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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte IVAN MITROVIC

Appeal 2017-010148¹
Application 13/282,199²
Technology Center 3600

Before ALLEN R. MACDONALD, JAMES B. ARPIN, and
NABEEL U. KHAN, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

I. DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) the Examiner’s decision rejecting claims 1–5, 8, and 20–23. Final Act. 2. Claims 9–19 are cancelled. *Id.* We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

¹ In this Decision, we refer to Appellant’s Appeal Brief (“App. Br.,” filed October 20, 2016); the Final Office Action (“Final Act.,” mailed March 18, 2016); the Examiner’s Answer (“Ans.,” mailed March 23, 2017); and the originally filed Specification (“Spec.,” filed October 26, 2011).

² According to Appellant, eBay, Inc. is the real party-in-interest. App. Br. 2.

II. STATEMENT OF THE CASE

The recited methods, systems, and instructions stored on computer readable media “relate[] generally to data processing within a network-based system operating over a distributed network, and more specifically to systems and methods to deliver location-aware offers based on missed purchase opportunities.” Spec. ¶ 1; *see id.* Fig. 8 (“swim-lane chart illustrating a method for providing location-aware offers based on missed purchase opportunities”). As noted above, claims 1–5, 8, and 20–23 are pending. Claims 1, 20, and 21 are independent. App. Br. 39, 40–42 (Claims App’x). Claims 2–5 and 8 depend directly from claim 1; and claims 22 and 23 depend directly from claim 21. *Id.* at 39–40, 42–43.

Claim 1, reproduced below, is illustrative.

1. A method to deliver a location-aware offer, the method comprising:
 - aggregating, on a network-based system, user profile data of a user from a plurality of commerce systems separate from the network-based system, the user profile data including a demonstrated purchase action that includes a reference to an item;
 - extracting, at the network-based system, the demonstrated purchase action from the user profile data, the demonstrated purchase action comprising an action indicating an interest in an item without subsequent purchase of the item;
 - generating, on the network-based system, a demonstrated purchase list based at least in part on the demonstrated purchase action;
 - receiving, at the network-based system, current location data specifying a current location of a client device associated with the user;
 - determining that the client device is within a pre-defined proximity to a merchant location based on the current location data;

accessing an inventory of the merchant location to compare the inventory against the demonstrated purchase list; identifying a matching inventory item within the inventory of the merchant and the demonstrated purchase list, the matching inventory item comprising the referenced item;

generating an offer for the matching inventory item in response to the determining that the user is within the pre-defined proximity to the merchant location and the identifying the matching inventory item to the item referenced by the demonstrated purchase action, the offer based on the demonstrated purchase action; and

causing display of the offer to the client device.

Id. at 39.

III. REFERENCES

The Examiner relies upon the following prior art in rejecting the pending claims:

DeWitt *et al.* (“DeWitt”) US 2009/0076925 A1 Published Mar. 19, 2009;
Filed Sept. 13, 2007

Samson *et al.* (“Samson”) US 7,228,287 B1 Issued June 5, 2007;
Filed Nov. 13, 2000

J.P. Manninen, “Geofencing” enables new location-based apps, raises privacy concerns, VENTURE BEAT (Apr. 23, 2010), <http://venturebeat.com/2010/04/23/geofencing-pushes-services-to-phones/> (“Manninen”).

IV. THE REJECTIONS

Claims 1–5, 8, and 20–23³ stand rejected under 35 U.S.C. § 112, ¶ 1, as lacking written description (Final Act. 3–4); and claims 1–5, 8, and 20–

³ The Examiner finds that “[d]ependent claims each inherit the deficiencies of their respective parent claims and are thus also rejected.” Final Act. 4.

23⁴ stand rejected under 35 U.S.C. § 112, ¶ 2, as indefinite (*id.* at 4–6).⁵ Claims 1–5, 8, and 20–23 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. *Id.* at 10–14. Claims 1–5, 8, and 20–23 also stand rejected under 35 U.S.C. § 103(a) as rendered obvious over the combined teachings of Samson and DeWitt, alone or in combination with Manninen. *Id.* at 14–21.

Unless otherwise indicated, we adopt the Examiner’s findings in the Answer as our own and add any additional findings of fact appearing below for emphasis. We address these rejections below.

V. ANALYSIS

A. Adequate Written Description

The Examiner finds that

[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of the claimed invention.

Final Act. 3. In particular, the Examiner finds that, although Appellant amended the independent claims to recite “extracting *the demonstrated*

⁴ The Examiner finds that “[d]ependent claims each inherit the deficiencies of their respective parent claims and are thus also rejected.” Final Act. 6.

⁵ The Examiner has withdrawn rejections to claim 20 under 35 U.S.C. § 112, ¶¶ 2, 6. Ans. 6. The Examiner also objects to the drawing and to the Specification. Final Act. 2 (citing 37 C.F.R. § 1.75(d)(1); MPEP §§ 608.01(o), 608.02(g)). The objections are not subject to review on appeal. MPEP § 706.01; *see* App. Br. 28–29; Ans. 2–5. All MPEP citations herein are to MPEP Rev. 08.2017, January 2018.

purchase action from the user profile data, the demonstrated purchase action comprising an action indicating an interest in an item without subsequent purchase of the item,” the Specification does not discuss “demonstrated purchase action,” and

[t]he only reference to extraction of information from the profile data is in Spec ¶ 19, which merely states that the extraction is performed. There is no disclosure of *how* the claimed function is specifically accomplished by the Applicant; rather the entirety of the disclosure is presented in functional terms, wherein the functions are performed by various modules or systems that are disclosed merely as black-boxes.

Final Act. 3 (emphasis added); *see* Ans. 7–9.

Appellant disagrees and contends that, although the terms “demonstrated purchase action” and “demonstrated purchase list,” recited in the independent claims, do not appear in the Specification, the terms are supported by the Specification. Specifically, the Specification explains that:

In an example, a network-based publication system can maintain an intended purchase list for each user that includes a list of products and services that the user has demonstrated an interest in purchasing (implicitly or explicitly). Table 1 contains an example list of actions a network-based publication system can analyze to populate an intended purchase list.

Spec. ¶ 18; *see id.* ¶ 19 (“[T]he network-based publication system 120 can work with both merchandizing system 134 and inventory system 132 to . . . match merchandise on which the merchant wants to offer deals with *missed purchase opportunities extracted from user profile data* associated with user 110.” (emphasis added)). Table 1, labeled “Demonstrated Purchase Interest,” lists numerous implicit and explicit actions “indicating an interest in an item without subsequent purchase of the item.” *See* Spec. ¶ 18; *see also id.* ¶¶ 31, 59 (describing hardware for accessing databases).

The Federal Circuit has explained that “[t]he test for the sufficiency of the written description ‘is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.’” *Vasudevan Software, Inc. v. MicroStrategy, Inc.*, 782 F.3d 671, 682 (Fed. Cir. 2015) (quoting *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)). In *Vasudevan Software*, the court considered whether disclosure in the patent’s specification of “accessing a plurality of *incompatible source databases*” provided written description for claim recitations of “disparate databases.” *Id.* at 682. The court concluded that “[t]he fact that these portions of the specification do not speak *in haec verba* of accessing ‘disparate databases’ does not eliminate as a genuine issue of material fact the existence of at least some discussion, and, therefore, possession, of the accessing of disparate databases, as claimed.” *Id.* at 682–83. For similar reasons, we conclude that Appellant has shown adequate written description here. App. Br. 29–32 (citing Spec. ¶¶ 18, 31, 59).

Further, we note that 35 U.S.C. § 112, ¶ 1, requires that the Applicant provide both a written description and an enabling disclosure of the claimed invention.

A specification must “enable” a person of skill in the art to make and use the claimed invention. Enablement is a legal question based on underlying factual determinations. A claim is sufficiently enabled even if “a considerable amount of experimentation” is necessary, so long as the experimentation “is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which the experimentation should proceed.”

Vasudevan Software, 782 F.3d at 684 (emphasis added; citations omitted; quoting *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988)). The Examiner’s

emphasis on the Specification's alleged failure to explain "how" the claimed function is accomplished suggests that the Examiner has conflated the written description and enablement requirements.

We determine that the Examiner erred in rejecting claims 1–5, 8, and 20–23 under 35 U.S.C. § 112, ¶ 1, as lacking adequate written description, and we do not sustain that rejection.

B. Claims Sufficiently Definite

1. "extracting" step

Each of the independent claims recites the step of "extracting, at the network-based system, the demonstrated purchase action from the user profile data, the demonstrated purchase action comprising an action indicating an interest in an item without subsequent purchase of the item." In *In re Packard*, the Federal Circuit addressed indefiniteness in the context of pre-issuance examination. *In re Packard*, 751 F.3d 1307, 1309 (Fed. Cir. 2014). The court held that an examiner properly may reject a pending claim as indefinite if it "contains words or phrases whose meaning is unclear." *Id.* at 1310; see *Tinnus Enter., LLC v. Telebrands Corp.*, 733 Fed. App'x 1011, 1020 (Fed. Cir. 2018) (finding claims not indefinite under either *Packard* or *Nautilus, Inc. v. Biosig Insts., Inc.*, 134 S. Ct. 2120 (2014)); *Ex parte McAward*, Appeal No. 2015-006416 (PTAB Aug. 25, 2017) (Precedential) (holding that *Packard* governs when determining indefiniteness during pre-issuance examination).

With respect to this "extracting" step recited in the independent claims, the Examiner finds that:

Applicant's original disclosure does not discuss "demonstrated purchase action." The only reference to extraction of information

from the profile data is in Spec ¶ 19, which merely states that the extraction is performed. There is no disclosure of how the claimed function is specifically accomplished by the Applicant. *As such, the metes and bounds of the claims cannot be reasonably ascertained.*

Final Act. 4. The Examiner also finds that because there is no clear definition of the term “demonstrated purchase action” in the Specification, especially in view of the recitation of “intended purchase indicator” in the original claims,

PHOSITA cannot reasonably understand what specifically must be possessed or performed to infringe on the claims without resort to undue conjecture or speculation (for example as to the actual nature of the claimed data, how it differs from other types of claimed data, or how the extraction of this type of data would vary from the other types) and no reasonable metes or bounds can be accorded to the claim limitation.

Ans. 11–12. Thus, the Examiner concludes that this claim limitation is indefinite.

We begin our analysis with the language of the claim, which provides an explanation of the term “demonstrated purchase action,” namely, “an action indicating an interest in an item without subsequent purchase of the item.”⁶ See Spec. ¶ 18 (Table 1 listing thirteen actions exemplifying demonstrated interest). However, “[the] Examiner interprets ‘demonstrated purchase action’ to be merely a name or label for data or information, which is processed by the computer as any other data according to programming.” Final Act. 7; see *Cox Comms., Inc. v. Sprint Comms. Co.*, 838 F.3d 1224, 1232 (Fed. Cir. 2016) (“To be sure, we have generally acknowledged that an

⁶ As an initial matter, the Examiner contends that Appellant has failed to respond to this rejection and, thus, has waived any response. Ans. 12. We disagree. Appellant has contested this rejection. App. Br. 32–34.

indefiniteness analysis under 35 U.S.C. § 112, ¶ 2 is ‘inextricably intertwined with claim construction.’” (citation omitted)). Claim interpretation is a question of law, which we review *de novo*.⁷ The Examiner’s interpretation of this term is overly broad and is divorced from the plain language of the claim and the descriptions of the Specification. *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016) (“While the broadest reasonable interpretation standard is broad, it does not give the Board an unfettered license to interpret the words in a claim without regard for the full claim language and the written description.” (citations omitted)). Specifically, Appellant contends that:

“Table 1 contains an example list of actions a network-based publication system can analyze to populate an intended purchase list [information stored in one or more databases],” one of ordinary skill in the art, having knowledge of a database structure and how information is stored and extracted from a database, would be reasonably appraised of how to avoid infringement of the claims.

App. Br. 33–34 (quoting Spec. ¶ 18); *see* Spec. ¶ 31 (describing means for accessing databases directly and through a server), ¶ 59 (describing the use of hardware modules to receive and operate on information). Thus, Appellant relies on the same Specification portions to respond to this rejection as relied upon with respect to the lack of written description rejection. App. Br. 32–34 (citing Spec. ¶¶ 18, 31, 59); *but see* Ans. 8–9. Appellant contends that the claim itself and the Specification describe the type of information that would be extracted and the Specification explains

⁷ The Examiner asserts that Appellant has waived any challenge to the claim interpretations. Ans. 19. We find that Appellant has presented alternative interpretations where appropriate. *See* App. Br. 28–35.

how that information would be extracted in a manner that is not unclear and would “notify the public of what is within the protections of the patent, and what is not” (*Packard*, 751 F.3d at 1313). App. Br. 33–34; *see id.* at 28–29. The Examiner bears the burden of demonstrating indefiniteness. On this record, the Examiner has not met that burden.

We conclude that, in view of the language of the claim and the cited explanations from the Specification, the meaning of the “extracting” step is not unclear.

2. “*causing*” step

Each of the independent claims recites the step of “causing display of the offer to the client device.” The Examiner finds that:

The specification alludes generally that causing of actions may be done by computer instructions. (See Spec ¶ 67, ¶¶ 69–70). Yet, the disclosure is devoid of any specific description of such causing. As such, it is not clear what specifically must be performed or provided to perform the claimed subject matter. Therefore, one of ordinary skill in the art would not be reasonably appraised of how to avoid infringement of the claim.

Final Act. 5. Specifically, the Examiner finds that “it is not possible to determine what precludes the displaying, so that it could be determined what, if anything, needs to specifically be provided or performed to ‘cause’ the display.” Ans. 12. Thus, Examiner finds that, although “delivering” an offer to a client device or “displaying” the offer on the device would be definite, “causing” display of an offer on the device is not. *Id.* n.6.

The Specification explains how a client device receives and displays information. Spec. ¶ 27, Fig. 3; *see* App. Br. 34–35. Further, referring to Figure 9, the Specification explains, “FIG. 9 is a diagrammatic representation of a machine in the example form of a computer system

within which a set of instructions *for causing* the machine to perform any one or more of the methodologies discussed herein may be executed.” Spec. ¶ 12 (emphasis added); *see id.* ¶ 69 (“The disk drive unit 916 includes a machine-readable medium 922 on which is stored one or more sets of instructions and data structures (e.g., software) 924 embodying or used by any one or more of the methodologies or functions described herein.”).

“Causing display” may be broader than “delivering” an offer or “displaying” the offer, but “[b]readth is not indefiniteness.” *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1341 (Fed. Cir. 2005) (alteration in original).

Appellant contends, “one of ordinary skill in the art, having knowledge of client devices (e.g., mobile devices), network signals, and how information is received by a client device and displayed on a display of a client device, would be reasonably appraised of how to avoid infringement of the claims.” App. Br. 34–35. The Examiner does not show that this contention is incorrect. *See Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 655 F.3d 1364, 1373–74 (Fed. Cir. 2011). Again, the Examiner bears the burden of showing indefiniteness. On this record, the Examiner has not met that burden.

C. Patent Ineligible Subject Matter

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 U.S. 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. 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 Court

in *Alice* reiterated the two-step framework previously set forth in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 82–83 (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. *Id.*

Noting that the two stages involve “overlapping scrutiny of the content of the claims,” the Federal Circuit has described “the first-stage inquiry” as “looking at the ‘focus’ of the claims, their ‘character as a whole,’” and “the second-stage inquiry (where reached)” as “looking more precisely at what the claim elements add--specifically, whether, in the Supreme Court’s terms, they identify an ‘inventive concept’ in the application of the ineligible matter to which (by assumption at stage two) the claim is directed.” *Electric Power Grp, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). The Court acknowledged in *Mayo* that “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. We, therefore, look to whether the claims focus on a specific method or means that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016). If the claims are not directed to an abstract idea, the inquiry ends. *Id.* at 1339. Otherwise, the inquiry proceeds to the second step where 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).

Initially, the Examiner finds that each of claims 1–5, 8, and 20–23 is directed to a statutory category of invention. Claims 1–5, 8, and 20–23, however, stand rejected under 35 U.S.C. § 101 because the statutory claims are directed to a judicial exception. Final Act. 10–11. In particular, the Examiner determines that “the claims are directed to receiving and comparing information and rules to generate an offer.” *Id.* at 11 (citing Spec. ¶ 15 (the invention seeks to solve the problem of “provid[ing] merchants the ability to target customers based on past behavior and current context (e.g., location)”), ¶ 18 (“utilizing any implicit or explicit actions associated with a user that can be recorded and stored for future analysis” (i.e., profile data) to sell merchandise to the user based on the user’s detected location)). The independent claims recite “the steps of aggregating user profile data of a user; extracting [data] from the user profile data; receiving current location data; accessing an inventory of the merchant location; generating an offer in response to the determining that the user is within the pre-defined proximity to the merchant location” to achieve this abstract idea. *Id.* Further, “[t]his is simply the organization and comparison of data which can be performed mentally” and

is similar to other concepts that have been identified as abstract by the courts, such as using categories to organize, store and transmit information in [*Cyberfone Sys. LLC v. CNN Interactive Grp. Inc.*, 558 Fed. App’x 988 (Fed. Cir. 2014)]; data recognition and storage in [*Content Extraction and Transmission LLC v. Wells Fargo Bank, NA*, 776 F.3d 1343 (Fed. Cir. 2014)]; organizing information through mathematical correlations in [*Digitech Image Techs. LLC v Elecs. for Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014)]; comparing new and stored information

and using rules to identify options in [*SmartGene Inc. v Advanced Biological Labs., SA*, 555 Fed. App'x 950 (Fed. Cir. 2014)]; collecting and comparing information in [*Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011)].

Id.; see Ans. 16–18. Thus, the Examiner concludes that the pending claims are directed to an abstract idea under the step one of the *Alice* analysis.

In addition, the Examiner finds that considered alone or as an ordered combination, the limitations of the claims do not amount to significantly more than the abstract idea. Final Act. 12–14. In particular, the Examiner considers each of the limitations recited in the independent claims and finds that these limitations describe no more than generic computer functions performed on a generic computer or limitations that improve the functioning of the abstract idea, rather than the computer technology used to achieve it. *Id.* at 12–13; see Ans. 13–15; see also Spec. ¶ 23 (known types of data transfer and communication networks), ¶¶ 57, 58 (describing “general-purpose processor”), ¶ 71 (“well-known transfer protocols”). The Examiner further finds that the “causing” step of each claim represents insignificant post-solution activity.⁸ Final Act. 13–14. “The term ‘extra-solution activity’ can be understood as activities incidental to the primary process or product that are merely a nominal or tangential addition to the claim.” MPEP 2106.05(g).

⁸ Appellant relies on this limitation and two recent U.S. district court decisions in support of the contention that this recited methods, systems, and instructions stored on computer readable media could not be performed in the human mind or with pen and paper. App. Br. 18–20. Because we find this limitation to be insignificant post-solution activity and because the cited cases neither are binding on the Board nor clearly distinguish binding precedent, we find this contention unpersuasive.

The Examiner determines that, considered as an ordered combination, these limitations do “not add anything further than looking at the limitations individually. Examiner notes that the disclosure does not present any evidence that the particular ordered combination provides any variation as to how any particular step would be conventionally expected to be performed.” Final Act. 14; *see BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016) (“The inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art. As is the case here, an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.”). On this record, we agree with the Examiner’s determination that the claims employ generic components that performing known and routine computer functionalities.

Appellant contends that the Examiner erred in finding that the claims are directed impermissibly to an abstract idea and in failing to find that the claim limitations amount to significantly more than an abstract idea. App. Br. 10–22. For the reasons set forth below, we are not persuaded that the Examiner erred in rejecting claims 1–5, 8, and 20–23 under 35 U.S.C. § 101.

First, Appellant contends that the pending claims are not directed to patent ineligible subject matter. *Id.* at 10–17. Appellant argues that the Examiner incorrectly determined that the pending, independent claims are directed to an abstract idea because the Examiner failed to consider each of the claims’ limitations in making this determination. *Id.* at 10–12. However, as discussed above, the Examiner indeed did consider all of the limitations of the pending, independent claims in determining that those

claims are directed to an abstract idea. Final Act. 12–13; Ans. 13–16. Thus, we find Appellant’s contention unpersuasive.

Further, Appellant contends that the Examiner’s comparison of the concepts present in the pending claims with similar concepts identified by the courts in other claims of other cases is deficient. App. Br. 12–15. In particular, Appellant contends that the Examiner fails to show that any court previously has found the abstract idea identified in these claims present in another case. *Id.* However, as discussed above, the Examiner has identified previous court decisions finding similar abstract ideas patent ineligible. Final Act. 11; Ans. 16–18. As the Examiner correctly notes, the abstract idea identified here

is also reasonably similar to the ideas considered by the courts to be abstract, as discussed above. There is no requirement that the words of the claims be match to the words of other claims found to be abstract, and certainly, the courts that have found claims to be ineligible under the *Alice* standard have not conducted such an analysis.

Ans. 18. Moreover, even assuming that Appellant is correct, as the Federal Circuit has explained, a “claim for a *new* abstract idea is still an abstract idea.” *SAP America, Inc. v. InvestPic, LLC*, 890 F.3d 1016, 1018 (Fed. Cir. 2018) (quoting *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016)). We find Appellant’s contention unpersuasive.

Second, Appellant contends that, like the claims in *Enfish*, the pending claims are directed to improvements in the functioning of a computer. App. Br. 15–17, 20–22. In particular, Appellant contends,

the claims at issue in this case focus on a specific asserted improvement in computer capabilities, particularly, in the capability of the network-based system to communicate and work with multiple websites and based on those

communications, as well as the physical location of a client device, generate and deliver content to the client device.

Id. at 17. Consequently, Appellant contends that either the claims are directed to an improvement in computer functionality, *rather than an abstract idea* (*id.* at 17), or to *significantly more* than an abstract idea (*id.* at 21–22). The Examiner finds, however, that the recited network-based system and client device are generic computing devices. Ans. 18; *see* Final Act. 7 (citing Spec. ¶ 19 (describing a “client device”), ¶ 30 (describing “network-based system 400”)). The Examiner also finds

there is no evidence of record that shows a deficiency in the computer or the computer technology that is resolved by the invention. There is no actual evidence that any of the communicative aspects or interaction between computing elements is performed by anything other than routine and expected industry standard means and protocols functioning according to their routine capacity to transmit, receive and process data.

Ans. 18–19. We agree.

We conclude the focus of the pending claims is not on an improvement to the computer functionality itself, but, instead, the focus is on an abstract idea that uses computers and networks as tools. *See Enfish*, 822 F.3d at 1336. That customer information may be gathered from multiple sources (i.e., “commerce systems”) and that the merchant may identify an offer receiving customer by his or her proximity to the merchant, neither alone nor in combination with the other claim limitations, amounts to significantly more than the abstract idea. Final Act. 14; Ans. 18–19. As Appellant acknowledges, the patent eligibility of dependent claims 2–5, 8, 22, and 23 falls with that of their base claims. App. Br. 12

The Examiner did not err in determining that the recited methods, systems, and instructions stored on computer readable media are patent ineligible; and we sustain the Examiner's rejections under 35 U.S.C. § 101.

D. Obvious Over Samson and DeWitt, Alone or in Combination with Manninen

As noted above, claims 1–5, 8, and 20–23 stand rejected under 35 U.S.C. § 103(a) as rendered obvious over the combined teachings of Samson and DeWitt, alone or in combination with the teachings of Manninen. Final Act. 14–21. Although the Examiner addresses each of the pending claims in the Final Office Action, Appellant focuses its response to the rejections on the limitations of independent claims 1, 20, and 21. *See* App. Br. 23–24, 28. Because of the similarities between the limitations of independent claims 1, 20, and 21, we focus on the limitations of claim 1 in our discussion of these rejections.

1. Teaching the Claim Limitations

The Examiner finds that Samson teaches or suggests almost all of the limitations of independent claim 1. Final Act. 15–17. In particular, the Examiner finds (1) that Samson teaches or suggests the step of “aggregating, on a network-based system, user profile data of a user from a plurality of commerce systems separate from the network-based system, the user profile data including a demonstrated purchase action that includes a reference to an item” and (2) that the combined teachings of Samson and DeWitt teach or suggest the step of “generating an offer for the matching inventory item in response to the determining that the user is within the pre-defined proximity to the merchant location and the identifying the matching inventory item to

the item referenced by the demonstrated purchase action, the offer based on the demonstrated purchase action.” *Id.* at 16.

The Examiner finds that Samson teaches aggregating “consumer information [having] at the least, information relating to bids on the auction items.” *Id.* at 16 (quoting Samson, 2:25–26); *see* Samson, Claims 1–20. In particular, Samson teaches:

The present invention further provides a database for an incentive program for bidders on auction items, including an inventory file having at least one of detailed descriptions of an inventory, a list of similar items of the inventory, and a list of complementary items of the inventory, and *a consumer profile* having at least one of bidding history, start bid, bid frequency, bid increment, final bid, winning bid, *target product*, Internet service provider, zip code, credit card type, and coupon redemption rate.

Samson, 2:53–61 (emphases added); *see id.* at 4:34–40. However, information aggregated by Samson is not limited to bid information. Referring to Figure 2, Samson explains that “[d]emographics, psychographics, market conditions, *and any other relevant information from other databases 15* or any other relevant information identified through contact with the consumer may also be recorded.” *Id.* at 4:40–44 (emphasis added). Further, Samson teaches that the consumer information may include information on goods that the consumer has viewed from different manufacturers, i.e., a consumer’s product consideration set. *Id.* at 7:60–8:10; *see also id.* at 5:47–57 (describing inventory database system 35 including inventory data 33 of both retailers and manufacturers). Thus, Samson teaches aggregating various types of consumer information from various sources over the Internet. *See id.* at 4:24–29 (“Preferably, the browsing behavior 11 has click stream information, which includes other

components of the auction site that were visited by the consumer, number of pages visited, time spent on each page during each visit per each auction, number of auctions visited/participated, and frequency of revisiting auctions.”), 6:23–25 (“Based on the product attributes the consumer most prefers, which are revealed *in the browsing behavior 11* in the consumer profile” (emphasis added)), 7:25–44 (describing information aggregated from “auctions visited and/or participated”).

With regard to the “extracting” step, the Examiner finds that “Samson discloses aggregating user profile data, extracting a missed purchase opportunity demonstrated by the user explicitly or implicitly indicating an interest in making a purchase that was not completed (i.e. lost auction bid).” Final Act. 17; *see* Samson, 1:16–18 (“While many consumers may bid on goods at a web site, those bidders willing to purchase merchandise, but having unsuccessful bids, may not purchase any merchandise.”), 4:38–40 (“Preferably, the bidding and behavior values 12 also contain whether the consumer’s bid was a successful bid, which is the winning bid, or an unsuccessful bid.”). By comparison, referring to Table 1, the Specification describes, “Losing an auction after placing a bid” as a “Demonstrated Purchase Interest” action. Spec. ¶ 18. Thus, we are persuaded that an unsuccessful auction bid is a “demonstrated purchase action,” and that Samson teaches linking an unsuccessful bid to a particular good. *See* Samson, 4:19–34, 8:2–10.

With regard to the “generating” step, the Examiner acknowledges, “Samson does not disclose presenting the offer based on a determination of the user’s physical proximity to the physical location of inventory.” Final

Act. 17. The Examiner finds, however, that DeWitt teaches this limitation. Specifically, the Examiner finds that DeWitt teaches:

(see at least [DeWitt] ¶6, “When the consumer is within a predetermined distance from the merchant, the offer is made;” ¶7, “sending a first transmission containing information sufficient to derive . . . the location of the portable consumer device;” ¶¶29-30, fig. 1; ¶47, “once it is determined that the consumer is within the predetermined distance, the ROS may generate and transmit an offer;” ¶64, “ first set of matching merchants is formed using the storage S(s) to signify that they have the consumer requested inventory;” ¶85, “Consumer device receives an offer . . . where the merchant has a location that is within a predetermined distance from the derived location of the consumer device.”).

Final Act. 17–18.

Appellant contends that the combined teachings of Samson and DeWitt fail to teach or suggest the “aggregating” and “generating” steps of independent claim 1. App. Br. 24–27. With regard to the “aggregating” step, Appellant contends that:

While Samson may teach “record[ing] the consumer’s ... bidding behavior,” the recorded bidding behavior is in connection with the auction house’s own website. In contrast, claim 1 recites “aggregating, on a network-based system, user profile data of a user from a plurality of commerce systems separate from the network-based system.”

Id. at 24–25 (citing Samson, 3:38–40, 61–64) (alteration in original).

Further, Appellant contends that to the extent Samson teaches collecting data from other sources, it is only “inventory data.” *Id.* at 25 (citing Samson, 3:38–40, 61–64).

The Examiner asserts that Appellant misrepresents Samson’s teachings. Ans. 21–22. Referring to Figure 2, Samson teaches creating a consumer profile 16 from information from distinct databases 11–15. *Id.*;

see Samson, 4:44–45. Further, as discussed above, Samson teaches that the user profile may be based on the user’s “browsing behavior.” *See, e.g.*, Samson, 6:23–25. The Examiner has shown that Samson teaches aggregating user profile data from a plurality of websites, i.e., “commerce systems,” separate from the network-based system. Moreover, the user profile data may include a demonstrated purchase action that includes a reference to an item. *See* Spec. ¶ 18 (Table 1: “Losing an auction after placing a bid” and “Researching a particular product or service”). Thus, we are persuaded that the Examiner has shown that Samson teaches or suggest the “aggregating” step of claim 1.

With regard to the “generating” step, Appellant contends that:

DeWitt does not teach or suggest, at least, that the offer is “generated . . . in response to the determining that the user is within the pre-defined proximity to the merchant location *and* the *identifying the matching inventory item to the item referenced by the demonstrated purchase action, the offer based on the demonstrated purchase action.*”

App. Br. 26. In addition, “while DeWitt discloses an offer being specifically tailored to a present location or past shopping behavior of the consumer, the past shopping behavior is associated with *purchases made* by the consumer.” *Id.* Although it is correct that DeWitt discusses using information regarding past purchases to predict future purchases (DeWitt ¶ 53), the Examiner relies on Samson, *not DeWitt*, to teach the limitations Appellant contends are missing. Ans. 24. Thus, for the reasons set forth above, we are persuaded the Examiner has shown that the combined teachings of Samson and DeWitt teach or suggest the “generating” step of claim 1.

2. *Sufficient Reason to Combine*

The Examiner further determines that a person of ordinary skill in the art would have had reason to combine the teachings of Samson and DeWitt to achieve the method recited in independent claim 1. In particular, the type of information aggregated in Samson is similar to the type of information relied upon by DeWitt, and the

presentation of offers when the user is within physical proximity to the merchant location would provide better inventory disposition option for the seller as well as greater likelihood for the buyer to be incentivized to make the purchase due to the physical convenience and the combination of old elements may be made according to known methods to yield predictable results.

Final Act. 18; DeWitt ¶¶ 42, 52, 70.

Appellant disagrees and contends that

DeWitt does not contemplate offers based on demonstrated purchase actions indicating an interest in an item without a subsequent purchase, as would be necessary for the Examiner's proposed combination. DeWitt only discusses proximity based offers tailored toward "present location" or "past shopping behavior," where the past shopping behavior is associated with purchases by the consumer.

App. Br. 27–28. Nevertheless, Appellant acknowledges, "DeWitt contemplates tailoring an offer specifically to an attribute of the consumer."

Ans. 24 (citing App. Br. 27; DeWitt ¶ 12). The Examiner concludes that:

The list of products [] calculated to be of interest to a customer, as provided by Samson, would specifically be a type of consumer attribute that [person of ordinary skill in the art] would wish to use when the user is within physical proximity to the merchant location as done in DeWitt.

Id.; *see also* Samson, 4:34–37 ("The personal computer information 13 includes . . . access location (work or home)"), 42–44 ("any other relevant

information identified through contact with the consumer may also be recorded.”). We conclude that the Examiner has shown sufficiently that a person of ordinary skill in the art would have had reason to combine the teachings of Samson and DeWitt to achieve the methods of claim 1.

The Examiner did not err in determining that the methods, systems, and instructions stored on computer readable media, recited in claims 1, 20, and 21, respectively, are rendered obvious over the combined teachings of Samson and DeWitt. Further, Appellant does not argue the dependent claims separately, and, on this record, we determine that the Examiner has shown that claims 3–5, 8 and 23 are rendered obvious over the combined teachings of Samson and DeWitt, and claims 2 and 22 are rendered obvious over the combined teachings of Samson and DeWitt, and Manninen. Thus, we sustain the Examiner’s rejections of claims 1–5, 8, and 20–23 under 35 U.S.C. § 103(a).

Consequently, we are persuaded that the Examiner did not err in rejecting claims 1–5, 8, and 20–23, and we sustain the rejections thereof under 35 U.S.C. § 101 and § 103(a).

VI. DECISION

For the above reasons, we affirm the Examiner’s decision rejecting claims 1–5, 8, and 20–23.

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