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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN MACLEOD, LUMUMBA MBEKEANI,
and HOWARD R. HAYES JR.

Appeal 2017-007595
Application 11/416,767¹
Technology Center 3600

Before ELENI MANTIS MERCADER, NORMAN H. BEAMER, and
ADAM J. PYONIN, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–11, 14–24, and 29–36. We have jurisdiction over the pending rejected claims under 35 U.S.C. § 6(b).

We affirm-in-part.

¹ Appellants identify Here Global B.V. as the real party in interest. (App. Br. 2.)

THE INVENTION

Appellants' disclosed and claimed invention is directed to a method of providing advertisements in which an advertisement is provided for output on a navigation system based on the presence of an advertising reference code. (Spec. ¶ 8.)

Independent claim 1, reproduced below, is illustrative of the subject matter on appeal:

1. A computer-implemented method for a traffic information broadcast system to provide advertisements in a traffic message comprising:

obtaining at a processor in the traffic information broadcast system traffic data having a traffic condition of a location description on a road network;

assessing by the processor a location reference code associated with the location description, the location reference code is pre-assigned prior to operation of the traffic information broadcast system;

assessing by the processor an advertising reference code associated with the location reference code;

wherein the location reference code and the advertising reference code are associated with an advertisement message having a data size larger than the data size of the location reference code and advertising reference code;

generating by the processor a traffic message having the location reference code and the advertising reference code instead of the advertisement message, the data size of the traffic message being less than if the advertisement message were included therein; and

automatically broadcasting the traffic message in a traffic channel such that a device in receipt of the traffic message may present the advertisement message, not included in the traffic message, to a user thereof based on the location reference code and the advertising reference code.

REJECTIONS

The Examiner rejected claims 23 and 24 under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form.² (Final Act. 2.)

The Examiner rejected claims 1–11, 14–24, and 29–36 under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception without significantly more. (Final Act. 3–4.)

ISSUE ON APPEAL

Appellants' arguments in the Appeal and Reply Briefs present the following issue:³

Whether the Examiner erred in finding claims 1–11, 14–24, and 29–36 as directed to non-statutory subject matter. (Reply Br. 2–5.)

ANALYSIS

The Examiner concludes the pending claims are patent-ineligible under 35 U.S.C. § 101 because independent claims 1, 14, and 29 recite an abstract idea “of delivering targeting advertisements to customers in a traffic message” in which:

² Appellants submitted an Amendment after Final Rejection on July 27, 2016 that canceled claims 23 and 24, but the Advisory Action mailed on Sept. 12, 2016 does not indicate the Amendment would be entered, and the Answer fails to indicate the status of claims 23 and 24. As Appellants do not challenge the rejection and the file history contains no indication the Amendment was entered, we summarily affirm the rejection.

³ Rather than reiterate the arguments of Appellants and the positions of the Examiner, we refer to the Appeal Brief (filed Dec. 20, 2016); the Reply Brief (filed Apr. 21, 2017); the Final Office Action (mailed June 7, 2016); the Advisory Action (mailed Sept. 12, 2016); and the Examiner's Answer (mailed Feb. 28, 2017) for the respective details.

[t]he steps of “obtaining”, “assessing”, “generating” and “broadcasting” the traffic message, is simply a way of collecting information and comparing known information, which is an idea of itself, as evidenced by *Classen* [*Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011)] and store and transmit information in *Cyberfone* [*Cyberfone Systems, LLC v. CNN Interactive Group, Inc.*, 558 Fed. Appx. 988 (Fed. Cir. 2014)(non-precedential)], or comparing new and stored information and using rules to identify options in *SmartGene* [*SmartGene, Inc. v. Advanced Biological Laboratories, SA*, 555 Fed.Appx. 950 (Fed. Cir. 2014)(non-precedential)].

(Final Act. 3.) The Examiner further finds that there is nothing in the claims that is significantly more than this abstract idea, because the cited steps “are generic computer functions that are well-understood, routine and conventional” and the additionally-recited processor, server, and navigational systems “do not add meaningful limitations.” (Final Act. 3–4.)

Appellants argue, *inter alia*, that “the claimed invention represents a significant improvement to communications technology” that “provides for a specific and particular application which transmits message reference codes instead of actual messages” in which “[t]he reference codes require much less bandwidth to transmit than the actual messages and therefore can be used over a lower bandwidth medium or with lower bandwidth communications protocols.” (App. Br. 6, citing Spec. ¶¶ 5, 11.)

We are persuaded of Examiner error. The Supreme Court has long held that “[l]aws 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 *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589–90 (2013)). The “abstract ideas” category embodies the

longstanding rule that an idea, by itself, is not patentable. *Alice Corp.*, 134 S. Ct. at 2354–55 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

In *Alice*, the Supreme Court sets forth an analytical “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. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 79, 78 (2012)). In other words, the second step is to “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.* (quoting *Mayo*, 566 U.S. at 73.) The prohibition against patenting an abstract idea “‘cannot be circumvented by attempting to limit the use of the formula to a particular technological environment’ or adding ‘insignificant postsolution activity.’” *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010).

Turning to the first step of the *Alice* inquiry, we agree with the Examiner’s finding that the claims are directed to the abstract idea “of delivering targeting advertisements to customers in a traffic message.”

There is no definitive rule to determine what constitutes an “abstract idea.” Rather, the Federal Circuit has explained that “both [it] and the

Supreme Court have found it sufficient to compare claims at issue to those claims already found to be directed to an abstract idea in previous cases.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016); *see also Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016) (explaining that, in determining whether claims are patent-eligible under § 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”). The Federal Circuit also noted 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.

Here, the Examiner finds that the steps of “obtaining”, “assessing”, “generating” and “broadcasting” comprise “collecting information and comparing known information.” We agree, as our reviewing court has held that collecting information, including when limited to particular content, analyzing it, and outputting the result are steps within the realm of abstract ideas. *See, e.g., Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); and *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011). Additionally, while Appellants do state that “the present claims are not directed to an abstract idea” (App. Br. 4), Appellants do not provide specific arguments challenging the Examiner’s *Alice* step one findings for the

“obtaining”, “assessing”, “generating” and “broadcasting” steps. *See* App. Br. 5–13.

Turning to the second step of the *Alice* inquiry, we disagree with the Examiner and find the claimed combination adds significantly more to transform the abstract idea of delivering targeting advertisements to customers in a traffic message. Particularly, we find “an inventive concept” in the “non-conventional and non-generic arrangement of known conventional pieces” (*Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016)), as Appellants’ claimed method requires

the location reference code and the advertising reference code are associated with an advertisement message having a data size larger than the data size of the location reference code and advertising reference code,

which improves computer functionality and requires less bandwidth as argued by Appellants and supported by the disclosure. App. Br. 6, citing Spec. ¶¶ 5, 11. We agree with Appellants that

even a savings of one byte per message, when considered in the context of the volume of messages which may be sent using the claimed system, would represent a significant savings in the consumption of bandwidth

(Reply Br. 2) and achieves an improvement in computer functionality.

As the claimed combination adds significantly more to the abstract idea, we reverse the Examiner’s non-statutory subject matter rejection of claims 1–11, 14–24, and 29–36.

CONCLUSION

For the reasons stated above, we affirm the Examiner's rejection of claims 23 and 24 under 35 U.S.C. § 112, fourth paragraph; and reverse the Examiner's non-statutory subject matter rejection of claims 1–11, 14–24, and 29–36.

DECISION

The Examiner's decision rejecting claims 23 and 24 under 35 U.S.C. § 112(4) is affirmed.

The Examiner's decision rejecting claims 1–11, 14–24, and 29–36 under 35 U.S.C. § 101 is reversed.

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-IN-PART