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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
11/948,721 11/30/2007 EWA DOMINOWSKA 321767.01/MFCP.137374 3274

45809 7590 09/18/2018
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Table with 1 column: EXAMINER

DAGNEW, SABA

Table with 2 columns: ART UNIT, PAPER NUMBER

3682

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

09/18/2018

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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* EWA DOMINOWSKA and ROBERT J. RAGNO,

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Appeal 2017-006892  
Application 11/948,721<sup>1</sup>  
Technology Center 3600

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Before MARC S. HOFF, JAMES W. DEJMEK, and  
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a Non-Final Rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' invention concerns associating structured information with online advertisements presented with primary content. Feature-value pairs corresponding with advertisements describe features of the products or services advertised. The feature-value pairs may be used during selection of advertisements for presentation with primary content. User interface

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<sup>1</sup> The real party in interest is Microsoft Technology Licensing, LLC.

elements may be generated, allowing users to sort and/or filter advertisements during presentation with primary content. The user interface elements are generated based on the associated feature-value pairs. *See* Abstract.

Claim 1 is exemplary of the claims on appeal:

1. One or more computer-storage media embodying computer-useable instructions for performing a method comprising:
  - storing an advertisement corresponding with a product or service and one or more feature-value pairs for the advertisement for use in an advertisement system that provides advertisements for presentation in conjunction with presentation of separate primary content, each feature-value pair for the advertisement being separate from the content of the advertisement and comprising a feature of the product or service and a value defining the feature of the product or service;
  - receiving a request for advertisements from a user device; and
  - providing, for delivery to the user device in response to the request, a plurality of advertisements and one or more feature-value pairs for each advertisement separate from the content of each advertisement for use in a user interface that presents at least a portion of the advertisements in conjunction with separate primary content and one or more user interface elements that allow a user to sort or filter the advertisements based on the feature-value pairs associated with the advertisements while maintaining the presentation of the separate primary content, the one or more user interface elements being generated based on the feature-value pairs associated with the advertisements.

Claims 1–20 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written-description requirement.

Claims 1–20 stand rejected under 35 U.S.C. § 101 as being drawn to patent-ineligible subject matter.

Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bharat et al. (US 8,352,499 B2, iss. Jan. 8, 2013) and Hayes, Jr. et al. (US 8,374,915 B2, iss. Feb. 12, 2013).

Throughout this decision, we make reference to the Appeal Brief (“App. Br.,” filed Aug. 26, 2016) and the Examiner’s Answer (“Ans.,” mailed Dec. 28, 2016) for their respective details.

### ISSUES

1. Does the disclosure reasonably convey to one of ordinary skill in the art that the inventors had possession of the claimed subject matter?

2. Is the claimed invention directed to a judicial exception, specifically an abstract idea, without reciting significantly more so as to transform the invention into a patent-eligible application?

3. Does the combination of Bharat and Hayes disclose or suggest providing one or more user interface elements that allow a user to sort or filter advertisements based on feature-value pairs associated with the advertisements while maintaining presentation of separate primary content, the user interface elements being generated based on the feature-value pairs associated with the advertisement?

### PRINCIPLES OF LAW

Under the written-description requirement of 35 U.S.C. § 112, the disclosure of the application relied upon must reasonably convey to one of ordinary skill in the art that, as of the filing date of the application, the inventor had possession of the later-claimed subject matter. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). “One shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its

claimed limitations, not that which makes it obvious.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (emphasis in original).

Although “the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification.” *Id.* The Specification need not describe the claimed subject matter in exactly the same terms as used in the claims, but it must contain an equivalent description of the claimed subject matter. *Id.*

Under 35 U.S.C. § 101, a patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has “long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013)). The Supreme Court in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–84 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 134 S. Ct. at 2355.

The first step in that analysis is to determine whether the claims at issue are directed to one of those patent-ineligible concepts, such as an *abstract idea*. Abstract ideas may 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 claims are *not directed* to a patent-ineligible concept, *the inquiry ends*. See *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1262 (Fed. Cir. 2017).

Otherwise, the inquiry proceeds to the second step in which the elements of the claims are considered “individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 79, 78).

## ANALYSIS

### REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The Examiner finds that paragraphs 23, 45, 66, and 67 of Appellants’ Specification provide disclosure that user interface elements are presented, provided, and interacted with by the user. Ans. 3–4. Nonetheless, the Examiner determines that the written description is inadequate because the specification does not describe how the claimed “user interface elements” are generated. Ans. 4.

We do not agree with the Examiner’s determination. We find that the Specification discloses that “one or more UI elements may be presented with the advertisements allowing the user to sort and/or filter” them. Spec. ¶ 61. “The UI elements may include, for instance, drop-down menus, lists, and other UI elements.” *Id.* Figures 7–11 illustrate the user interface elements that are disclosed and claimed. We find that the person having ordinary skill in the art, as of the filing date of the invention under appeal, would have found these user interface elements to be conventional, and would have known how to generate such user interface elements.

We conclude that the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 112, first paragraph, and we do not sustain the rejection.

REJECTION UNDER 35 U.S.C. § 101

We agree with the Examiner that the claimed invention is directed to the abstract idea of “delivering of advertisements for presentation with some primary content.” Ans. 5. Proceeding to step 2 of the *Alice* analysis, however, we find that the invention solves a problem necessarily rooted in computer technology in order to overcome a problem specifically arising when presenting advertising on the Internet.

In *DDR Holdings*,<sup>2</sup> the invention concerned retaining visitors on a host web site when such visitors click on an advertisement for a third-party product. Rather than being sent to the third-party website, said visitors were directed instead to a hybrid website that retains the look and feel of the host website and presents the product information of the third party. *DDR Holdings*, 773 F.3d at 1253. The court held the claims to be patent eligible because the invention did not merely apply a known business process to the particular technological environment of the Internet, nor broadly claim “use of the Internet” to perform an abstract business practice. *Id.* at 1256. Rather, the claims in *DDR Holdings* were found to address the challenge of retaining control over the attention of the customer in the context of the Internet. *Id.*

Similarly, the claims under appeal address the challenge, particular to the Internet, of providing the ability for users to interact with an advertisement, using limited screen display space, and view additional

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<sup>2</sup> *DDR Holdings, LLC v. Hotels.com, LP*, 773 F.3d 1245 (Fed. Cir. 2014).

information about an advertised product or products without taking the user's attention away from primary content. App. Br. 22. We agree with Appellants' argument that providing user interface elements that allow the user to sort and/or filter advertisements based on features that interest the user, using only the limited screen display space provided for advertisements, avoids the disadvantages of requiring larger display space for advertisements or requiring the user to navigate away from primary content. *Id.*

Therefore, we find that the claimed invention is deeply rooted in computer technology to solve a problem that arises with the presentation of advertising on the Internet. The claimed invention thus recites significantly more than an abstract idea, so as to transform the nature of the claim into a patent-eligible application. We conclude that the Examiner erred in rejecting claims 1–20 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter. We do not sustain the Examiner's rejection.

#### REJECTION UNDER 35 U.S.C. § 103(A)

Independent claim 1 recites, *inter alia*, “one or more user interface elements that allow a user to sort or filter the advertisements based on the feature-value pairs associated with the advertisements while maintaining the presentation of the separate primary content, the one or more user interface elements being generated based on the feature-value pairs associated with the advertisements.” Independent claims 9 and 16 recite analogous limitations.

The Examiner finds that Bharat teaches this limitation concerning user interface elements. Non-Final Act. 7–8. The Examiner cites Figures 7 and 11–13, and columns 6, 13, and 14 of Bharat as providing a teaching of user

interface elements that allow a user to sort or filter advertisements based on feature-value pairs associated with the advertisements.

We find the Examiner's rejection to be erroneous. Bharat is concerned with employing information that may be gleaned about a user, e.g., from the user's provided profile information and/or from tracking the user's search history, in order to serve the user with targeted advertising. *See* Bharat, cols. 2–3. Bharat does not disclose the ability for the *end user* to sort and/or filter advertising information that is delivered to the user's computer. Further, the disclosed "feature-value pairs" in Bharat "are directed to information about the advertisements that may be used to select advertisements based on user information," not "a feature of the product or service and a value defining the feature." App. Br. 24, 28; Bharat, col. 9:12–50. The Examiner further finds that "user interface elements that **allow a user to sort or filter** the advertisement based on the feature value pairs associated with the advertisements" constitutes "mere intended use" that receives little patentable weight. Non-Final Act. 10. Even were we to assume *arguendo* that the Examiner's statement were correct, the combination of Bharat and Hayes fails to disclose the claimed user interface elements.

The Examiner further cites Hayes as disclosing the claimed feature-value pairs. Non-Final Act. 8–9. Although we agree with the Examiner that the advertisements shown in Hayes Figures 1B and 1C include product features such as price and mileage, such features appear as text that forms the content of the advertisements. We agree with Appellants that there is nothing to indicate that the product features are "separate from the content of the advertisement," as claim 1 requires. App. Br. 25. Hayes, like Bharat,

fails to disclose user interface elements that allow the user to sort and/or filter the advertisement. App. Br. 26.

Because we are persuaded by Appellants' arguments that the Examiner erred, we do not sustain the Examiner's § 103(a) rejection of claims 1–20 over Bharat and Hayes.

### CONCLUSIONS

1. The disclosure reasonably conveys to one of ordinary skill in the art that the inventors had possession of the claimed subject matter.

2. The claimed invention is directed to an abstract idea, but recites significantly more so as to transform the invention into a patent-eligible application.

3. The combination of Bharat and Hayes does not disclose or suggest providing one or more user interface elements that allow a user to sort or filter advertisements based on feature-value pairs associated with the advertisements while maintaining presentation of separate primary content, the user interface elements being generated based on the feature-value pairs associated with the advertisement.

### ORDER

The Examiner's decision to reject claims 1–20 is reversed.

REVERSED