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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEPHEN DENIS KIRKBY

Appeal 2017-004981
Application 12/549,669
Technology Center 3600

Before MURRIEL E. CRAWFORD, BRUCE T. WIEDER, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ seeks our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1–21. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

BACKGROUND

Appellant's invention is directed to a system for advertising on the Internet for product placement. Spec. 4.

Claim 10 is illustrative:

10. A method performed by a computer system executing code stored

¹ The real party in interest is Accenture Global Services Limited. App. Br. 3.

on a computer readable storage device, the method comprising:

providing a plurality of product-related information and rules for including each of the plurality of product-related information in user-generated content, wherein the rules determine compliance based on at least one of a certain size, a location on a web site, and the product related information not providing product related information from competitors;

capturing metrics for a plurality of published user-generated content and each of the published user-generated content includes a product-related information of the plurality of product-related information, wherein the captured metrics include information related to compliance with the rules for the product-related information;

for each of the published user-generated content, determining whether the published user-generated content complies with the rules, wherein determining whether the published user-generated content complies with the rules comprises searching the published user-generated content for keywords to determine whether the published user generated content provides product related information from competitors;

comparing the plurality of published user-generated content amongst each other using at least one of the captured metrics; and

determining, by the computer system, an amount of payment for each of the published user-generated content based on the compliance with the rules and the comparison of the plurality of published user-generated content amongst each other.

Appellant appeals the following rejection:

Claims 1–21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

PRINCIPLES OF LAW

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 implicit exceptions: “[l]aws of nature, natural phenomena, and abstract ideas” are

not patentable. *E.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014).

In determining whether a claim falls within the excluded category of abstract ideas, we are guided in our analysis by the Supreme Court's two-step framework, described in *Mayo* and *Alice*. *Id.* at 2355 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–78 (2012)). In accordance with that framework, we first determine whether the claim is “directed to” a patent-ineligible abstract idea. *See Alice*, 134 S. Ct. at 2356 (“On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.*, the use of a third party to mitigate settlement risk.”); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (“Claims 1 and 4 in petitioners’ application explain the basic concept of hedging, or protecting against risk.”); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981) (“Analyzing respondents’ claims according to the above statements from our cases, we think that a physical and chemical process for molding precision synthetic rubber products falls within the § 101 categories of possibly patentable subject matter.”); *Parker v. Flook*, 437 U.S. 584, 594–595 (1978) (“Respondent’s application simply provides a new and presumably better method for calculating alarm limit values.”); *Gottschalk v. Benson*, 409 U.S. 63, 64 (1972) (“They claimed a method for converting binary-coded decimal (BCD) numerals into pure binary numerals.”).

The patent-ineligible end of the spectrum includes fundamental economic practices, *Alice*, 134 S. Ct. at 2357; *Bilski*, 561 U.S. at 611; mathematical formulas, *Parker*, 437 U.S. at 594–95; and basic tools of scientific and technological work, *Gottschalk*, 409 U.S. at 67. On the patent-eligible side of the spectrum are physical and chemical processes, such as

curing rubber, *Diamond*, 450 U.S. at 184 n.7, “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores,” and a process for manufacturing flour, *Gottschalk*, 409 U.S. at 69.

If the claim is “directed to” a patent-ineligible abstract idea, we then consider the elements of the claim—both individually and as an ordered combination—to assess whether the additional elements transform the nature of the claim into a patent-eligible application of the abstract idea. *Alice*, 134 S. Ct. at 2355. This is a search for an “inventive concept”—an element or combination of elements sufficient to ensure that the claim amounts to “significantly more” than the abstract idea itself. *Id.*

In addition, the Federal Circuit has held that if a method can be performed by human thought alone, or by a human using pen and paper, it is merely an abstract idea and is not patent-eligible under § 101. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (“[A] method that can be performed by human thought alone is merely an abstract idea and is not patent-eligible under § 101.”).

Claims to data collection, analysis, and display are directed to an abstract idea. *Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent-ineligible concept”); *see also In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016). Claims that recite an improvement to a particular computer technology have been found patent eligible. *See, e.g., McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1314–15 (Fed. Cir. 2016) (determining claims not abstract

because they “focused on a specific asserted improvement in computer animation”).

ANALYSIS

Rejection under 35 U.S.C. § 101

The Examiner determines that the claims are directed to data storage and instructions executed by a processor to manage content compliance. Final Act. 3. The Examiner also determines that the claims are similar to concepts involving an idea of itself and human activity relating to commercial practices and that the claims involve comparing new and stored information and using rules to identify options and concepts involving organizing information. Final Act. 4.

The Examiner finds that the other recitations in the claims in addition to the abstract idea amount to generally linking the abstract idea to a particular technological environment and do not provide meaningful limitations to transform the abstract idea so as to amount to significantly more than the abstract idea itself.

We agree with the determination of the Examiner that the claims are directed to an abstract idea. Claim 10, for example, recites collecting data by providing data in the form of product-related information and rules and capturing metrics for content; analyzing data by determining compliance with the rules, comparing content with metrics and determining amount of payment for content. As such, claim 10 is directed to data collection and analysis which is an abstract idea.

We also agree with the Examiner that the elements recited in claim 10 in addition to the abstract idea i.e., the “computer system executing code stored on a computer readable storage device” is not significantly more than the abstract idea.

We are not persuaded of error on the part of the Examiner by Appellant’s argument that the Examiner improperly generalized the abstract idea as simply comparing new and stored information and using rules to identify options. App. Br. 11. The Appellant directs our attention to the recitation of the specific data that is analyzed and argues that the Examiner has failed to grasp the gist of the claimed subject matter. However, while claim 10 recites the specific data that is analyzed, it is nevertheless directed to the analysis of data. As we have explained above, claims directed to the collection and analysis of data have been held to be directed to an abstract idea.

We do not agree with the Appellant’s argument found on page 14 of the Appeal Brief that the claims are necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks. In Appellant’s view, the claims are directed to the technical compliance checking process. Specifically, Appellant argues that the claimed subject matter is associated with analyzing data on the Internet in order to overcome a problem specifically arising in the realm of posting user generated content. App. Br. 15. Appellant argues that the claims are similar to the claims in *DDR Holdings, LLC v. Hotels.com L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014).

We are not persuaded by Appellant’s argument that the claim is analogous to that in *DDR Holdings*, 773 F.3d at 1257, where the Court noted

that a claim may amount to more than any abstract idea recited in the claims when it addresses a business challenge, such as “retaining website visitors,” where that challenge is particular to a specific technological environment, such as the Internet. Appellant contends that the claims address a business challenge of placing ads on user generated content on the internet. App. Br. 17.

In *DDR*, the court stated that “the [] patent’s claims address the problem of retaining website visitors that, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be instantly transported away from a host’s website after ‘clicking’ on an advertisement and activating a hyperlink.” *DDR Holdings*, 773 F.3d at 1257. This was done in the claim by serving a composite page with content based on the link that was activated to serve the page.

In contrast, claim 10 is directed to a process for placement of content, e.g., ads. Ad placement is not a problem particular to the Internet.

We are also not persuaded of error on the part of the Examiner by Appellants argument that the claims do not preempt the use of the asserted abstract idea. App. Br. 18. While 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); *see also 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.”). And, “[w]here a patent’s claims are deemed only to disclose patent ineligible subject matter

under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

Appellant analogizes the claimed invention to the invention at issue in *McRO*. Reply Br. 8.

We are not persuaded that the claimed invention is analogous to the claimed invention in *McRO*. The claims in *McRO* were directed to a specific asserted improvement in computer animation, i.e., the automatic use of rules of a particular type. *McRO*, 837 F.3d at 1314. By contrast, the independent claims under appeal recite only determining the placement of content on a website and use of a computer in a conventional and well-known manner.

We are not persuaded of error on the part of the Examiner by Appellants argument that the claims are not taught or suggested by the prior art. To the extent Appellants maintain that the limitations of claim 1 necessarily amount to “significantly more” than an abstract idea because the claimed apparatus is allegedly patentable over the prior art, Appellants misapprehend the controlling precedent. Although the second step in the *Alice/Mayo* framework is termed a search for an “inventive concept,” the analysis is not an evaluation of novelty or non-obviousness, but rather, a search for “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.” *Alice*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304.

In view of the foregoing, we will sustain the Examiner’s rejection of claim 10. We will also sustain the Examiner’s rejection as it is directed to

Appeal 2017-004981
Application 12/549,669

the remaining claims because the Appellant has not argued the separate eligibility of these claims.

DECISION

We affirm the Examiner's § 101 rejection.

TIME PERIOD

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. § 1.136(a)(1) (2009).

ORDER

AFFIRMED