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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* DAN E. HOLDEN and MICHAEL J. COOK

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Appeal 2017-006174  
Application 13/775,956  
Technology Center 2400

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Before ALLEN R. MacDONALD, ROBERT E. NAPPI, and  
CARL L. SILVERMAN, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1 through 3, 5 through 7, 9, 21 through 23, 25 through 29, 45, and 46. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## INVENTION

Appellants' disclosed invention is directed to a method displaying additional or targeted content to a user. *See* Abstract of Appellants' Specification. Claim 1 is representative of the invention and reproduced below.

1. A method comprising:
  - outputting, by a computing device, content for display;
  - controlling an image capture device to capture a first image of a first field of view;
  - determining a first number of instances that a first object appears in the first image;
  - determining a second number of instances that the first object appears in a second image, wherein the second image is an image of a second field of view different from the first field of view;
  - comparing the first number of instances with the second number of instances;
  - determining additional content based on the comparing the first number of instances with the second number of instances; and
  - outputting, by the computing device, the additional content.

## REJECTION AT ISSUE<sup>1</sup>

The Examiner has rejected claims 1 through 3, 5 through 7, 9, 21 through 23, 25 through 29, 45, and 46 under 35 U.S.C. § 101 for being directed to non-statutory subject matter. Final Action 3.

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<sup>1</sup> Throughout this Decision we refer to the Appeal Brief filed August 29, 2016, Reply Brief filed February 28, 2017, Final Office Action mailed January 20, 2016, and the Examiner's Answer mailed December 29, 2016.

## PRINCIPLES OF LAW

Patent-eligible subject matter is defined in § 101 of the Patent Act, which recites:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

There are, however, three judicially created exceptions to the broad categories of patent-eligible subject matter in § 101: laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2354 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012). Although an abstract idea, itself, is patent-ineligible, an application of the abstract idea may be patent-eligible. *Alice*, 134 S. Ct. at 2355. Thus, we must consider “the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (citing *Mayo*, 132 S. Ct. at 1297–98). The claim must contain elements or a combination of elements that are “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea] itself.” *Id.* (citing *Mayo*, 132 S. Ct. at 1294).

The Supreme Court sets forth a two-part “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.

First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. [*Mayo*,] 132 S.Ct., at 1296–1297. If so, we then ask, “[w]hat else is there in the claims before us?” *Id.*, at —, 132 S.Ct., at 1297. To answer that

question, we consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. *Id.*, at —, 132 S.Ct., at 1298, 1297. We have described step two of this analysis as a 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.*, at —, 132 S.Ct., at 1294.

*Id.*

### ANALYSIS

We have reviewed Appellants’ arguments in the Briefs, the Examiner’s rejections, and the Examiner’s response to Appellants’ arguments. Appellants’ arguments have not persuaded us of error in the Examiner’s determination that the claims are patentable.

Appellants argue on pages 5 through 7 of the Brief, that claim 1 is not directed to an abstract idea. Specifically, Appellants argue the Examiner has not shown that the idea is abstract by showing “the present claims are similar to those in *Alice* or any other court decision.” App. Br. 5. Appellants further argue that the current claims are not drawn to a fundamental economic practice as the claims in *Alice*, and the lack of an art rejection demonstrates that the claims do not recite a longstanding practice.

These arguments have not persuaded us the Examiner erred in determining representative claim 1 recites an abstract idea.

The Federal Circuit has explained that, in determining whether claims are patent-eligible under Section 101, “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.” *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288,

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1294 (Fed. Cir. 2016). The Federal Circuit also noted in that decision that “examiners are to continue to determine if the claim recites (i.e., sets forth or describes) a concept that is similar to concepts previously found abstract by the courts.” *Amdocs*, 841 F.3d at 1294 n.2 (citation omitted).

Initially we note that, contrary to Appellants’ arguments, the Examiner has compared the concept claimed with a claimed concept the courts have held to recite an abstract idea. *See Answer 7* (citing *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011).) We concur with the Examiner that the claims recite an abstract idea.

In the instant case, representative claim 1 recites controlling an input device to capture an image (gathering data), determine a number of instances that an object appears in the image and another image (processing the data), comparing the number of instances, and determining and outputting content based upon the comparison. Thus, the claim is directed to the abstract concept of gathering data, analyzing the data comparing it and using it to create an output, which is similar to the claims at issue in *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (holding that claims directed to a process of gathering and analyzing information of a specific content are directed to an abstract idea). They are also similar to those at issue in *Content Extraction and Transmission LLC. v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (holding that the claims were “drawn to the abstract idea of 1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory.”). Thus, we concur with the Examiner that claim 1 is directed to the use of an abstract idea.

On pages 8 through 11 of the Brief, Appellants address the second part of the *Alice* analysis and argue the claims recites significantly more than

the abstract idea. Appellants argue that when the claims are considered as a whole, as an ordered combination, including the use of a computing device, they are more than the routine application of an abstract idea. App. Br. 8–9; Reply Br 4–5. Further, Appellants argue that the claims do not pre-empt the alleged abstract idea. App. Br. 9–10; Reply Br. 5–6.

We are not persuaded of error in the Examiner’s rejection by these arguments. We concur with the Examiner that, the additional limitations are directed to generic computer functions and the claims do not recite significantly more. Answer 9 and Final Rej. 3.

“[T]he use of generic computer elements like a microprocessor or user interface do not alone transform an otherwise abstract idea into patent-eligible subject matter.” *FairWarning IP v. Iatric Sys. Inc.*, 839 F.3d 1089, 1096 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014)). *See also Alice Corp.* We disagree with Appellants that claim 1 recites significantly more than the abstract idea, the claimed recitation of a computing device is to output content (data), count objects and comparing the counts to make a determination, which are data processing steps typically performed by a computer. Further, the recitation of an image capture device to capture an image, is using a generic component for its purpose. Thus, the limitations other than the abstract concept are merely using the computer technology as a means to perform the abstract concept.

With respect to the pre-emption concern, “[w]hat matters is whether a claim threatens to subsume the full scope of a fundamental concept, and when those concerns arise, we must look for meaningful limitations that prevent the claim as a whole from covering the concept’s every practical application.” *CLS Bank Intern. v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269,

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1281 (Fed. Cir. 2013) (Lourie, J., concurring). Here, said relied-on claim limitation simply narrows the abstract idea so that it is described at a lower level of abstraction. It does not render the abstract idea to which the claim is directed to any less an abstract idea. Pre-emption is not a separate test.

To be clear, the proper focus is not preemption per se, for some measure of preemption is intrinsic in the statutory right granted with every patent to exclude competitors, for a limited time, from practicing the claimed invention. *See* 35 U.S.C. § 154. Rather, the animating concern is that claims should not be coextensive with a natural law, natural phenomenon, or abstract idea; a patent-eligible claim must include one or more substantive limitations that, in the words of the Supreme Court, add “significantly more” to the basic principle, with the result that the claim covers significantly *less*. *See Mayo* 132 S. Ct. at 1294. Thus, broad claims do not necessarily raise § 101 preemption concerns, and seemingly narrower claims are not necessarily exempt.

*Id.* *See also Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.”). Because we find the claimed subject matter covers patent-ineligible subject matter, the pre-emption concern is necessarily addressed. “Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, [] preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics*, 788 F.3d at 1379. Thus, Appellants’ arguments have not persuaded us that representative claim 1 recites significantly more than the abstract idea and, therefore, we sustain the Examiner’s 35 U.S.C. § 101 rejection of claim 1 and claim 21 grouped with claim 1.

With respect to the dependent claims, Appellants argue the Examiner has failed to address any of the additional features of the dependent claims.



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App. Br. 4; Reply Br. 6. Further, Appellants separately address dependent claims 2, 3, 5, 6, 7, 9, 22, 23, 25 through 29, 45, and 46 by restating the claims and including the statement:

Taking these features along with the features of its base claim and any intervening claims, this claim is directed to more than the purported abstract idea of “‘determining a first number of instances’ and ‘determining a second number of instances’ that ‘an object’ appears in different fields of view, e.g. rooms, and making a comparison of the instances in order [to] output additional content,” and recites an ordered combination that does not pre-empt the purported abstract idea. Further, this dependent claim includes meaningful features beyond generally linking the use of the purported abstract idea to a particular technological environment, and therefore, at a minimum, amounts to significantly more than the purported abstract idea.

App. Br. 11–19.

The Examiner states that claims 2, 3, 5, 6, 7, 9, 22, 23, 25 through 29, 45, and 46 are rejected applying the same rationale as discussed with respect to claim 1. We concur and do not consider Appellants’ statements directed to the dependent claims as being a separate argument. To the extent the features of these claims have been pointed out, this is considered to be nothing more than a general allegation of patentability and is not considered a separate patentability argument. *See* 37 C.F.R. § 41.37(c)(1)(iv) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”).

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Further, Appellants' separate statements "this dependent claim includes meaningful features beyond generally linking the use of the purported abstract idea" is insufficient to show the Examiner erred in concluding that the limitations of claims merely modify the abstract algorithm and do not recite significantly more than the abstract algorithm. Thus, we sustain the Examiner's rejection of claims 2, 3, 5 through 7, 9, 22, 23, 25 through 29, 45, and 46

#### DECISION

We affirm the Examiner's rejection of claims 1 through 3, 5 through 7, 9, 21 through 23, 25 through 29, 45, and 46 under 35 U.S.C. § 101.

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