matter.

DECISION

For the above reasons, we reverse the Examiner's rejection of claims 1–11, 15, 16, 18, 20, 23–29, and 31–33 as set forth above.

REVERSED