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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID GROSS-BASER, FIDJI NAHEMA SIMO,
and HIMANSHU BAWEJA

Appeal 2017-007785
Application 13/751,801
Technology Center 3600

Before JOSEPH A. FISCHETTI, NINA L. MEDLOCK, and
AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL¹

The Appellants² appeal under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–20, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).³

We AFFIRM.

¹ Throughout this Decision, we refer to the Appellants’ Appeal Brief (“Appeal Br.,” filed Nov. 28, 2016), Reply Brief (“Reply Br.,” filed Apr. 26, 2017), and Specification (“Spec.,” filed Jan. 28, 2013), and to the Examiner’s Answer (“Ans.,” mailed Feb. 28, 2017) and Final Office Action (“Final Act.,” mailed Jan. 29, 2016).

² According to the Appellants, the real party in interest is Facebook, Inc. Appeal Br. 2.

³ We note that the Appellants waived the oral hearing. *See* Waiver of Hearing, Mar. 29, 2019.

STATEMENT OF THE CASE

The Appellants’ “invention relates generally to social networking systems, and in particular to creating advertisements for users of a social networking system.” Spec. ¶ 1.

Claims 1 and 13 are the independent claims on appeal. Claim 1 (Appeal Br. 18–19 (Claims App.)) is illustrative of the subject matter on appeal and is reproduced below (with added bracketing for reference):

1. A method comprising:

[(a)] receiving, through an advertisement user interface provided by a social networking system, an input from a user identifying a content item generated within the social networking system, the content item being associated with a content item type of a plurality of content item types;

[(b)] identifying, based on the content item type, one or more advertisement goals from a plurality of advertisement goals available to the content item, each content item type being associated with at least one advertisement goal, each advertisement goal corresponding to a set of options for advertising the content item type within the social networking system;

[(c)] presenting the identified one or more advertisement goals to the user on the advertisement user interface;

[(d)] receiving, through the advertisement user interface, a selection of an advertisement goal from the one or more presented advertisement goals from the user;

[(e)] identifying one or more options for advertising the content item within the social network from the set of options corresponding to the advertisement goal[;]

[(f)] presenting the identified options to the user through the advertisement user interface;

[(g)] receiving, from the user through the advertisement user interface, one or more selections of the presented options;
and

[(h)] generating one or more advertisements for the content item based on the advertisement goal selected by the user and the one or more selections of the presented options for promotion within the social networking system.

REJECTIONS⁴

Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more.

Claims 1–3, 6, 8–11, 13–16, 19, and 20 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Shah et al. (US 2008/0255944 A1, pub. Oct. 16, 2008) (“Shah”) and Novikov et al. (US 2013/0013418 A1, pub. Jan. 10, 2012) (“Novikov”).

Claims 4 and 17 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Shah, Novikov, and Smith et al. (US 2003/0041050 A1, pub. Feb. 27, 2003) (“Smith”).⁵

Claims 5, 7, and 18 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Shah, Novikov, and Ketchum (US 2011/0161162 A1, pub. June 30, 2011).⁶

Claim 12 stands rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Shah, Novikov, and Baldwin et al. (US 2014/0089320 A1, pub. Mar. 27, 2014) (“Baldwin”).⁷

⁴ The Examiner has withdrawn the rejection of claim 13 under AIA 35 U.S.C. § 112(a). Ans. 2.

⁵ Claims 4 and 13 depend directly from claims 2 and 13, respectively. We consider the Examiner’s omission of Novikov to be harmless error.

⁶ Claims 5, 7, and 18 depend directly from claims 2, 1, and 15, respectively. We consider the Examiner’s omission of Novikov to be harmless error.

⁷ Claim 12 depends directly from claim 10. We consider the Examiner’s omission of Novikov to be harmless error.

ANALYSIS

35 U.S.C. § 101 – Patent-Eligible Subject Matter

The Appellants argue claims 1–20 as a group. *See* Appeal Br. 9, 14, and 15. We select claim 1 from the group with the remaining claims standing or falling therewith. *See* 37 C.F.R. 41.37(c)(1)(iv).

An invention is patent-eligible if it claims a “new and useful process, machine, manufacture, or composition of matter.” 35 U.S.C. § 101. However, the Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: “[I]aws of nature, natural phenomena, and abstract ideas” are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Supreme Court’s two-step framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is “directed to.” *See Alice*, 573 U.S. at 219 (“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.”); *see also 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.”).

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 69 (1972)). Concepts

determined to be patent eligible include physical and chemical processes, such as “molding rubber products” (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); “tanning, dyeing, making water-proof cloth, vulcanizing India rubber, smelting ores” (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1854))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Supreme Court held that “a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula.” *Diehr*, 450 U.S. at 187; *see also id.* at 191 (“We view respondents’ claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula.”). Having said that, the Supreme Court also indicated that a claim “seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, . . . and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment.” *Id.* (citing *Benson* and *Flook*); *see, e.g., id.* at 187 (“It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.”).

If the claim is “directed to” an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where “we must examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Alice*, 573 U.S. at 221 (quotation marks omitted). “A claim that recites an abstract idea must include ‘additional features’ to

ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Id.* (quoting *Mayo*, 566 U.S. at 77). “[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention.” *Id.*

The PTO recently published revised guidance on the application of § 101. 2019 REVISED PATENT SUBJECT MATTER ELIGIBILITY GUIDANCE, 84 Fed. Reg. 50 (Jan. 7, 2019) (“2019 Revised Guidance”). Under the 2019 Revised Guidance, we first look to whether the claim recites:

- (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human activity such as a fundamental economic practice, or mental processes); and
- (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.05(a)–(c), (e)–(h)).

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look to whether the claim:

- (3) adds a specific limitation beyond the judicial exception that is not “well-understood, routine, conventional” in the field (*see* MPEP § 2106.05(d)); or
- (4) simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception.

See 2019 Revised Guidance.

Step One of the Mayo/Alice Framework

Under the first step of the *Mayo/Alice* framework the Examiner determines that claim 1 is directed to “the abstract idea of determining advertisements in response to user interaction.” Final Act. 6; Ans. 3. When viewed through the lens of the 2019 Revised Guidance, the Examiner’s determination depicts the claimed subject matter as one of the ineligible

“[c]ertain methods of organizing human activity” that include “commercial . . . interactions (including . . . advertising, marketing or sales activities or behaviors” under Prong One of Revised Step 2A. 2019 Revised Guidance, 84 Fed. Reg. at 52.

The Appellants disagree and contend that the claim is more accurately described as “recit[ing] a user interface flow in which a user (e.g., an advertiser) creates a new advertisement.” Appeal Br. 10.

Under step one of the *Alice* framework, we “look at the ‘focus of the claimed advance over the prior art’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter.” *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (quoting *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016), *cert. denied*, 137 S. Ct. 1230 (2017)).

The “directed to” inquiry . . . cannot simply ask whether the claims *involve* a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions *involves* a law of nature and/or natural phenomenon Rather, the “directed to” inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether “their character as a whole is directed to excluded subject matter.” *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1335 (Fed. Cir. 2016). In other words, the first step of the *Alice* framework “asks whether the focus of the claims is on the specific asserted improvement in [the relevant technology] or, instead, on a process that qualifies as an ‘abstract idea’ for

which computers are invoked merely as a tool.” *Id.* at 1335–36; *see also* 2019 Guidance, 84 Fed. Reg. at 54–55.

An examination of claim 1 shows that the claim recites “[a] method comprising:” (a) receiving input identifying a content item associated with a content type from a user through an advertisement interface provided by a social networking system; (b) identifying an advertisement goal based on the type; (c) presenting the identified goal on the interface; (d) receiving a selection of a goal through the interface; (e) identifying an option for advertising the content item with the social network; (f) presenting the identified option through the interface; (g) receiving a selection of an option; and (h) generating an advertisement for the content items based on the selected goal and options. *See* Appeal Br. 18–19 (Claims App.). Steps (b), (e), and (h) of identifying and generating are not claimed as being performed by a computer or the interface.

The Specification provides for an invention that “creat[es] advertisements for users of a social networking system.” Spec. ¶ 1. The problem with previous social networking systems is that “because additional options for advertisement presentation and performance enhance advertisement effectiveness, advertisements created using conventional social networking systems are not optimized to achieve their goals.” *Id.* ¶ 3. Thus, the purported invention “increase[s] the effectiveness of an advertisement,” by having “the social networking system allow[] a user to specify a goal for an advertisement and customize[] the advertisements based on the specified goal.” *Id.* ¶ 4.

The social network is not defined in the claim. The Specification provides that “[a] social networking system allows users to connect with and

to communicate with other users of the social networking system” (Spec. ¶ 2) and that “[c]onventional social networking systems provide users with different options for creating an advertisement” (*id.* ¶ 3). A social networking system is described as “includ[ing] a user profile store 205, an action logger 210, an action store 215, an interface generator 220, an edge store 225, an object store 230, a query processing module 235, and a web server 240.” *Id.* ¶ 21. The social networking system may have “additional, fewer, or different components” and includes “[c]onventional components such as network interfaces, security functions, load balancers, failover servers, management and network operations consoles, and the like.” *Id.* As such, the social networking system comprises conventional components of stores/databases, a generator, a module, servers, interfaces, security functions, and consoles.

The claim also does not provide details on how the identifying and generating steps are performed. The Specification provides that “the social networking system determines the type of object corresponding to the input (e.g., a page, an application, an event, etc.)” by, for example, providing a list of candidate objects matching a portion of the input and having the user identify an object from the list. Spec. ¶ 4. “Once the type of object is identified by the social networking system, the user is presented with goals specific to the type of object.” *Id.* ¶ 5; *see also id.* ¶ 38. After a goal is selected, advertisement customization options are presented based at least in part on the selected goal. *Id.* ¶ 39. Once customization options are received, “interface generator 220 generates 305 an advertisement based on the selected advertisement customization options that is presented to other users of the social networking system.” *Id.* The Specification does not provide

details on how, technologically or by what algorithm, a goal is identified, an option is identified, or an advertisement generated.

When considered collectively and under the broadest reasonable interpretation of the claim limitations, the limitations recite a method for creating customized advertisements based on user input.⁸ Limitations (a), (d), and (g) of receiving input and selections are data input steps and ordinarily performed in creating customized items. Limitations (b) and (e) of determining goals and options based on user input are limitations comprising analyses that can be performed mentally. Limitations (c) and (f) of presenting the identified goals and options are post-solution activities of simply presenting the results of an analysis. And limitation (g) of generating an advertisement based on the selections is a post-solution activity that can be performed manually and is ordinarily performed in creating a customized item.

Creating customized advertisements based on user input is similar to the concepts of customizing information based on known user information in *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369–70 (Fed. Cir. 2015) and customizing a user interface based on user selections in *Affinity Labs of Texas, LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1271 (Fed. Cir. 2016). Accordingly, we conclude the claim recites a commercial interaction, which is one of the certain methods of organizing

⁸ Although we and the Examiner describe, at different levels of abstraction, to what the claims are directed, it is recognized that “[a]n abstract idea can generally be described at different levels of abstraction.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). That need not and, in this case does not, “impact the patentability analysis.” *See id.* at 1241.

human activities identified in the 2019 Revised Guidance, 84 Fed. Reg. at 52, and thus an abstract idea.

Under Step 2A, Prong 2 of the 2019 Revised Guidance at 54, we look to whether the claims “apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception,” i.e., “integrates a judicial exception into a practical application.” Here, the Appellants contend that the claim “recite[s] improvements to advertisement technologies” by “us[ing] an unconventional user interface in which a would-be advertiser first specifies a content item in the system (which may relate to a product or service to be advertised),” similar to *BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016).⁹ Appeal Br. 12; *see also id.* at 13; Reply Br. 6. The Appellants contend that the “customization of advertisements by the social networking system itself is a non-conventional improvement on traditional advertising and thereby provides significantly more than simply generating advertisements in an abstract sense.” *Id.* at 12.

In *BASCOM*, the court determined that “an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.” *BASCOM*, 827 F.3d at 1350. In that case, the installation of a filtering tool at a specific location, remote from the end users, with customizable filtering features specific to each end user,

⁹ We acknowledge that some of these considerations may be properly evaluated under Step 2 of *Alice* (Step 2B of Office guidance). Solely for purposes of maintaining consistent treatment within the Office, we evaluate them under Step 1 of *Alice* (Step 2A of Office guidance). *See* 2019 Revised Guidance at 55.

provided an inventive concept in that it gave the filtering tool both the benefits of a filter on a local computer and the benefits of a filter on the ISP server. *Id.* We find no analogous non-conventional, non-generic arrangement of known, conventional pieces within a network or an achievement of a technical improvement. The claim does not disclose a particular, unconventional user interface or how the interface itself is technologically improved. The Specification provides that the interface is a generic computer component, such as a display of a web page, operating in its conventional manner. *See Spec.*, e.g., ¶¶ 19, 26, 40, Figs. 1, 4A–6. As the Appellants state, any improvement is to “traditional advertising” by “increas[ing] the effectiveness of the advertisement” (Appeal Br. 12) and by “allow[ing] for the more effective customization of advertisements to achieve these goals specific to the type of content item” (*id.* at 13), not to the user interface itself. These are not technological improvements or improvements to a technological area. The alleged improvement lies in the abstract idea itself, not to any technological improvement. *See BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1287–88 (Fed. Cir. 2018). And, as discussed above, there are no technological details for implementing the method or further description of a particular technological manner for performing the steps. *See TDE Petroleum Data Sols., Inc., v. AKM Enter., Inc.*, 657 F. App’x 991, 993 (Fed. Cir. 2016) (“As we discussed at greater length in *Electric Power*, the claims of the ’812 patent recite the *what* of the invention, but none of the *how* that is necessary to turn the abstract idea into a patent-eligible application” (citing *Electric Power*, 830 F.3d at 1353)); *Enfish*, 822 F.3d at 1336 (focusing on whether the claim is “an improvement

to [the] computer functionality itself, not on economic or other tasks for which a computer is used in its ordinary capacity”).

The Appellants further contend that the claim is not directed to an abstract idea because it “recite[s] a method that is inherently tied to computer technology” and is “rooted in computer technology,” similar to *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2015). Appeal Br. 13, 14; *see also* Reply Br. 8. We disagree. In *DDR Holdings*, the Federal Circuit determined that the claims addressed the problem of retaining website visitors who, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be transported instantly away from a host’s website after clicking on an advertisement and activating a hyperlink. *DDR Holdings*, 773 F.3d at 1257. The Federal Circuit, thus, held that the claims were directed to statutory subject matter because they claim a solution “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *Id.* The court cautioned that “not all claims purporting to address Internet-centric challenges are eligible for patent.” *Id.* at 1258. And the court contrasted the claims to those at issue in *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014), in that, in *DDR Holdings*, the computer network was not operating in its “normal, expected manner” and the claims did not “recite an invention that is . . . merely the routine or conventional use of the Internet.” *Id.* at 1258–59.

In contrast, here, the Appellants do not state what problem specifically arising from computer networks the claim addresses. At best, the Appellants contend that the claim addresses the problem of ineffective advertising. *See* Appeal Br. 12–13. This is a business problem that existed prior to the

Internet. Also, unlike *DDR Holdings*, here, the solution comprises the use of mental steps of identifying and generating steps and a generic user interface operating in its normal capacity to receive and present data. The Appellants do not direct attention to, and we do not see, where the Specification describes computer components acting in an unconventional manner to further the desired solution of more effective advertising. Rather, the claim is analogous to *Ultramercial* in “recit[ing] an invention that is . . . merely the routine or conventional use of the Internet.” *DDR Holdings*, 773 F.3d at 1258–59. That the method is in the field of a social networking system, ostensibly involving the Internet and without a “brick-and-mortar equivalent” (Appeal Br. 14; *see also* Reply Br. 9), is not necessarily sufficient to transform an otherwise abstract claim to patent eligible subject matter. *Ultramercial*, 772 F.3d at 716 (limiting the use of the abstract idea “to a particular technological environment” does not make the abstract idea patent-eligible).

We also disagree that the claim is similar to those of *Trading Techs. Int’l., Inc. v. CQG, Inc.*, 675 F. App’x 1001 (Fed. Cir. 2017). *See* Reply Br. 4–6. In *Trading Techs.*, under Step 1, the district court held that the claims were “directed to improvements in existing graphical user interface devices that have no ‘pre-electronic trading analog,’ and recite more than ‘setting, displaying, and selecting’ data or information that is visible on the [graphical user interface] device.” *Trading Techs.* 675 F. App’x at 1004 (internal quotations omitted). The district court determined that the claims “solve problems of prior graphical user interface devices . . . in the context of computerized trading[] relating to speed, accuracy and usability” and did not “simply claim displaying information on a graphical user interface.” *Id.*

The claims required “a specific, structured graphical user interface paired with a prescribed functionality directly related to the graphical user interface's structure that is addressed to and resolves a specifically identified problem in the prior state of the art.” *Id.* Further, under Step 2, the district court held that “the specific structure and concordant functionality of the graphical user interface are removed from abstract ideas, as compared to conventional computer implementations of known procedures.” *Id.* The Federal Circuit agreed, holding that “the claimed subject matter is ‘directed to a specific improvement to the way computers operate,’ . . . for the claimed graphical user interface method imparts a specific functionality to a trading system ‘directed to a specific implementation of a solution to a problem in the software arts.’” *Id.* at 1006 (citations omitted).

Here, the claim simply requires receiving, identifying, presenting, and generating data without any specific functionality directly related to the user interface’s structure that is addressed to and resolves a problem in technology, as discussed above. The Appellants’ contention that the claimed “functionality paired with the claimed advertisement creation interface improves on conventional technology” (Reply Br. 5; *see also id.* at 6) is unsupported attorney argument; the Specification provides for no such consideration of an improvement to conventional technology. As discussed above, any improvement lies in the abstract idea itself.

Thus, we are not persuaded of error in the Examiner’s determination that claim 1 is directed to an abstract idea.

Step Two of the Mayo/Alice Framework

Under the second step in the *Mayo/Alice* framework, we find supported the Examiner’s determination that the claim’s limitations, taken individually or as an ordered combination, recites

a generic computer component that performs functions (i.e., receiving data (e.g. user input), determining data (e.g. a goals of an advertisement), receiving data (e.g. selection of a goal), determining data (e.g. options for an advertisement), receiving data (e.g. selection of an option for an advertisement) and generating data (e.g. advertisement) etc. . . .) that are well-understood, routine, and conventional activities previously known to the industry.

Final Act. 6. The Appellants argue that the “[E]xaminer oversimplifies the actual limitations of the claims, and improperly finds that the claims do not recite significantly more than an abstract idea” (Reply Br. 8), and rely on the arguments presented in the Appeal Brief at pages 12–13 (*id.* at 6). As we discussed above under Prong 2, we disagree that the claim recites a technical improvement.

The Appellants do not offer additional reasoning or argument why the claim “[a]dds a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, which is indicative that an inventive concept may be present.” 2019 Revised Guidance, 84 Fed. Reg. at 56. We agree with the Examiner that the claimed user interface operates in its ordinary and conventional capacity to perform the well-understood, routine, and conventional functions of receiving, and presenting data. *See* Spec. ¶¶ 19, 26, 40, Figs. 1, 4A–6.10, ll. 4–25 (describing a generic computer and interface); *Electric Power*, 830 F.3d at 1354–55 (gathering, sending, monitoring, analyzing, selecting, and

presenting information does not transform the abstract process into a patent-eligible invention). The steps of identifying and generating can be performed manually without a computer. Moreover, the claim simply recites the functional results to be achieved of receiving data, identifying data based on the received data, presenting data, and generating an advertisement/data based on the received data. The claim “provides only a result-oriented solution[] with insufficient detail for how a computer accomplishes it. Our law demands more.” *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1342 (Fed. Cir. 2017).

Thus, we are not persuaded of error in the Examiner’s determination that the limitations of claim 1 do not transform the claims into significantly more than the abstract idea.

We therefore sustain the Examiner’s rejection under 35 U.S.C. § 101 of claim 1 and of claims 2–20, which fall with claim 1.

35 U.S.C. § 103(a) – Obviousness

Claims 1–12

The Appellants contend that the Examiner’s rejection of independent claim 1 is in error because the cited “references describe methods for presenting advertisements to users, not for generating advertisements,” as recited in limitation (h). Appeal Br. 15; *see also* Reply Br. 9. Specifically, the Appellants argue that Shah does not “disclose a process for actually generating the advertisements” (*id.*) and “does not provide any further details about a process for how those advertisements are generated” (*id.* at 16). In the Reply Brief, the Appellants elaborate that Shah does not disclose generating advertisements “based on [an] advertisement goal

selected by the user and . . . one or more selections of the presented options.”
Reply Br. 11 (emphases omitted) (alterations in original). We agree.

The Examiner finds that Shah teaches a method comprising:

- (1) receiving actions and compiling behavior information, i.e., receiving input from a user through an interface, as recited in limitation (a);
- (2) determining campaign objectives, i.e., identifying advertisement goals, based on a content item type, as partially recited in limitation(b);
- (3) delivering the proposed campaign plan, i.e., presenting the identified advertisement goals to the user on the interface, as recited in limitation (c);
- (4) choosing a plan that meets the objectives, i.e., receiving a selection of a goal from the user through the interface, as recited in limitation (d);
- (5) delivering a proposed plan that meets requirement, i.e., identifying advertising options corresponding to the goal, as recited in limitation (e);
- (6) delivering the proposed plan, i.e., presenting the identified option through the interface, as recited in limitation (f); (7) receiving from the user a selection of an option, as recited in limitation (g), and delivering the advertisements that are based on fulfilling the objectives of the campaign, i.e., generating an advertisement based on the selected goals and option, as recited in limitation (h). *See* Final Act. 9–11 (citing Shah ¶¶ 59, 60, 62, 64, and 66). In response to the Appellants’ argument, the Examiner clarifies that Shah teaches using analyzed user traffic parameters to “inform the creation and transmission of targeted ads” and “facilitat[ing] the creation of comprehensive ad campaigns and targeted content serving based user preferences, geographic data, and other related data.” Ans. 5–6 (quoting Shah ¶¶ 47, 64). The Examiner acknowledges that Shah does not teach identifying a content item associated with a type, with each type being

associated with an advertisement goal, as recited in limitation (b) (*id.* at 11) and relies on Novikov for this (*id.*), determining that it would have been obvious to combine Novikov with Shah “in order to ‘leverage the information available to the systems to optimize for any desired result (or, optimization goal), such as growth, user engagement, revenue, sharing, or any other goal of an administrator of the social networking system’” (*id.* at 12 (quoting Novikov ¶ 6)).

Shah discloses “a system and method for managing multimedia advertising campaigns across multiple online and offline media sources.” Shah, Abstract. User information is obtained at run-time, i.e., “the moment when the ad or supplemental message is served to the user and displayed on the user device,” and is “used for the aggregation of metrics regarding the users.” *Id.* ¶ 47. “This facilitates the creation of comprehensive ad campaigns and targeted content serving based user preferences, geographic data, and other related data that are tied to and obtained from persistent profiles associated with each individual user.” *Id.* The ads served are “usually created as part of an overall ad campaign that consists of a number of ads that are rotated in and out of service depending upon their success, and other factors, such as time, classes of users, location, and so on.” *Id.* ¶ 59. The effectiveness of the ad messages is constantly analyzed and reviewed to determine an appropriate ad and maximum ad revenue. *Id.* ¶¶ 59, 66. The CMP server interfaces with the information database, the delivery systems, and the fulfillment requirement of the advertising campaign and executes a process that “facilitate[s] the planning and management of ad campaigns to meet both the high-level objectives and to ensure that these objectives can be met based on traffic patterns of the

networks” and tracks the delivery of ad messages. *Id.* ¶ 60. An “electronic dashboard” in a graphical user interface (“GUI”) “allows the ad server administrator to specify in plain language certain parameters regarding the ad campaign.” *Id.* ¶ 62. The GUI “includes a scanning function that automatically formats the ad server input and delivers a proposed campaign plan that meets the campaign objectives, including budget, verification, measurement, and reporting.” The system “ultimately helps ad servers 916 provide a customized experience for different audience and user segments based on characteristics unique to the users and/or their client devices.” *Id.* Identifiers/tags can also be collected and analyzed to “extract[] relevant user and client device information to compile reports that can be used by the advertising server.” *Id.* ¶ 64. “Various parameters regarding user traffic can be analyzed to inform the creation and transmission of targeted ads.” *Id.* The analyses are “provided to the ad server to facilitate the management of present or future ad messages in an ad campaign.” *Id.* ¶ 66.

We agree with the Appellants that the Examiner has not adequately shown how Shah, individually or in combination with Novikov, teaches generating an advertisement for an identified content item based on user-selected goals and presented options, as required by limitation (h) and in context of the claim as a whole. *See* Appeal Br. 16; Reply Br. 9–11. We agree that delivering an advertisement based on data is not equivalent to the claimed generating of an advertisement based on user-selected data. *See* Appeal Br. 16. The definitions of “generating” include to bring into existence such as by procreating or producing, to be the cause of a situation, action, or state of mind, and to define or originate something by the application of rules or operations. Merriam-Webster Online Dictionary,

<https://www.merriam-webster.com/dictionary/generate>, last visited June 5, 2019. In the context of claim 1 that is directed to creating customized advertisements based on user input, the term “generating” means to bring into existence by creating. Simply delivering appropriate advertisements is not enough.

To the extent the Examiner finds that Shah teaches creating advertisements based on collected data, the Examiner does not adequately explain how, and we do not see where, Shah teaches creating advertisements for an identified item based on user-selected goals and options. Although Shah teaches that user-collected data can be used to inform the creation of ads and to help ad servers provide a customized experience based on characteristics unique to the users (*see supra*), Shah does not teach that the advertisement is for an identified content item based on collected data including user-selected goals and user-selected options based on those goals. And, although a specific process for generating the advertisement is not claimed, the claimed process requires generating an advertisement for an identified item based on the user-selected data. We do not see how Shah’s process of analyzing data collected from the user to determine and deliver appropriate and effective advertisements generates an advertisement for an identified item based on user-selected data. And the Examiner’s reliance on Novikov for identifying a content item does not explain how the combination of Shah and Novikov teaches the generating step.

Thus, we are persuaded of error in the Examiner’s rejection of independent claim 1, and we do not sustain the Examiner’s rejection under 35 U.S.C. § 103(a) of claims 1–3, 6, and 8–11.

For the rejections of dependent claims 4, 5, 7, and 12, the Examiner relies on the same deficient finding of independent claim 1. Thus, for the same reasons as for claim 1, we also do not sustain the rejections of the dependent claims 4, 5, 7, and 12.

Claims 13–20

Independent claim 13 recites a method comprising 1) receiving input from a user through an interface; (2) determining a content item type; (3) presenting at least one advertisement goal to the user through the interface; (4) receiving a selection of a goal from the user through the interface; (5) determining one or more advertisement customization options for generating an advertisement; and (6) presenting the determined option(s) to the user. *See* Appeal Br. 21–22 (Claims App.). Claim 13 does not require the limitations recited in claim 1 of selecting an option and generating an advertisement for an identified content item based on user-selected goals and options.

The Appellants do not argue independent claim 13 and dependent claims 14–20 separately from claim 1. Thus, the Appellants have not met their burden in providing sufficient evidence to show non-obviousness in that Appellants have not provided sufficient evidence or technical reasoning why the Examiner has not established a *prima facie* case of obviousness. *See In re Eli Lilly & Co.*, 902 F.2d 943, 945 (Fed. Cir. 1990). The Appellants have not identified error in the Examiner’s interpretations of the cited references or the claim language and have offered no substantive arguments to rebut the specific underlying factual findings made by the Examiner in support of the ultimate legal conclusion of obviousness for claims 13–20. And we decline to examine the claims *sua sponte*, looking for

distinctions over the prior art. *Cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”).

In the absence of a detailed argument or explanation, we are not persuaded of error on the part of the Examiner. *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections,” citing *Ex Parte Frye*, 94 USPQ2d 1072 (BPAI 2010) (precedential) (“The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon.”)).

Therefore, we sustain the Examiner’s rejection of claims 13–16, 19, and 20 under 35 U.S.C. § 103(a). For similar reasons, we also sustain the Examiner’s rejections of dependent claims 17 and 18.

DECISION

The Examiner’s rejection of claims 1–20 under 35 U.S.C. § 101 is **AFFIRMED**.

The Examiner’s rejections under 35 U.S.C. § 103(a) of claims 1–12 are **REVERSED**.

The Examiner’s rejections under 35 U.S.C. § 103(a) of claims 13–20 are **AFFIRMED**.

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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