



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/682,038	04/08/2015	Rajesh BASHETTY	48270.21500	6364
30734	7590	11/01/2018	EXAMINER	
BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304			BUSCH, CHRISTOPHER CONRAD	
			ART UNIT	PAPER NUMBER
			3681	
			NOTIFICATION DATE	DELIVERY MODE
			11/01/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eofficemonitor@bakerlaw.com
edervis@bakerlaw.com
patents@bakerlaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RAJESH BASHETTY, YUNZHEN WANG,
THOMAS POTTJEGORT, and
ALFONSO CORRETTI GERBAUDO¹

Appeal 2017-007639
Application 14/682,038
Technology Center 3600

Before CAROLYN D. THOMAS, JOHN R. KENNY, and
MICHAEL J. ENGLE, *Administrative Patent Judges*.

KENNY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 from a final rejection of claims 1–5, 7–13, 15–18, and 20–23, which constitute all pending claims. Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

¹ Appellants identify comScore, Inc. as the real party in interest. App. Br. 1.

SPECIFICATION

The Specification discloses a computer-implemented method for receiving at an analysis network information concerning video ad tracking. Spec. ¶¶ 1, 6. The disclosed method involves communications amongst a content provider, a creative provider, and an analysis network. *See, e.g., Id.* at Figs. 3, 4A. A content provider may be a website owner, content publisher, or an advertising agency or broker that provides advertisements to the website owner or content publisher. *Id.* ¶ 20. A creative provider may be a company seeking to market or sell products or services, or an advertisement agency or broker that provides advertisements to the content provider. *Id.* An analysis network may be a third party seeking to receiving information received by content provider and the creative provider to determine metrics associated with the viewing of the advertisements. *Id.*

CLAIMED INVENTION

Claim 1 is illustrative:

1. A computer-implemented method for receiving tracking information at an analysis network, the computer-implemented method comprising:
 - receiving, at the analysis network and from a creative provider, a first link to a first video ad serving template comprising first instructions for generating first tracking information and a second link to a video creative;
 - generating, based on the first link to the first video ad serving template, a second video ad serving template comprising:
 - the first link to the first video ad serving template comprising the first instructions for generating the first tracking information and the second link to the video creative, and

a third link to second instructions for generating second tracking information, the second tracking information being different from the first tracking information;

forwarding, from the analysis network and to the creative provider, a link to the second video ad serving template that is forwarded by the creative provider to a content provider;

receiving, at the analysis network and from the content provider, a request for the second instructions for generating the second tracking information;

forwarding, from the analysis network and to the content provider, the second instructions for generating the second tracking information; and

receiving, at the analysis network and from the content provider, the second tracking information generated by the second instructions.

REJECTION

Claims 1–5, 7–13, 15–18, and 20–23 stand rejected under 35 U.S.C. § 101. Final Act. 2.

ANALYSIS

In *Alice Corp v. CLS Bank International*, 134 S. Ct. 2347 (2014), the Supreme Court reiterates an analytical two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 79 (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 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 eligible subject matter, the inquiry ends. *Thales*

Visionix Inc. v. United States, 850 F.3d 1343, 1349 (Fed. Cir. 2017); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1339 (Fed. Cir. 2016).

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.” *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 566 U.S. at 79, 78). 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.* (alteration in original) (quoting *Mayo*, 566 U.S. at 72–73).

In rejecting claims 1–5, 7–13, 15–18, and 20–23 under 35 U.S.C. § 101, the Examiner determines these claims are directed to the abstract idea of “distributing ads and creating links to monitor and record the performance of the ads,” which is considered as (1) an idea of itself and (2) a fundamental economic process. The Examiner also determines these claims include limitations that are analogous to those discussed in *SmartGene, Inc. v. Advanced Biological Labs*, 555 F. App’x 950 (Fed. Cir. 2014); *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350 (Fed. Cir. 2014); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315 (Fed. Cir. 2012); and *Digitech Image Tech., LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014). Final Act. 2–3. The Examiner also determines the additional limitations in the claims do not improve another technology or technical field, do not improve the functioning of a computer itself, and do not move beyond a general link of the abstract idea to a particular technological environment. *Id.* at 3–4. The

Examiner further determines the claims merely amount to the application of the abstract idea on a generic computer system, and merely are instructions to implement the abstract idea in a particular, well-understood, routine, and conventional technological environment. *Id.*

Alice Step One

Turning to the first step of the *Alice* inquiry, Appellants argue that the Examiner improperly overgeneralizes or simplifies the claims, asserting that the pending claims do not recite distributing ads. App. Br. 14; Reply Br. 1–2. Instead, Appellants assert the claims recite the creation of a particular type of file—a second video ad serving template—that includes two specific types of information: a first link to the first video ad serving template and a third link to the second instructions for generating second tracking information. App. Br. 14; Reply Br. 3. Further, Appellants argue that, because the second video ad serving template contains two different links for tracking, two different networks can track the performance of an advertisement in different ways using different instructions. App. Br. 14; Reply Br. 3. Specifically, Appellants contend that the content provider can request instructions for generating first tracking information and second, different tracking information based on the reception of a single file. App. Br. 14; Reply Br. 3. Appellants assert that by providing links and not the instructions themselves, the second video ad serving template allows the creative provider and the analysis network to update the instructions themselves without creating a new video ad serving template or informing the other party of the update, thereby improving the performance of the network. App. Br. 14; Reply Br. 3.

Appellants argue that because the claims create the recited second video ad serving template, the claims are not directed to an abstract idea, but rather to (1) an improvement in computer-related technology, like the claims in *McRO, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) (App. Br. 14–15; Reply Br. 2–3) and (2) an unconventional technological solution for a technical problem, i.e., tracking the performance of advertisements simultaneously using two different networks working together in a distributed manner, like the claims in *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016). App. Br. 15.

Appellants further argue that, under *Enfish*, the mere fact that the claimed elements can be performed on a general purpose computer does not mean they are directed to an abstract idea. App. Br. 16; Reply Br. 3. Further, Appellants assert that the claims here pose no threat of preempting all techniques of distributing ads and creating links to monitor and record the performance of the ads and, therefore, are patent eligible. App. Br. 15. And Appellants also contend that because the pending claims solve technological problems, they are not directed to an abstract idea under *Thales Visionix*. Reply. Br. 6.

We disagree. At the outset, we note the Examiner is required to characterize whether a claim is directed to an abstract idea under *Alice* step one. But because there is no single universal definition of an abstract idea, the Examiner is asked “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*, 841 F.3d at 1294 (citing *Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353–54 (Fed. Cir. 2016)); accord USPTO Memorandum, July 2015 Update: Subject Matter Eligibility (July 30, 2015),

<https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf> (instructing Examiners that “a claimed concept is not identified as an abstract idea unless it is similar to at least one concept that the courts have identified as an abstract idea”). In this case, the Examiner did what was required under the USPTO Memorandum, and characterized the claims as required under *Alice*. Further, the identified abstract idea need not encompass every claim limitation. Otherwise, there would be no need for step two of the *Alice* inquiry. *Alice*, 134 S. Ct. at 2355.

Second, although the pending claims do not expressly recite distributing ads, they recite distributing links to such ads (i.e., a second link to a video creative in a first ad serving template). The purpose of such links is to distribute the ads/video creatives themselves. *See Spec. Figs 4A and 4B*. Therefore, the Examiner’s finding that the claims are directed to the distribution of ads is not erroneous. Moreover, to the extent that we would clarify that only links to video creatives are distributed, the alleged error by the Examiner would be harmless. In that case, the abstract idea would be phrased as involving the distribution of links to a video creative, which would not substantively affect our analysis.

Third, Appellants’ reliance on *McRO* is misplaced. The claims in *McRO* recited a “specific . . . improvement in computer animation” using “unconventional rules that relate[d] sub-sequences of phonemes, timings, and morph weight sets.” *McRO*, 837 F.3d at 1302–03, 1307–08, 1314–15. In *McRO*, the defendants conceded that, before the claimed invention, an animator’s process was driven by subjective determinations rather than specific, limited mathematical rules. *Id.* at 1314. The claimed invention in *McRO* “improv[ed] the prior art through ‘the use of rules, rather than artists,

to set the morph weights and transitions between phonemes.” *Id.* at 1313 (citation omitted). Here, however, what is alleged to be unconventional about the recited template is not technological (e.g., having a file that includes links from two different sources with instructions), but rather economic (i.e., having a file that contains a link *from a creative provider* and a link *from an analysis network*, each with instructions *for ad tracking*). As such, the claims reciting this template are directed to an abstract idea. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (“The process of receiving copyrighted media, selecting an ad, offering the media in exchange for watching the selected ad, displaying the ad, allowing the consumer access to the media, and receiving payment from the sponsor of the ad all describe an abstract idea, devoid of a concrete or tangible application.”); *see also buySAFE*, 765 F.3d at 1355; *Dealertrack*, 674 F.3d at 1334; and *Digitech Image Tech.*, 758 F.3d at 1349–1351.

Fourth, Appellants’ reliance on *Amdocs* is misplaced. *Amdocs* did not hold that the claims at issue in that case were patent eligible under step one of the *Alice* test. *Amdocs*, 841 F.3d at 1300 (“Indeed, even if we were to agree that claim 1 is directed to an ineligible abstract idea under step one, the claim is eligible under step two because it contains a sufficient ‘inventive concept.’”). Accordingly, we will address Appellants’ arguments concerning *Amdocs* in our analysis of step two below.

Fifth, Appellants’ reliance on *Enfish* is also misplaced. Although *Enfish* indicates that the mere ability of an invention to run on a general purpose computer does not render the invention patent eligible, *Enfish* does not hold that all inventions running on a general purpose computer are patent eligible. *Enfish*, 822 F.3d at 1338. In *Enfish*, the claims were directed to an

improved database architecture, i.e., a self-referential table — “a specific type of data structure designed to improve the way a computer stores and retrieves data in memory.” *Enfish*, 822 F.3d at 1339. Such a data structure has several distinct advantages over conventional relational databases, including: (1) faster searching of data than would be possible with the conventional relational model (*see* US 6,151,604, 1:55–59, 2:66–3:6); (2) more effective storage of data other than structured text, such as storage of images and unstructured text (*id.* at 2:16–22, 2:46–52); and (3) more flexibility in configuring the database (*id.* at 2:27–29).

In *Enfish*, the Federal Circuit interpreted the “directed to” inquiry as asking “whether the claims are directed to an *improvement to computer functionality* versus being directed to an abstract idea.” *Enfish*, 822 F.3d at 1335 (emphasis added). “[T]he focus of the claims is on the specific asserted improvement in computer capabilities (i.e., the self-referential table for a computer database).” *Id.* at 1335–1336. Based on the “plain focus of the claims,” the Federal Circuit reached the conclusion that *Enfish*’s claims were directed to “a specific improvement to the way computers operate, embodied in the self-referential table,” and, as such, were more than a mere abstract idea. *Id.* at 1336. As discussed above, however, here what is alleged to be unconventional about the creation of the second video ad serving template in the pending claims is economic, rather than technological.

Sixth, Appellants’ arguments regarding preemption are also misplaced. Although “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). “Where a patent’s claims are deemed only to disclose patent ineligible subject matter” under the *Alice/Mayo* framework, “preemption concerns are fully addressed and made moot.” *Id.*

Seventh, Appellants’ argument that the claims are patent eligible under *Thales Visionix* because the claims solve technological problems is not persuasive because, as discussed above, the allegedly unconventional aspects of the claims, concern economic, rather than technological factors.

Accordingly, we agree with the Examiner that the pending claims are directed to an abstract idea of distributing ads and creating links to monitor and record the performance of the ads.

Alice Step Two

Turning to step two of the *Alice* inquiry, Appellants argue that the claims are patent eligible because (i) the limitations reciting the second video ad tracking template, like the claimed steps in *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), provide an inventive concept sufficient to transform the claims into more than the abstract idea, (ii) the claims recite a self-evident, patent eligible ordered combination, like the claims in *BASCOM*, and (iii) the claims solve problems that are unique to activities on the Internet, like the claims in *DDR Holdings, LLC v. Hotels.com, LP*, 773 F.3d 1245 (Fed. Cir. 2014).

We disagree. First, as discussed above, the allegedly unconventional aspect of the second video ad tracking template concerns economic, not technological factors. Second, the steps identified by Appellants as a self-evident, patent eligible ordered combination are not self-evidently patent eligible, and Appellants have provided no persuasive reason for us to deem

them patent eligible. Reply Br. 5–6. Third, Appellants’ analogy to *DDR Holdings* is unpersuasive. The claims in *DDR Holdings* addressed a unique technical problem in computer technology: how to allow a user to view something from another website while retaining control over what is displayed to the user. *DDR Holdings*, 773 F.3d at 1257–1258. As discussed above, the allegedly unconventional aspects of the pending claims concern economic, not technological, factors.

Fourth, regarding *Amdocs*, the inventive concept in that case was “an unconventional technological solution (enhancing data in a distributed fashion) to a technological problem (massive record flows which previously required massive databases) . . . [where the] claim’s enhancing limitation necessarily requires that . . . generic components operate in an unconventional manner to achieve an improvement in computer functionality.” *Amdocs*, 841 F.3d at 1300–1301. As discussed above, the allegedly unconventional aspects of the pending claims concern economic, not technological, factors.

Therefore, we agree with the Examiner that the claims do not recite an inventive concept sufficient to transform the abstract idea into a patent-eligible application. Accordingly, we sustain the rejection.

DECISION

We affirm the rejection of claims 1–5, 7–13, 15–18, and 20–23 under 35 U.S.C. § 101.

Appeal 2017-007639
Application 14/682,038

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)(iv).

AFFIRMED